## UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON DC 20005-3096

MAILED
AUG 0 4 2011
OFFICE OF PETITIONS

In re Application of

Mitsuru Suzuki

Application No. 11/360,495

Filed: February 24, 2006

Attorney Docket No. 065933-0251

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 18, 2011, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before July 14, 2011, as required by the Notice of Allowance and Fee(s) Due mailed April 14, 2011. Accordingly, the date of abandonment of this application is July 15, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of \$1,510.00 and the publication fee of \$300.00, (2) the petition fee of \$1,620.00; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

This application is being referred to the Office of Data Management for processing into a patent.

/Joan Olszewski/ Joan Olszewski Petitions Examiner Office of Petitions



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OFFICE OF PETITIONS

KIRTON AND MCCONKIE 60 EAST SOUTH TEMPLE, SUITE 1800 SALT LAKE CITY UT 84111

In re Application of

Jensen et al.

Application No. 11/360,550

Filing or 371(c) Date: 02/23/2006

Attorney Docket No. 10209.908

: DECISION ON PETITIONS

: UNDER 37 CFR 1.78(a)(3) AND (a)(6)

This is a decision on the Petition Under 37 CFR 1.78, Petition to Accept Unintentionally Delayed Benefit Claim, filed July 21, 2010, to accept an unintentionally delayed claim under 35 U.S.C. §§120 and 119(e) for the benefit of priority to the prior-filed applications set forth in the concurrently filed amendment. The petition is properly treated under 37 CFR §§ 1.78(a)(3) AND (a)(6).

## The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in  $\S 1.17(t)$ ; and
- a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

As to item (1), a review of provisional application no. 60/335,343, reveals that there is no common inventorship between the provisional application no. 60/335,343, and the present application, 11/360,550, or application no. 10/285,359.

Under 35 U.S.C. 119(e), as contained in Public Law 103-465, a later filed nonprovisional application under 35 U.S.C. 111(a) that is filed within twelve months of an earlier provisional application may claim benefits based on the earlier filed provisional application so long as both applications have at least one inventor in common.

#### MPEP 201.03.

Here, because there is no common inventor between the provisional application no. 60/335,343, and the present application, 11/360,550, or application no. 10/285,359, the priority claim to provisional application 60/335,343 is improper and must be removed.

Moreover, a review of the Amendment to the Specification and the benefit claim filed with the petition reveals that Petitioner stated that "[t]his application is a divisional of United States Patent Serial No. 10/285,359, dated October 31, 2002, entitled..., <u>and</u> claims priority to United States Provisional Application No. 60/335,343...." (Emphasis supplied). Petitioner attempts to claim priority from the present application to Provisional Application No. 60/335,343; however, Office records reveals that continuity does not exist between the present application, filed November 19, 2004, and Provisional Application No. 60/335,343, filed November 2, 2001. Also, petitioner has not provided the filing date of application no. 10/285,359.

An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See MPEP Section 201.11, Reference to Prior Nonprovisional Applications. The amendment fails to comply with the provisions of 37 CFR 1.78(a)(2)(i) and is therefore unacceptable.

An example of a proper benefit claim from the present application to application no. 11/285,259, and from 11/285,259 to provisional application no. 60/335,343, would be as follows<sup>1</sup>:

This application is a divisional of application no. 10/285,359, filed October 31, 2002, now U.S. Patent No. 7,033,624, which claims priority to provisional application no. 60/335,343, filed November 2, 2001.

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition under 37 CFR § 1.78(a)(3) an Application Data Sheet or a substitute amendment (complying with 35 U.S.C. 120; 37 CFR 1.121 and 37 CFR 1.76(b)(5)), which states the relationship of the prior-filed application(s) to this application, are required.

<sup>&</sup>lt;sup>1</sup> Please note; however, that this is by way of example only, as common inventorship does not exist between provisional application 60/335,343 and application nos. 10/285,259 or 11/360,550, as noted *supra*.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop PETITIONS

Director for Patents Post Office Box 1450

Alexandria, VA 22313-1450

By hand:

**Customer Service Window** 

Mail Stop Petitions Randolph Building 40l Dulany Street Alexandria, VA 22314

By fax:

(571) 273-8300

ATTN: Office of Petitions

Any questions concerning this matter may be directed to Derek Woods at (571) 272-3232.

Christopher Bottorff

Supervisor

Office of Petitions

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ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON DC 20036

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AUG 0 6 2010

OFFICE OF PETITIONS

In re Patent No. 7,688,182

Application No. 11/360,601

Filed: February 24, 2006 : ON F

Issued: March 30, 2010

Attorney Docket No. 100353-00256

ON PETITION

This is a decision on the petition filed July 6, 2010, which is being treated as a request under 37 CFR 3.81(b)<sup>1</sup> to correct the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

This matter is being referred to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3206. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

Liana Walsh

Petitions Examiner Office of Petitions

<sup>&</sup>lt;sup>1</sup> See MPEP 1309, subsection II; and Official Gazette of June 22, 2004.



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SNR DENTON US LLP P.O. BOX 061080 CHICAGO IL 60606-1080

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In re Application of

OFFICE OF PETITIONS

Michael David Andrew et al.

Application No. 12/360,791 Filed: January 27, 2009

DECISION ON PETITION TO WITHDRAW

Attorney Docket No. 40000302-0002-002

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 25, 2010.

### The request is **NOT APPROVED.**

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request cannot be approved because there is no indication that certifications for acts (1) and (3) have been performed.

Further, the request cannot be approved because no forwarding address was provided. The request to change the correspondence address should be that of the: (1) the first named inventor; or (2) an assignee of the entire interest under 37 C.F.R 3.71. If an assignee has intervened in this application then a Statement under 37 CFR 3.73(b), or a copy of the actual assignment must be submitted with a renewed request.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4618.

/Kimberly Inabinet/

Kimberly Inabinet Petitions Examiner Office of Petitions

#### UNITED STATES PATENT AND TRADEMARK OFFICE



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DILLON & YUDELL LLP 8911 N. CAPITAL OF TEXAS HWY., SUITE 2110 AUSTIN TX 78759

MAILED SEP 0 9 2010

OFFICE OF PETITIONS

In re Application of

Matyas Sustik

Application No. 11/360,905

Filed: February 23, 2006

Attorney Docket No. AUS920060046US1

**DECISION ON PETITION** 

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed July 27, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a proper and timely manner to the final Office action mailed, September 15, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on December 16, 2008. A Notice of Abandonment was mailed April 10, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of \$810.00 and the submission required by 37 CFR 1.114 (previously submitted April 12, 2010); (2) the petition fee of \$1,620.00 (previously submitted April 12, 2010); and (3) a proper statement of unintentional delay.

Further, it is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

This matter is being referred to Technology Center AU 2161 for processing of the Request for Continued Examination under 37 CFR 1.114 and the Amendment filed April 12, 2010.

Joan Olszewski Petitions Examiner

Office of Petitions





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NELSON MULLINS RILEY & SCARBOROUGH / BIOGEN FLOOR 30, SUITE 3000 ONE POST OFFICE SOUARE BOSTON MA 02109-2127

MAILED NOV 2 2 2010 OFFICE OF PETITIONS

In re Application of Taylor, et al.

Application No. 11/360,938 Filed: February 22, 2006

Atty Docket No.BGG-A190CNRCE2:

DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION UNDER 37 CFR 1.705(b)" filed September 24, 2010. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from two hundred and thirty-five (235) days to one hundred and seventy-three (173) days. Applicants also set forth some argument as to the adjustment to the patent term on the basis that the Office will take in excess of three years to issue this patent, which is properly treated under 37 CFR 1.705(b).

Relative to the any assertion that the Office will take in excess of 3 years of the filing date to issue this patent, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee<sup>1</sup>.

It is noted that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —

For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the \$1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is further noted that a Request for Continued Examination (RCE) was filed in this application on September 1, 2009.

To the extent that applicants otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is **GRANTED to the extent indicated herein**.

The Office has updated the PALM and PAIR screens to reflect that the Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one hundred and seventy-three (173) days. A copy of the updated PALM screen, showing the corrected determination, is enclosed.

On June 25, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment is 235 days. On September 24, 2010, applicants timely submitted the instant application for patent term adjustment. Applicants dispute the period of reduction of 94 days for the filing of an Information Disclosure Statement (IDS) on May 22, 2009, and indicate that the a reduction of 156 days should be entered for the IDS filed February 4, 2010.

Applicant's argument relative the reduction of the patent term adjustment of 94 days for the purported filing of an IDS on May 22, 2009, is noted and is persuasive. A review of the file history did not reveal an IDS filed May 22, 2009. Accordingly, the reduction of 94 days is being removed.

A review of the application history reveals that an Information Disclosure Statement (IDS) was filed on February 4, 2010, 156 days after a response to a final rejection was filed on June 1, 2010. 37 CFR 1.704(c)(8) provides that:

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include

 $<sup>^2</sup>$  PALM records indicate that the issue fee payment was received on September 24, 2010.

the following circumstances, which will result in the following reduction of the period of adjustment set forth in \$ 1.703 to the extent that the periods are not overlapping:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date the supplemental reply or other such paper was filed.

## 37 CFR 1.704(d) provides that:

(d) A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

It is undisputed that the Information Disclosure Statement filed February 4, 2010, was filed 156 days after the response to the final rejection was filed on September 1, 009. The record does not support a conclusion that the Examiner expressly requested the filing of the IDS. Further review of the Information Disclosure Statement did not reveal a statement under § 1.704(d). Accordingly, pursuant to 37 CFR 1.704(c)(8), a period of reduction of one hundred and fifty-six (156) days will be entered.

In view thereof, the determination of the patent term adjustment at the time of the mailing of the notice of allowance is one hundred and seventy-three (173) days (391 days of Office delay - 218 days of applicant delay).

The Office is in receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this specific matter should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Senior Petitions Attorney Office of Petitions

Enclosure: Copy of REVISED PALM screen



Application Number\*: 11360938

Search Explanation of PTA Calculation Explanation of PTE Calculation

## PTA Calculations for Application: 11360938

1		
	Application Filing Date 02/22/2006	OverLapping Days Between (A and B) or (A and C)
	Issue Date of Patent	Non-Overlapping USPTO Delays: 391
ţ	A Delays 391	PTO Manual Adjustment -62
	B Delays 0	Applicant Delay (APPL) 156
	C Delays 0	Total PTA (days) 173

## \* - Sorted Column

## File Contents History

▣

Action Number	Action Recorded Date	Action Due Date	Action Code	<u>Action</u> <u>Description</u>	Duration PTO	Duration APPL	Parent Action Number
105	11/16/2010		P028	Adjustment of PTA Calculation by PTO		62	,
8	06/25/2010		MN/=.	Mail Notice of Allowance			0
7	06/23/2010		IREV	Issue Revision Completed			0
6	06/23/2010		DVER	Document Verification			0
5	06/23/2010		N/=.	Notice of Allowance Data Verification Completed			)
4	06/23/2010		CNTA	Notice of Allowability			0
7	06/18/2010		FWDX	Date Forwarded to Examiner			0
4	06/18/2010		ABN9	Disposal for a RCE / CPA / R129			0
1	06/15/2010		IDSC	Information Disclosure Statement considered			0
0	06/15/2010		WIDS	Information Disclosure Statement (IDS) Filed			0
9	06/15/2010		RCAP	Reference capture on IDS			0
8	06/15/2010		M844	Information Disclosure Statement (IDS) Filed			0
6	06/15/2010		AMSB	Amendment Submitted/Entered with Filing of CPA/RCE			)
5	06/15/2010		RCEX	Request for Continued Examination (RCE)			)
3	06/15/2010		BRCE	Workflow - Request for RCE - Begin			)
2	06/01/2010		FIDC	Finished Initial Data Capture			)
- 1	05/17/2010		TCPUB	TC Return to Pubs			- )
- 0	05/17/2010		MM327	Mail Miscellaneous Communication to Applicant			5
9	05/07/2010		M327	Miscellaneous Communication to Applicant - No Action Count			)
5	04/28/2010		QURI	Workflow - Query Request - Begin			- )
6	04/22/2010		PUBTC	Pubs Case Remand to TC			·
4	03/30/2010		CRFT	Sequence Forwarded to Pubs on Tape			
3	03/19/2010		EIDC	Export to Initial Data Capture			, 1
2	03/15/2010	01/01/2010		Mail Notice of Allowance	<u>73</u>		- 17
9	03/13/2010	01/01/2010	N/=.	Notice of Allowance Data Verification Completed	<u> </u>		·'
8	03/12/2010		DOCK	Case Docketed to Examiner in GAU			,
1							, 1
0	03/05/2010		IREV DVER	Issue Revision Completed  Document Verification			-
7	03/05/2010			Information Disclosure Statement considered	•		,
	02/04/2010		IDSC				,
6	02/04/2010		EIDS.	Electronic Information Disclosure Statement			
5	02/04/2010		WIDS	Information Disclosure Statement (IDS) Filed			)
0	09/04/2009		CNTA	Notice of Allowability			)
0	09/03/2009		FWDX	Date Forwarded to Examiner			,
8	09/03/2009		FWDX	Date Forwarded to Examiner			
6	09/03/2009		ABN9	Disposal for a RCE / CPA / R129			
5	09/01/2009		IDSC	Information Disclosure Statement considered			
4	09/01/2009		IDSC	Information Disclosure Statement considered		9	-
3	09/01/2009		RCAP	Reference capture on IDS			
2	09/01/2009		M844	Information Disclosure Statement (IDS) Filed			
1	09/01/2009		AF/D	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received			
9	09/01/2009		AMSB	Amendment Submitted/Entered with Filing of CPA/RCE			
7	09/01/2009		RCEX	Request for Continued Examination (RCE)			
5	09/01/2009		WIDS	Information Disclosure Statement (IDS) Filed			
4	09/01/2009		WIDS	Information Disclosure Statement (IDS) Filed		(	
3	09/01/2009		BRCE	Workflow - Request for RCE - Begin		(	
2	06/25/2009		MEXIN	Mail Examiner Interview Summary (PTOL - 413)		9	
1	06/22/2009		EXIN	Examiner Interview Summary Record (PTOL - 413)		(	
0	06/01/2009		MCTFR	Mail Final Rejection (PTOL - 326)		9	
9	05/27/2009		CTFR	Final Rejection			
1	05/22/2009	02/17/2009		Information Disclosure Statement (IDS) Filed			35
6	04/02/2009		FWDX	Date Forwarded to Examiner		(	
4	02/17/2009		RCAP	Reference capture on IDS			)
3	02/17/2009		M844	Information Disclosure Statement (IDS) Filed		(	
8	02/17/2009		IDSC	Information Disclosure Statement considered		(	
7	02/17/2009		AF/D	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		- (	)

35	02/17/2009	12/17/2008	A	Response after Non-Final Action		<u>62</u>	32	
34	02/17/2009	•	XT/G	Request for Extension of Time - Granted			0	
33	02/17/2009		WIDS	Information Disclosure Statement (IDS) Filed			0	
32	09/17/2008		MCTNF	Mail Non-Final Rejection			0	
31	09/12/2008		CTNF	Non-Final Rejection			0	
26	08/26/2008		DOCK	Case Docketed to Examiner in GAU			0	
25	07/14/2008		FWDX	Date Forwarded to Examiner			0	
24	06/05/2008		ELC.	Response to Election / Restriction Filed			0	
23	06/05/2008		XT/G	Request for Extension of Time - Granted			0	
62	05/22/2008		RCAP	Reference capture on IDS			0	
27	05/22/2008		IDSC	Information Disclosure Statement considered			0	
22	05/22/2008		WIDS	Information Disclosure Statement (IDS) Filed			0	
21	03/05/2008	04/22/2007	MCTRS	Mail Restriction Requirement	318		-1	
20	02/27/2008		CTRS	Requirement for Restriction / Election			0	
17	11/13/2007		C.ADB	Correspondence Address Change			0	
16	09/05/2007		C.ADB	Correspondence Address Change			0	
15	03/01/2007		PG-ISSUE	PG-Pub Issue Notification			0	
14	01/04/2007		DOCK	Case Docketed to Examiner in GAU			0	
13	12/01/2006		TSSCOMP	IFW TSS Processing by Tech Center Complete			0	
12	11/17/2006		OIPE	Application Dispatched from OIPE			0	
11	11/17/2006		COMP	Application Is Now Complete			0	
10	07/27/2006		ADDFLFEE	Additional Application Filing Fees			0	
9	07/27/2006		OATHDECL	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic			0	
8	03/19/2006		L128	Cleared by L&R (LARS)			0	
6	03/09/2006		L198	Referred to Level 2 (LARS) by OIPE CSR			0	
5	03/09/2006		CLSS	CASE CLASSIFIED BY OIPE			0	
4	03/09/2006		CRFE	CRF Is Good Technically / Entered into Database			0	
3	03/04/2006		SCAN	IFW Scan & PACR Auto Security Review			0	
2	02/22/2006		CRFL	CRF Disk Has Been Received by Preexam / Group / PCT			0	
1	02/22/2006		IEXX	Initial Exam Team nn			0	

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Action 1

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MAILED

NOV 1 7 2010

OFFICE OF PETITIONS

In re Application of

Gainer et al.

Application No. 11/361,054

Filed: February 24, 2006

Attorney Docket No. 4112-42

**ON PETITION** 

This is a decision on the petition under 37 CFR 1.102(c)(1), filed October 27, 2010, to make the above-identified application special based on applicant's age as set forth in M.P.E.P. § 708.02, Section IV.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section IV: Applicant's Age must be accompanied by evidence showing that at least one of the applicants is 65 years of age, or more, such as a birth certificate or a statement by applicant. No fee is required.

The instant petition includes a statement from the applicant's attorney. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-3206. All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

This matter is being referred to the Technology Center Art Unit 1621 for action on the merits commensurate with this decision.

Liana Walsh

Petitions Examiner Office of Petitions

(anawabet

Doc Code: PET.PTA.RCAL

Document Description: Request for Recalculation in view of Wyeth

PTO/SB/131 (01-10) Approved for use through 02/28/2011. OMB 0851-0020

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

Attorney Docket Number: 020517	Patent Number: 7,660,658
Filing Date (or 371(b) or (f) Date): 02-23-2006	Issue Date: 02-09-2010
First Named Inventor: LEONID SHEYNBLAT	

Title: APPARATUS AND METHODS FOR SPEED MANAGEMENT AND CONTROL

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-WYETH INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

Signature / Musik / U/	<sub>Date</sub> 07-27-2010			
Name (Print/Typed) Ashish L. Patel	Registration Number 53440			
Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below*.				
*Total of forms are submitted.				

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. BO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

## **Privacy Act Statement**

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

- The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
- A record from this system of records may be disclosed, as a routine use, in the course of
  presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to
  opposing counsel in the course of settlement negotiations.
- A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
- 4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
- A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
- A record in this system of records may be disclosed, as a routine use, to another federal
  agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to
  the Atomic Energy Act (42 U.S.C. 218(c)).
- 7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
- 8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
- A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



## United States Patent and Trademark Office

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Mail Date: 08/11/2010

QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121

Applicant : Leonid Sheynblat

Patent Number: 7660658 Issue Date : 02/09/2010 Application No: 11/361,221

Filed : 02/23/2006 : DECISION ON REQUEST FOR : RECALCULATION of PATENT

: TERM ADJUSTMENT IN VIEW

: OF WYETH AND NOTICE OF INTENT TO

: ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 641 days. The USPTO will sua sponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

		R CERTIFICATE OF CORRECTION Paper No.:
DATE	:05-07-11	<del></del>
TO SPE OF	: ART UNIT	
SUBJECT	: Request for Certificate of Correction	on for Appl. No.: <u>11/361271</u> Patent No.: <u>7708279</u>
Please resp	ond to this request for a certif	CofC mailroom date: 06-15-11 icate of correction within 7 days.
FOR IFW F	ILES:	
the IFW app	ew the requested changes/collication image. No new matte the claims be changed.	rrections as shown in the <b>COCIN</b> document(s) in er should be introduced, nor should the scope o
	plete the response (see below nent code <b>COCX</b> .	v) and forward the completed response to scanr
FOR PAPE	R FILES:	
		rrections as shown in the attached certificate of ee below) and forward it with the file to:
Certificates of Correction Brand Randolph Square – 9D10-A Palm Location 7580		Angela Green Certificates of Correction Brane
		(703) 756-1541
Thank You	For Your Assistance	
•	et for issuing the above-iden n on the appropriate box.	tified correction(s) is hereby:
	× Approved	All changes apply.
Σκχ		Specify below which changes do not apply.
	Approved in Part	Specify below which changes do not apply.
	Approved in Part  Denied	State the reasons for denial below.

/Vishu K. Mendiratta/



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PILLSBURY WINTHROP SHAW PITTMAN LLP ATTENTION: DOCKETING DEPARTMENT P.O BOX 10500 McLean VA 22102 MAILED

APR 1 9 2011

OFFICE OF PETITIONS

In re Patent No. 7,915,549 Issued: March 29, 2011 Application No.: 11/361,315

Filed: February 24, 2006

Attorney Docket No: 032177-0326178

**NOTICE** 

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Petitions Attorney Office of Petitions



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
11/361,316	02/24/2006	Daniel Pinkel	UCOTP124X8D2C3US	1722	
22434 Weaver Austin	7590 06/10/2011 Villeneuve & Sampson L	EXAMINER			
P.O. BOX 70250			STRZELECKA, TERESA E		
OAKLAND, CA 94612-0250			ART UNIT	PAPER NUMBER	
			1637		
			NOTIFICATION DATE	DELIVERY MODE	
			06/10/2011	ELECTRONIC	

# Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@wavsip.com

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

June 8, 2011

Weaver Austin Villeneuve & Sampson LLP P.O. BOX 70250 OAKLAND CA 94612-0250	
In re Application of PINKEL, DANIEL, ET AL. Application No. 11/361316 Filed: 02/24/2006 Attorney Docket No: UCOTP124X8D2C3U	: : DECISION ON PETITION : US
This is a decision on the Petition to Accept Colo in the United States Patent and Trademark Offic	r Drawings under 37 C.F.R 1.84 (a) (2), received e (USPTO) March 20, 2006.
The petition is <b>DISMISSED</b> .	
A grantable petition under 37 C.F.R. 1.84(a) (2)	must be accompanied by the following.
3. The specification containing the foll	17(h), in question, (One (1) set for EFW filings, and owing language as the first paragraph in that to the brief description of the drawings
Copies of this patent or patent applic	ins at least one drawing executed in color. cation publication with color drawing(s) will est and payment of the necessary fee."
The petition did not meet the following requirem A renewed petition filed under 37 C.F.R. 1.84 (of this decision. If a renewed petition is not file the drawings will be printed in black and white	a) (2) must be filed within TWO (2) MONTHS

Telephone inquires relating to this decision may be directed to the undersigned in the Office of Data Management at 571-576-1565.

/Bernadette Queen/ Quality Control Specialist Office of Data Management Publications Branch

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Siemens Corporation Intellectual Property Department 170 Wood Avenue South Iselin NJ 08830

**MAILED** 

AUG 02 2010

**OFFICE OF PETITIONS** 

In re Application of

John Blackford, et al.

Application No. 11/361,401

Filed: February 24, 2006

Attorney Docket No. 2006P03590US

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 21, 2010, to revive the above-identified application.

## The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, January 21, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on April 22, 2009. The Notice of Abandonment was mailed July 29, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of \$1,620, and (3) a proper statement of unintentional delay.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney document must be submitted. While a courtesy copy of this decision is being mailed to the person signing the petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

Telephone inquiries concerning this decision should be directed to Terri Johnson at (571) 272-2991.

This application is being referred to Technology Center AU 2416 for appropriate action by the Examiner in the normal course of business on the reply received

Terri Johnson
Petitions Examiner
Office of Petitions

cc:

Barry L. Keimachter BACHMAN & LAPOINTE, P.C. 900 Chapel Street, Suite 1201 New Haven, CT 06510



#### UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED JUL 22 2011

**OFFICE OF PETITIONS** 

QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO CA 92121

In re Patent No. 7,940,908

Sprigg et al.

Issue Date: 05/10/2011 Application No. 11/361,406

Filed: 02/23/2006

Atty. Docket No. 050713

: DECISION ON REQUEST FOR

: RECONSIDERATION OF

: PATENT TERM ADJUSTMENT AND

: NOTICE OF INTENT TO ISSUE

CERTIFICATE OF CORRECTION

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)", filed July 8, 2011, requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand two hundred forty-two (1242) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is GRANTED to the extent indicated herein. The term of the above-identified patent is extended or adjusted by one thousand three hundred eighty-eight (1388) days.

Patentees do not dispute the calculation of 892 days of A delay and 660 days of B delay. However, patentees dispute the reduction of 51 days associated with the filing of the 312 Amendment on March 21, 2011, after the mailing of the notice of allowance pursuant to 37 CFR 1.704(c)(10). Specifically, patentees assert that the Examiner acted on the 312 Amendment and mailed a responsive communication on April 13, 2011. Patentees contend that they should have been assessed 24 days of applicant delay (not 51 days) for the period beginning on the filing date of the 312 Amendment, March 21, 2011, and ending on

the mailing date of the Supplemental Notice of Allowability in response to the amendment, April 13, 2011. See 37 CFR 1.704(c)(10).

Patentees' contention is well taken. A review of the application history confirms that patentees' calculation of the period of reduction of patent term under 37 CFR 1.704(c)(10) for the filing of the 312 Amendment on March 21, 2011, is correct. Therefore, the period of reduction of 51 days will be removed and a period of reduction of 24 days will be entered.

Additionally, patentees disclose that they believe that the period of overlap between A delay and B delay of 74 days is incorrectly calculated and should be 220 days. The Office thanks patentees for their candor; however, patentees' disclosure that the period of overlap is 220 days is not warranted. A further review of the calculation of the period of overlap reveals that the overlapping period is 74 days.

Accordingly, the patent term adjustment is 1338 days (892 days of A delay + 660 days of B delay - 74 days of overlap - 90 days of applicant delay).

The Office will sua sponte issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentee is given one (1) month or thirty (30) days, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office will charge the Deposit Account for the \$200.00 fee set forth in 37 CFR 1.18(e) as authorized. No additional fees are required.

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction. The Office

will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one thousand three hundred eighty-eight (1388) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Partera Donnell

Christina Tartera Donnell Senior Petitions Attorney Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

## **DRAFT COPY**

## UNITED STATES PATENT AND TRADEMARK OFFICE **CERTIFICATE OF CORRECTION**

PATENT

: 7,940,908 B2

DATED

: May 10, 2011

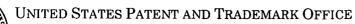
INVENTOR(S): Sprigg et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

Subject to any disclaimer, the term of this patent is extended or adjusted [\*] Notice: under 35 USC 154(b) by (1361) days.

Delete the phrase "by 1361 days" and insert - by 1388 days--





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## MAILED

Fish & Richardson PC P.O.Box 1022 Minneapolis MN 55440

JAN 3 0 2012

OFFICE OF PETITIONS

In re Patent No. 8,065,393 Chandra et al.

Issue Date: November 22, 2011 Application No. 11/361,442 Filed: February 24, 2006 Attorney Docket No. 100101-

01700US

Title: METHOD AND SYSTEM FOR OBVIATING REDUNDANT ACTIONS IN

A NETWORK

: DECISION ON REQUEST FOR

: RECONSIDERATION OF

: PATENT TERM ADJUSTMENT

This is a decision on the petition filed on January 20, 2012, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand three hundred seventy-six (1,376) days.

The request for reconsideration of the patent term adjustment (PTA) pursuant to 37 CFR 1.705(d) is **DISMISSED**.

The above-identified application matured into U.S. Pat. No. 8,065,393 on November 22, 2011. The patent issued with a patent term adjustment of 1250 days. The instant application for patent term adjustment was timely filed in accordance with 37 CFR 1.705(d). Patentees contest the period of adjustment of 352 days accorded pursuant to 37 CFR 1.702(b) and assert that the correct period of adjustment under 37 CFR 1.702(b) is 478 days.

Petitioner's arguments have been carefully considered, but are not persuasive. The period of adjustment pursuant to 37 CFR 1.702(b) was properly calculated at 352 days.

35 USC 154(b)(1)(B) states in relevant part:

2

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including - (i) any time consumed by continued examination of the application requested by the applicant under section 132(b).

## 37 CFR 1.702(b) states in relevant part:

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including: (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b).

#### 37 CFR 1.703(b) states in relevant part:

The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods: (1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

Counting the period of time excluded from the "B delay" for the filing of a request for continued examination under 35 U.S.C. 132(b), from the date on which the request for continued examination is filed to the date the patent is issued is proper. Patentee does not dispute that time consumed by continued examination of an application under 35 U.S.C. 132(b) is properly excluded and that the calculation of the excluded period begins on the date of filing of the request for continued examination. At issue is what further processing or examination beyond the date of filing of the request for continued examination is time consumed by continued examination of the application under 35 U.S.C. 132(b). The USPTO indicated in September of 2000 in the

final rule to implement the patent term adjustment provisions of the AIPA that once a request for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114 is filed in an application, any further processing or examination of the application, including granting of a patent, is by virtue of the continued examination given to the application under 35 U.S.C. 132(b) and CFR 1.114.

See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56365, 56376 (Sept. 18, 2000) (response to comment 8). Thus, the excluded period begins with the filing of the request for continued examination and ends with the issuance of the patent.

Patentees' argument that the period of time after the issuance of a notice of allowance on a request for continued examination is not "any time consumed by continued examination requested by the applicant under section 132(b)" within the meaning of 35 U.S.C. 154(b)(1)(B)(i) is not availing. This limitation is not supported by the statutory language. Garcia v. United States, 469 U.S. 70, 75 (1984) ("only the most extraordinary showing of contrary intentions from [legislative history] would justify a limitation on the 'plain meaning' of the statutory language"). BP Am. Prod. Co. v. Burton, 549 U.S. 84, 91 (2006) ("Unless otherwise defined, statutory terms are generally interpreted in accordance with their ordinary meaning"). The statute provides for a guarantee of no more than 3-year application pendency, by providing for an adjustment in the patent term:

First, "Subject to the limitations of paragraph (2)," means that the limitations of paragraph 2 apply to this paragraph's adjustment of patent term. That is, the day-to-day extension of patent term for pendency beyond the 3 year period is restricted as follows: 1) "B delay" cannot accrue for days of "A delay" that overlap, 2) the patent term cannot be extended beyond disclaimed term, and 3) the period of adjustment, including accrued "B delay," will be reduced for applicant delay.

Second, "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States," meaning that the condition must first occur that the issuance of an original patent (35 U.S.C. 153), not merely the issuance of a notice of allowance, is delayed due to the Office's failure to issue a

patent (sign and record a patent grant in the name of the United States), not merely mail a notice of allowance, within 3 years after the actual filing date of the application in the United States. This provision gives the Office a three-year period to issue a patent (sign and record a patent grant in the name of the United States) after the application filing date before an adjustment will accrue for "B delay."

Third, "not including- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b); (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), meaning that the three-year period does not include "any time consumed by" or "any delay in processing," as specified in clauses (i)-This language correlates to 35 U.S.C. 154(b)(1)(A) which likewise provides the basis for determining the period given the Office to take the specified actions before an adjustment will accrue for "A delay" (e.g., extended for 1 day after the day after the period specified in clauses (i)-(iv)).

Furthermore, these clauses are interpreted using their ordinary Nonetheless, the context of the legislation should be As stated in Wyeth v. Dudas, No. 07-1492, 2008 U.S. Dist. LEXIS 76063 (D.D.C., September 30, 2008), because the clock for calculating the 20-year patent term begins to run on the filing date, and not on the day the patent is actually granted, some of the effective term of a patent is consumed by the time it takes to prosecute the application. To mitigate this First, "Subject to the limitations of paragraph (2)," means that the limitations of paragraph 2 apply to this paragraph's adjustment of patent term. That is, the day-to-day extension of patent term for pendency beyond the 3 year period is restricted as follows: 1) "B delay" cannot accrue for days of "A delay" that overlap, 2) the patent term cannot be extended beyond disclaimed term, and 3) the period of adjustment, including accrued "B delay," will be reduced for applicant delay.

Thus, not including "any time consumed by" means not including any days used to prosecute the application as specified in

5

clauses (i)-(ii)1. Clause (i) specifies "any time consumed by continued examination of the application requested by the applicant under section 132(b)." Clause (ii) specifies "any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court." "Time" in the context of this legislation throughout refers to days. "Consumed by" means used by or used in the course of. Collegiate Dictionary, (11th ed.). The "any" signifies that the days consumed by are "any" of the days in the pendency of the application, and not just days that occur after the application has been pending for 3 years. As such, "any time consumed by" refers to any days used in the course of 1) continued examination of the application under section 132(b) (the filing of a request for continued examination), 2) interference proceedings, 3) secrecy orders, and 4) appellate review. that 3-year period given to the Office to issue a patent before an adjustment will accrue for "B delay" does not include any days used in the course of or any time consumed by clauses (i)-(ii), including any time consumed by the filing of a request for continued examination.

Fourth, "the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued" meaning that the consequence of this failure is that after "the end of that 3-year period" an additional 1 day of patent term will accrue for each day that the application is pending until the day the patent is issued. effect, the statute, inter alia, grants adjustments of patent term whenever the patent prosecution takes more than three years, regardless of the reason. The time consumed by prosecution of the application includes every day the application is pending before the Office from the actual filing date of the application in the United States until the date of issuance of the patent. The time it takes to prosecute the

Clause (iii) provides for not including (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued. It is noted that paragraph (3)(C) allows with an adequate showing by applicant for reinstatement of no more than 3 months of the patent term reduced for applicant delay in taking in excess of three months to respond.

application ends not with the mailing of the notice of allowance, but with the issuance of the patent.

The "time consumed by" or used in the course of the continued examination of the application requested by the applicant under section 132(b) does not end until issuance of the patent. U.S.C. 132(b) was enacted under the same title, the "American Inventors Protection Act of 1999," as 35 U.S.C. 154(b). 4403 of the AIPA amended 35 U.S.C. § 132 to provide, at the request of the applicant, for continued examination of an application for a fee (request for continued examination or RCE practice), without requiring the applicant to file a continuing application under 37 CFR 1.53(b) or a continued prosecution application (CPA) under 37 CFR 1.53(d). Thus, clause (i) is different from clause (ii) in that clause (i) refers to an examination process whereas clause (ii) refers to time consumed by proceedings (interferences, secrecy orders and appeals) in an application.

By nature, the time used in the course of the examination process continues to issuance of the patent. The examination process involves examining the application to ascertain whether it appears that the applicant is entitled to a patent under the See 35 U.S.C. 131 ("[t]he Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor"). If on examination it appears that the applicant is entitled to a patent, the USPTO issues a notice of allowance. See 35 U.S.C. 151 ("[i]f it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant"). If on examination it appears that the applicant is not entitled to a patent, the USPTO issues a notice (an Office action) stating the applicable rejection, objection, or other requirement, with the reasons therefor. See 35 U.S.C. 132 ("[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application"). Neither the issuance of a notice of allowance nor the insurance of an Office action terminates the examination process. If after the issuance of an Office action under 35 U.S.C. 132 it

subsequently appears that the applicant is entitled to a patent (e.g., in response to an argument or amendment by the applicant), the USPTO will issue a notice of allowance. Conversely, if after the issuance of a notice of allowance under 35 U.S.C. 151 it subsequently appears that the applicant is not entitled to a patent (e.g., in response to information provided by the applicant or uncovered by the USPTO), the USPTO will withdraw the application from issuance and issue an Office action under 35 U.S.C. 132 stating the applicable rejection, objection, or other requirement, with the reasons therefor.

As held in <u>Blacklight Power</u>, the USPTO's responsibility to issue a patent containing only patentable claims does not end with the issuance of a notice of allowance under 35 U.S.C. 151. See <u>BlackLight Power</u>, Inc. v. Rogan, 295 F.3d 1269, 1273 (Fed. Cir. 2002). Rather, if there is any substantial, reasonable ground within the knowledge or cognizance of the Director as to why an application should not issue, it is the USPTO's duty to refuse to issue the patent even if a notice of allowance has previously been issued for the application. See <u>In re Drawbaugh</u>, 9 App. D.C. 219, 240 (D.C. Cir 1896).

Moreover, the applicant continues to be engaged in the examination process after the mailing of the notice of allowance. 37 CFR 1.56 makes clear that the applicant has a duty to disclose information material to patentability as long as the application is pending before the USPTO (i.e., until a patent is granted or the application is abandoned). See 37 CFR 1.56(a) ("[t]he duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned"). 37 CFR 1.97 and 1.98 provide for the consideration of information submitted by the applicant after a notice of allowance has been mailed. See 37 CFR 1.97(d). In addition, 37 CFR 1.312 provides for the amendment of an application after a notice of allowance has been mailed. In fact, the request for examination procedures2 permit the filing of a request for continued examination under 37 CFR 1.114 even after the issuance of a notice of allowance under 35 U.S.C. 151. See 37 CFR 1.114(a)(1).

As the examination process does not terminate with the mailing of the notice of allowance, the time consumed by continued

Thus, on occasion, even where a request for continued examination has already been filed and a notice of allowance issued pursuant to that request, applicant may file a further request for continued examination.

examination requested by the applicant under section 132(b) does not terminate with the mailing of the notice of allowance. All the time the application is pending from the date of filing of the request for continued examination to the mailing of the notice of allowance through issuance of the patent is a consequence of the filing of the request for continued examination. Further action by the Office is pursuant to that request. Applicant has gotten further prosecution of the application without having to file a continuing application under 37 CFR 1.53(b).

All of the continued examination pursuant to the filing of the request by the applicant is properly excluded from the delay attributed to the Office. 35 U.S.C. 154(b)(1)(B)'s guarantee of a total application pendency of no more than three years provides for adjustment of the patent term for delay due to the Office's failure to issue the patent within three years, but does not include "any time consumed by continued examination requested by the applicant under 35 U.S.C. 132(b)." It is not necessary to mitigate the effect on the 20-year term to the extent that applicant has requested that the Office continue to examine the application via a request for continued examination, in lieu of, the filing of a continuing application under 37 CFR 1.53(b).

In view thereof, no adjustment to the patent term will be made.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3215.

Charlema Grant

Attorney Advisor

Office of Petitions

Chloren Gland

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Quinn Emanuel Urquhart'& Sullivan, LLP 865 S. FIGUEROA STREET, 10TH FLOOR LOS ANGELES CA 90017

MAILED

DEC 1-6 2010

In re Application of

Mii et al.

OFFICE OF PETITIONS

Application No. 11/361,640

Filed: February 24, 2006

Attorney Docket No. 85A 3804

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed October 22, 2010.

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended. to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

This application is being forwarded to art unit 1735 for processing in the normal course of business.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3215.

Charlema Grant

**Petitions Attorney** 

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

LEVINE BAGADE HAN LLP 2400 Geng Road, Suite 120 Palo Alto, CA 94303

**MAILED** 

SEP 2.7 2010

OFFICE OF PETITIONS

In re Application of

Jonathan A. Smith, et al.

Application No. 11/361,704

Filed: February 24, 2006 TO WITHDRAW Attorney Docket No. ARMUNA00600

**DECISION ON PETITION** 

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 24, 2010.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to Levine Bagade Han LLP has been revoked by the assignee of the patent application on September 15, 2010. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to Terri Johnson at 571-272-2991.

**Petitions Examiner** Office of Petitions

cc:

**BAYER MATERIAL SCIENCE LLC** 100 BAYER ROAD **PITTSBURGH PA 15205** 



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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AMGEM INC.
MAIL STOP 28-2-C
ONE AMGEN CENTER DRIVE
THOUSAND OAKS, CA. 91320-1799

MAILED

JUN 13 2011

OFFICE OF PETITIONS

In re Application of

DANIEL J. FREEMAN et al

Application No. 11/361,711

Filed: February 23, 2006

Attorney Docket No. A-999-US-NP

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR § 1.137(b), filed June 9, 2011, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before May 28, 2011, as required by the Notice of Allowance and Fee(s) Due, mailed February 28, 2011. Accordingly, the date of abandonment of this application is May 29, 2011.

The petition satisfies the requirements of 37 CFR § 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of \$1510.00 and the publication fee of \$300.00, (2) the petition fee of \$1620.00; and (3) an adequate statement of unintentional delay.

37 CFR § 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR § 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is **not** a correct reading of the statement appearing in the petition.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP § 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-0602.

This application is being referred to Publishing Division for processing into a patent.

Thurman K. Page Petitions Examiner Office of Petitions

cc: US PATENT OPERATIONS/SNB DEPT. 10200, M/S 28-2-C AMGEN INC. ONE AMGEN CENTER DRIVE THOUSAND OAKS, CALIFORNIA 91320-1799



COMMISSIONER FOR PATENTS UNITED STATES PATENT AND TRADEMARK OFFICE P.O. Box 1450 ALEXANDRIA, VA 22313-1450

MIDDLETON & REUTLINGER 2500 BROWN & WILLIAMSON TOWER **LOUISVILLE KY 40202** 

MAILED

AUG 3 0 2010

In re Application

Navarro, et al.

OFFICE OF PETITIONS

Application No. 11/361,733

: PATENT TERM ADJUSTMENT

Filed: February 24, 2006

Dkt. No.: ZP193/09010

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) AND 35 U.S.C. § 154," filed July 8, 2010.

Applicant submits that the correct patent term adjustment to be indicated on the patent is 1,141 days, not 551 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent.

Insofar as the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See, § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the

patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee<sup>1</sup>.

Receipt is hereby acknowledged of the required patent term adjustment application fee under 37 CFR 1.705(b) of \$200.00. See, 37 CFR 1.18(e).

However, any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The application file is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

<sup>&</sup>lt;sup>1</sup> For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown Petitions Attorney Office of Petitions

CC: ERIC L. KILLMEIER
401 SOUTH FOURTH STREET
2600 BROWN & WILLIAMSON TOWER
LOUISVILLE, KY 40202



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

SLATER & MATSIL, L.L.P. 17950 PRESTON RD, SUITE 1000 DALLAS TX 75252-5793

MAILED

SEP 2 8 2010 OFFICE OF PETITIONS

In re Application of Sriram CHANDRASEKARAN Application No. 11/361,742 Patent No. 7,176,662

Filed: February 23, 2006

Attorney Docket No. CDW-002

NOTICE UNDER 37 CFR. 1.28(c)

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

The Office no longer investigates or rejects original or reissue patent under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Inquiries related to this communication should be directed to Michelle R. Eason at (571) 272-4231.

Thurman K. Page 6

Petitions Examiner Office of Petitions

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Ansel M. Schwartz Attorney at Law Suite 304 201 N. Craig Street Pittsburgh PA 15213

MAILED

DEC 1 9 2011

OFFICE OF PETITIONS

In re Application of

Perlin

Application No. 11/361,748

Filed: February 24, 2006

Attorney Docket No. KPER-8

For: METHOD AND APPARATUS FOR CREATING A COMPUTER SIMULATION OF

AN ACTOR

ON PETITION

This is a decision on the petition, filed November 10, 2011 (certificate of mailing date November 7, 2011), under 37 CFR 1.137(b) to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely submit a reply within three (3) months of the mailing of the March 11, 2011 non-final Office action. No response being received and no extensions of time being obtained under the provisions of 37 CFR 1.136(a), this application became abandoned on June 12, 2011. A Notice of Abandonment was mailed on October 17, 2011.

Applicant has submitted an amendment in reply to the March 11, 2011 non-final Office action, an acceptable statement of the unintentional nature of the delay in responding to the March 11, 2011 non-final Office action, and the \$930.00 petition fee. All of the requirements under 37 CFR 1.137(b) being met, the petition is granted.

After the mailing of this decision, the application will be returned to Technology Center AU 2628 for consideration of the amendment filed on November 10, 2011 (certificate of mailing date November 7, 2011).

Telephone inquiries should be directed to the undersigned at (571) 272-3230.

Shure Willis Brantley Senior Petitions Attorney

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

C. JAMES BUSHMAN 5851 SAN FELIPE SUITE 975 HOUSTON TX 77057

MAILED

MAR 032011
OFFICE OF PETITIONS

In re Application of

Bull et al.

Application No. 11/361,760

Filed: February 24, 2006

Attorney Docket No. V&M-139-3

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 11, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a proper and timely manner to the final Office action mailed, July 2, 2010, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on October 3, 2010. A Notice of Abandonment was mailed February 14, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of \$810.00 and the submission required by 37 CFR 1.114; (2) the petition fee of \$1,620.00; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

This matter is being referred to Technology Center AU 3754 for processing of the Request for Continued Examination under 37 CFR 1.114 and the Amendment filed with the instant petition.

Yoan Olszewški
Petitions Examiner
Office of Petitions





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Vierra Magen Marcus & DeNiro LLP 575 Market Street, Suite 2500 San Francisco CA 94105

MAILED

SEP 2 1 2010

OFFICE OF PETITIONS

In re Patent No. 7,752,303 Issue Date: July 6, 2010

Application No. 11/361,815 Filed: February 23, 2006

Attorney Docket No. WILY-01038US0

**DECISION ON PETITION** 

This is a decision on the Request To Correct Assignee Under 37 C.F.R. §3.81(b), filed on August 6, 2010, which is being treated as a Petition Under 37 CFR §3.81(b) to correct assignee's name and residence. A completed Certificate of Correction Form (PTO/SB/44) was submitted with the petition.

The petition under 37 CFR §3.81(b) is **GRANTED**.

Petitioner requests that the present Petition was submitted to correct assignee's name and residence on the previously submitted PTOL 85B and that such error was inadvertent. Accordingly, petitioner requests, in effect, that the Title Page of the above-identified patent be corrected, via issuance of Certificate of Correction, to correct assignee's name and residence identified thereon from:

"Wily Technology, Inc., Brisbane, CA (US)"

to:

-- Computer Associates Think, Inc., Islandia, New York (US)--

37 CFR 3.81(b), effective June 25, 2004, reads:

After payment of the issue fee: Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in  $\S 3.11$  before issuance of the patent, and must include a request for a certificate of correction under  $\S 1.323$  of this chapter (accompanied by the fee set forth in  $\S 1.20(a)$  and the processing fee set forth in  $\S 1.17(i)$  of this chapter.

U.S. Patent No. 7,752,303 Application No. 11/361,815 Decision on Petition under 37 CFR 3.81

The requisite \$100.00 fee (Fee Code 1811), as set forth under 37 CFR 1.20(a), and the requisite \$130.00 processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(i), have been submitted. Further, Office assignment records are consistent with the requested correction. Accordingly, since the Petition complies with the provisions of 37 CFR 3.81(b), it is appropriate for the Office to issue a Certificate of Correction in accordance with the content of the Form PTO/SB/44 submitted with Petition.

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

Any questions concerning the issuance of a Certificate of Correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,752,303.

Cheryl Gibson-Baylor Benjlow

Petitions Examiner
Office of Petitions

# United States Patent and Trademark Office

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

IAN FINCHAM MCFADDEN, FINCHAM SUITE 606 - 225 METCALFE STREET OTTAWA, ONTARIO K2P1P-9 CA CANADA

MAILED JAN 13 2012

OFFICE OF PETITIONS

In re Application of

Arnold Kastner

Application No. 11/361914

Filing or 371(c) Date: 02/23/2006

Patent No. 7385375

Issue Date: 06/10/2008

Title of Invention:

CONTROL CIRCUIT FOR A DEPLETION:

MODE SWITCH AND METHOD OF :

OPERATING THE SAME

ON PETITION

This is a notice regarding request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods Attorney Office of Petitions



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
11/361,977	02/24/2006	John R. McDonald	3800007.00006 / 601F	3379
77202 Y. O. Y. C. A. T. Y.	7590 08/03/2011		EXAM	IINER
K&L Gates LL 3580 Carmel N			XIE, XIA	OZHEN
Suite 200 San Diego, CA	. 02130		ART UNIT	PAPER NUMBER
San Diego, CA			1646	
			MAIL DATE	DELIVERY MODE
			08/03/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



AUG 03 2011

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

K&L Gates LLP 3580 Carmel Mountain Road Suite 200 San Diego CA 92130

In re Application of: McDonald et al.

Serial No.: 11/361,977 Filed: February 24, 2006

Attorney Docket No: 3800007.00006 /

601F

: PETITION DECISION

This is in response to the petition filed on January 7, 2011 under 3 7 CFR 1.181 to correct the misclassification of submitted Information Disclosure Statements. Specifically, applicants request correction of the classification in PAIR of the Information Disclosure Statements submitted on October 18, 2007; July 10, 2008; and December 14, 2009 in connection with the above-referenced application and consideration by the Examiner of the documents and information contained therein.

Applicants argue the "Information Disclosure Statements were submitted in connection with the above-captioned application on October 18, 2007; July 10, 2008; and December 14, 2009. Each Information Disclosure Statement was prepared in accordance with 37 C.F.R 1.97 and 1.98. As required under 37 C.F.R 1.98, each Information Disclosure Statement contained 1) a list of all patents, publications, applications, or other information submitted for consideration by the Office, including a column that provides a space next to each document to be considered, for the examiner's initials and a heading that clearly indicates that the list is an Information Disclosure Statement; and 2) legible copies of all items listed. The items either were in English or a translation was provided. A copy of the misclassified Information Disclosure Statements filed on October 18, 2007; July 10, 2008; and December 14, 2009 is attached.

The submitted Information Disclosure Statement included a tabular Form PTO-1449, which was classified as an "IDS," and a written disclosure of information. In each instance, the written disclosure of information was misclassified in PAIR as a "Transmittal Letter" (October 18, 2007, "Transmittal Letter" of 3 pages; July 10, 2008, "Transmittal Letter" of 4 pages; and December 14, 2009, "Transmittal Letter" of 2 pages). Consequently the information contained therein may not be considered or reviewed by the Examiner."

Applicants' argument has been accorded careful consideration and is persuasive. PAIR will be corrected to reflect the misclassification of the submitted Information Disclosure Statements of October 18, 2007; July 10, 2008; and December 14, 2009.

#### **DECISION**

The petition is **GRANTED**.

The examiner is instructed to consider the IDS of October 18, 2007; July 10, 2008; and December 14, 2009 which was misclassified in PAIR as a "Transmittal Letter" (October 18, 2007, "Transmittal Letter" of 3 pages; July 10, 2008, "Transmittal Letter" of 4 pages; and December 14, 2009, "Transmittal Letter" of 2 pages).

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 571-273-8300.

/MC Seidel/ Marianne C. Seidel, Quality Assurance Specialist Technology Center 1600



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/04/2010

BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314-1176

Applicant : Chi-Hsi Su : DECISION ON REQUEST FOR Patent Number: 7649934 : RECALCULATION of PATENT

Issue Date : 01/19/2010 : TERM ADJUSTMENT IN VIEW **Application No:** 11/362,075 : OF WYETH AND NOTICE OF INTENT TO Filed : 02/27/2006 : ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 969 days. The USPTO will sua sponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MAILED

NOV 172010

OFFICE OF PETITIONS

ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036

In re Application of Kiichiro Iga

Application No. 11/362,153 : ON PE

Filed: February 27, 2006

Attorney Docket No. 108075-00183

ON PETITION

This is a decision on the petition, filed November 16, 2010 under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on October 21, 2010 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 2622 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/ Irvin Dingle Petitions Examiner Office of Petitions

<sup>&</sup>lt;sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/03/2010

ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036

Applicant : Hisakatsu Yamaguchi : DECISION ON REQUEST FOR

Patent Number: 7653169 : RECALCULATION of PATENT Issue Date : 01/26/2010 : TERM ADJUSTMENT IN VIEW

Application No: 11/362,174 : OF WYETH AND NOTICE OF INTENT TO Filed : 02/27/2006 : ISSUE CERTIFICATE OF CORRECTION

: 1550E CERTIFICATE OF CORRECTIO

:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 916 days. The USPTO will suasponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BAKER & HOSTETLER LLP WASHINGTON SQUARE, SUITE 1100 1050 CONNECTICUT AVE. N.W. WASHINGTON, DC 20036-5304

MAILED

AUG 1 6 2010

**OFFICE OF PETITIONS** 

In re Application of

**Eddy Laudwig** 

Application No. 11/362,262

Filed: February 27, 2006

Attorney Docket No. 87367.2820

DECISION ON PETITION TO WITHDRAW

FROM RECORD

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 27, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office will require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, which the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any replies that may be due and the time frame within which the client must respond, pursuant to 37 CFR 10.40 (c).

The request was signed by Adam M. Treiber, on behalf of the practitioners of record associated with Customer Number 30734.

Customer Number 30734 has been withdrawn as attorney of record. Applicant is reminded that there is no attorney of record at this time.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

There is an outstanding Office action mailed May 27, 2010, that requires a reply from the applicant.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-6059. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Alicia Kelley Petitions Examiner Office of Petitions

cc: B.T. INNOVATIONS INC. 2455 RUE COURSOL

QUEBEC G2B 5E9 CA



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS PO. DOX 1450 Alexandria, Virginia 22313-1450

APPLICATION NUMBER

FILING OR 371(C) DATE

FIRST NAMED APPLICANT

ATTY. DOCKET NO./TITLE

11/362,262

02/27/2006

**Eddy Ludwig** 

87367.2820 CONFIRMATION NO. 1685

**POWER OF ATTORNEY NOTICE** 

30734
BAKER & HOSTETLER LLP
WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

Date Mailed: 08/16/2010

### NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 06/27/2010.

• The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

/atkelley/		

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY & POPEO, P.C. ONE FINANCIAL CENTER BOSTON MA 02111

MAILED

DEC 23 2010

**OFFICE OF PETITIONS** 

In re Application of

Kirtkow et al.

Application No. 11/362,304

ON PETITION

Filed: February 23, 2006

Attorney Docket No. 34874-032

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed December 7, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (and fee), (2) the petition fee of \$1620.00, and (3) a proper statement of unintentional delay.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the \$1110.00 extension of time fee submitted with the petition was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account as authorized.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206

This matter is being referred to Technology Center AU 2113 for processing of the Request for Continued Examination under 37 CFR 1.114 filed concurrently with the instant petition.

Liana Walsh

Petitions Examiner Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE NW, SUITE 800 WASHINGTON, DC 20037

MAILED

OCT 2 6 2010

OFFICE OF PETITIONS

In re Application of **Masaru TANABE** 

Application No. 11/362,353 Filed: February 27, 2006

Attorney Docket No. Q93471

**DECISION GRANTING PETITION** 

UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed October 25, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on September 30, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>

Telephone inquiries should be directed to the undersigned at (571) 272-7253.

This application is being referred to Technology Center AU 1721 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B - Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.



COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. 80x 1450
ALEXANDRIA, VA 22313-1450

Paper No.

CLINICAL DATA, INC. Attn: Amy Medel ONE GATEWAY CENTER SUITE 702 NEWTON MA 02458

# MAILED

AUG 1 2 2010

# OFFICE OF PETITIONS

In re Patent No. 7,618,962 : DECISION ON REQUEST

Wang et al. : FOR

Issue Date: November 17, 2009: RECONSIDERATION OF

Application No. 11/362,393 : PATENT TERM ADJUSTMENT

Filed: February 27, 2006 : and

Atty Docket No. ATL-006-US : NOTICE OF INTENT TO ISSUE

: CERTIFICATE OF CORRECTION

This is a decision on the petition filed on January 11, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by six hundred seventy-nine (679) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED** to the extent indicated herein. The patent term adjustment is corrected to indicate that the term of the above-identified patent is extended or adjusted by six hundred eighty (680) days.

The over three year pendency period is 263, not 262 days, counting the number of days beginning on February 28, 2009, the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a), and ending on November 17, 2009, the date of issuance of the patent. See 37 CFR 1.703(b). Considering the period of overlap of 45 days, the patent term adjustment is increased by 218 days to 680 days.

The Office will sua sponte issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given one (1) month or thirty (30) days, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by six hundred eighty (680) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Senior Petitions Attorney

Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

# UNITED STATES PATENT AND TRADEMARK OFFICE **CERTIFICATE OF CORRECTION**

**PATENT** 

: 7,618,962 B2

DATED

November 17, 2009

**DRAFT** 

INVENTOR(S): Wang et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 462 days

Delete the phrase "by 462 days" and insert - by 680 days--

		OR CERTIFICATE OF CORRECTION Paper No∴
DATE	02-26-11	
TO SPE OF	: ART UNIT <b>1795</b>	•
SUBJECT	: Request for Certificate of Correct	ction for Appl. No.: <u>11/362433</u> Patent No.: <u>7846306</u>
Please respo	and to this request for a ce	CofC mailroom date: 02-16-11 rtificate of correction within 7 days.
FOR IFW FIL	_ES:	
the IFW appl	w the requested changes/o lication image. No new ma he claims be changed.	corrections as shown in the <b>COCIN</b> document(s) in atter should be introduced, nor should the scope or
	plete the response (see be ent code COCX.	low) and forward the completed response to scanning
FOR PAPER	R FILES:	
	icates of Correction Brar	nch (CofC)
	olph Square – 9D10-A Location 7580	Angela Green Certificates of Correction Branch
Palm	Location 7580	Angela Green Certificates of Correction Branch (703) 756-1541
Palm Thank You	Location 7580 For Your Assistance	Certificates of Correction Branch (703) 756-1541
Palm  Thank You  The request	Location 7580 For Your Assistance	Certificates of Correction Branch
Palm  Thank You  The request	Location 7580  For Your Assistance  t for issuing the above-id	Certificates of Correction Branch (703) 756-1541
Thank You  The request  Note your decision	For Your Assistance  t for issuing the above-id on the appropriate box.	Certificates of Correction Branch (703) 756-1541 lentified correction(s) is hereby:
Thank You  The request Note your decision	For Your Assistance  t for issuing the above-id on the appropriate box.  Approved	Certificates of Correction Branch (703) 756-1541  lentified correction(s) is hereby:  All changes apply.
Thank You The request Note your decision	For Your Assistance  t for issuing the above-id on the appropriate box.  Approved  Approved in Part	Certificates of Correction Branch (703) 756-1541  lentified correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.

PTOL-306 (REV. 7/03)



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MARGARET ANDERSON 106 E. 6TH STREET, SUITE 900 AUSTIN TX 78701

MAILED
MAR 1 1 2011
OFFICE OF PETITIONS

In re Application of

Jung et al.

Application No. 11/362,440

Filed: February 24, 2006

Attorney Docket No. QQ1-0060US

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 26, 2011.

The request is **NOT APPROVED**.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest who properly became of record under 37 CFR 3.71, or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.

According to a review of current USPTO records petitioner has not requested the address be changed to a properly recorded assignee or the first listed inventor. The Customer Number 55922 is neither the first named inventor nor the assignee who properly became of record under 37 CFR 3.71 As such, all future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Further, the address given on the petition differs from the address of record. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Currently, a Notice of Panel Decision from Pre-Appeal Brief Review was mailed March 4, 2011 in the above-identified application.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-7751.

Joan Olszewski Petitions Examiner Office of Petitions

cc: LEE & HAYES, PLLC

601 W RIVERSIDE

**SUITE 1400** 

SPOKANE, WA 99201

	SPE RESPONSE	FOR CERTIFICATE OF CORRECTION
DATE	:11/30/10	Paper No
TO SPE OF	: ART UNIT	
SUBJECT		ection for Appl. No.: 11362441 Patent No.: 7475780
Please res	pond to this request for a ce	ertificate of correction within 7 days.
FOR IFW F	FILES:	vium / days.
	ew the requested changes/eation image. No new matter the claims be changed.	corrections as shown in the COCIN document(s) in the should be introduced, nor should the scope or
Please comusing documents	nplete the response (see bel ment code <b>COCX</b> .	low) and forward the completed response to scanning
FOR PAPE	R FILES:	
Please revi correction.	ew the requested changes/o Please complete this form (	corrections as shown in the attached certificate of see below) and forward it with the file to:
Palm	dolph Square 9D40-D Location 7580	Lamonte Newsome
		Certificates of Correction Branch
		571-272-3421
Thank You	For Your Assistance	3. 3. <del>2. 2 3. 2 .</del>
The reques Note your decision	t for issuing the above-ide	entified correction(s) is hereby:
囡	Approved	All changes apply.
. •	Approved in Part	Specify below which changes do not apply.
	Denied	State the reasons for denial below.
		- 1 de l'édection de l'étable pelow,
Comments:	· .	
Comments:		M.Y. 3728



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MARGARET ANDERSON 106 E. 6TH STREET, SUITE 900 AUSTIN TX 78701

MAILED

MAR 1 1 2011

OFFICE OF PETITIONS

In re Application of

Jung et al.

Application No. 11/362,541

Filed: February 24, 2006

Attorney Docket No. QQ1-0065US

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 26, 2011.

The request is **NOT APPROVED**.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest who properly became of record under 37 CFR 3.71, or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.

According to a review of current USPTO records petitioner has not requested the address be changed to a properly recorded assignee or the first listed inventor. The Customer Number 55922 is neither the first named inventor nor the assignee who properly became of record under 37 CFR 3.71 As such, all future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Further, the address given on the petition differs from the address of record. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Currently, there is an outstanding Office action mailed September 21, 2010 that requires a reply.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-7751.

Joan Olszewski Petitions Examiner Office of Petitions

cc: LEE & HAYES, PLLC

601 W RIVERSIDE

**SUITE 1400** 

SPOKANE, WA 99201



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Paper No.

FELDMAN LAW GROUP, P.C. 220 East 42nd Street, Suite 3304 NEW YORK NY 10017 **MAILED**AUG 1 5 2011

OFFICE OF PETITIONS

In re Application of

Joseph Joseph

Application No. 11/362,563 : DECISION ON PETITION

Filed: February 24, 2006 : PURSUANT TO

Title: BIOMETRIC IDENTIFICATION : 37 C.F.R. § 1.137(A)

AND SECURITY SYSTEM ASSOCIATED

WITH CASH REGISTER :

This is a decision on the petition filed on July 29, 2011, pursuant to 37 C.F.R. § 1.137(a), to revive the above-identified application.

This petition is GRANTED.

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed April 1, 2011, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue fees. Accordingly, the above-identified application became abandoned on July 2, 2011. A Notice of Abandonment was mailed on July 19, 2011.

A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R.
  § 1.17(1);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable

<sup>1</sup> See MPEP § 710.02(e)(III).

petition was unavoidable, and;

(4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

With this petition, Petitioner has submitted the issue fee. The petition fee will be charged to Deposit Account No. 06-0515 in due course, as authorized on the letter that was received on July 19, 2011 (which contains a certificate of mailing that has been signed by Petitioner and dated July 1, 2011).

Requirements (1) - (3) of Rule 1.137(a) have been satisfied. The fourth requirement is not applicable, as a terminal disclaimer is not required.<sup>2</sup>

The Office of Patent Publication will be notified of this decision so that the present application can be processed into a patent.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the present decision to ensure that the revival has been acknowledged by the Office of Patent Publication in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Office of Patent Publication where that change of status must be effected - the Office of Petitions cannot effectuate a change of status.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.<sup>3</sup> All other inquiries concerning the status of the application should be directed to the Office of Patent Publication at 571-272-4200.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

<sup>2 &</sup>lt;u>See</u> Rule 1.137(d).

<sup>3</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

	SPE RESPONSE I	
DATE	: <u>12-12-11</u>	
TO SPE OF	: ART UNIT <u>2887</u>	
SUBJECT		ection for Appl. No.: <u>11362563</u> Patent No.: <u>RE42734</u>
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	n date: 12-1-11	ortificate of correction within 7 days
FOR IFW FI	•	ertificate of correction within 7 days.
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FW applicat		corrections as shown in the <b>COCIN</b> document(s) in the should be introduced, nor should the scope or
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FOR PAPER	R FILES:	
		corrections as shown in the attached certificate of (see below) and forward it with the file to:
Note:		<u>Omega</u>
		<u>703-75</u>
Thank You	For Your Assistance	
	t for issuing the above-ic on the appropriate box.	dentified correction(s) is hereby:
<b>V</b>	Approved	
Х	Approved	All changes apply.
X	Approved in Part	All changes apply.  Specify below which changes do not apply.
x 	• •	
	Approved in Part Denied	Specify below which changes <b>do not</b> apply.
□ □ Comments:	Approved in Part  Denied  The request for Certificate of	Specify below which changes <b>do not</b> apply.  State the reasons for denial below.  of Correction filed on 12/01/2011 has been reviewed and
□ □ Comments:	Approved in Part  Denied  The request for Certificate of	Specify below which changes <b>do not</b> apply.  State the reasons for denial below.
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□ □ Comments:	Approved in Part  Denied  The request for Certificate of	Specify below which changes <b>do not</b> apply.  State the reasons for denial below.  of Correction filed on 12/01/2011 has been reviewed and

PTOL-306 (REV. 7/03)

## UNITED STATES PATENT AND TRADEMARK OFFICE



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BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA VA 22314-1176

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AUG 02 2011

OFFICE OF PETITIONS

In re Patent No. 7,495,723

Issued: February 24, 2009

Application No. 11/362,752 : ON PETITION

Filed: February 28, 2006

Attorney Docket No. CHUN3097/EM

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed December 28, 2010.

On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Further, it is not apparent whether the person signing the instant petition was ever given a power of attorney or authorization of agent regarding this patent. In accordance with 37 CFR 1.34(a), the signature appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-7751.

/Joan Olszewski/ Joan Olszewski Petitions Examiner Office of Petitions

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SCHUBERT LAW GROUP PLLC P.O. BOX 90879 AUSTIN, TX 78709-0879

In re Application of

Steven C. Moore Application No. 11/362,990

Filed: February 27, 2006 :

Attorney Docket No. AMG.4013.PAT

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 03, 2011, to revive the above-identified application.

## The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of October 16, 2009. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is January 17, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of \$405, and the submission required by 37 CFR 1.114; (2) the petition fee of \$810; and (3) a proper statement of unintentional delay. Accordingly, the reply to the final Office Action of October 16, 2009 is accepted as having been unintentionally delayed.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at (571) 272-2783.

This application is being referred to Technology Center AU 3617 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

. Ramesh Krishnamurthy

Petitions Examiner Office of Petitions

cc:

JEFFREY S. SCHUBERT 6013 CANNON MOUNTAIN DRIVE AUSTIN TX 78749



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NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128

MAILED

AUG 1 6 2010

In re Application of

Majid Shahbazi

Application No. 11/363,283

Filed: February 28, 2006

Attorney Docket No. 039996-003000

**OFFICE OF PETITIONS** 

**DECISION ON PETITION** TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR. § 1.36(b), filed July 8, 2010.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to attorneys/agents associated with Customer Number 22204 has been revoked by the applicants of the patent application on June 29, 2010. Accordingly, the request to withdraw under 37 CFR § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the belowlisted address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-4584.

/JoAnne Burke/ **IoAnne Burke Petitions Examiner** Office of Petitions

Patent Capital Group cc:

6119 McCommas Blvd

Dallas TX 75214



COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1455
ALEXANDRIA, VA 22313-1455

Ostrolenk Faber LLP 1180 Avenue of the Americas New York NY 10036 MAILED

MAR 21 2011

OFFICE OF PETITIONS

: DECISION ON PETITION

In re Application of

Hoffberg, et al.

Application No. 11/363,431

Filed: February 27, 2006

Atty. Dkt. No.: LIH 10.6

This decision is in response to the petition under 37 CFR 1.137(b), filed February 14, 2011.

The petition is **GRANTED**.

The application became abandoned December 12, 2009 for failure to timely submit a proper reply to the non-final Office action mailed September 11, 2009. The non-final Office action set a three month shortened statutory period of time for reply. No petition for extension of time under 37 CFR 1.136(a) was timely filed. Notice of Abandonment was mailed April 20, 2010.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The instant petition has been carefully reviewed and found in compliance with the requirements set forth above.

This application is being forwarded to Group Art Unit 2439 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown Attorney Advisor Office of Petitions



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FISH & RICHARDSON P.C. (BO) P.O. BOX 1022 MINNEAPOLIS MN 55440-1022

**MAILED** 

NOV 24 2010

In re Application of

Wolfgang Andreasch et al

Application No. 11/363,544

Filed: February 24, 2006

Attorney Docket No. 15540-

075001/27807;18.00

OFFICE OF PETITIONS

**DECISION GRANTING PETITION** 

UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed November 23, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on October 22, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 3742 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

/Karen Creasy/ Karen Creasy Petitions Examiner Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.



#### UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF PETITIONS

FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS MN 55440-1022

In re Patent No.7,992,575

Cui, et al. :

Issue Date: August 9, 2011 : Application No. 11/363,664 :

Filed: February 28, 2006

Attorney Docket No. 20210-088001

DECISION FOR REQUEST

FOR RECONSIDERATION

OF PATENT TERM ADJUSTMENT

This is a decision on the "Application for Patent Term Adjustment Under 37 CFR 1.705(d)," filed October 10 2011. Patentees request that the patent term adjustment indicated on the face of the Letters of Patent be corrected from one thousand, two hundred and sixty-six (1,266) days, to one thousand, three hundred and ninety-eight (1,398) days.

The request for reconsideration of the patent term adjustment under 37 CFR 1.705(d) is **DISMISSED**.

On August 9, 2011, the above-identified application matured into U.S. Patent No. 7,992,575, with a revised patent term of 1,266 days. By the instant petition, patentees assert that the patent term should be adjusted by 787 days pursuant to 37 CFR 1.702(b) and 37 CFR 1.703(b). Patentees state:

Section 154(b)(1)(B)(i) of Title 35 excludes from the calculation of B Delay "any time consumed by continued examination of the application." In the present matter, a Request for Continued Examination was filed on December 16, 2010. The Director erred in the calculation of the patent term adjustment by subtracting from B Delay a period of time that was not "consumed by continued examination of the application." The PTO mailed a Notice of Allowance on March 31, 2011, thereby closing examination of the application on that date. Thus, no continued examination took place during 132 day period from May 31, 2011 (the mailing date of the Notice of Allowance) until August 9,

2011 (the date the patent was issued). Accordingly, 132 days for "B Delay" should have been included in addition to the 655 days accorded by the Director for a total B Delay of 787 days.

Excerpt taken from "Application for Patent Term Adjustment Under 37 CFR 1.705(d)," filed October 10, 2011, p.2.

The Office's calculation of "B delay" is correct. The "B delay" is an adjustment entered if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed. However, the adjustment does not include, among other things, any time consumed by continued examination of the application at the request of the applicant under 35 U.S.C. 132(b)<sup>1</sup>. So, with respect to calculating the "B delay" where applicant has filed a request for continued examination, the period of adjustment is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the number of days in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

Further, counting the period of time excluded from the "B delay" for the filing of a request for continued examination under 35

Pursuant to 35 U.S.C. 132(b), 37 CFR 1.114 provides for continued examination of an application, as follows:

<sup>. (</sup>a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in  $\S 1.17(e)$  prior to the earliest of:

<sup>(1)</sup> Payment of the issue fee, unless a petition under  $\S$  1.313 is granted;

<sup>(2)</sup> Abandonment of the application; or

<sup>(3)</sup> The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

<sup>(</sup>b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

U.S.C. 132(b), from the date on which the request for continued examination is filed to the date the patent is issued is proper. Patentee does not dispute that time consumed by continued examination of an application under 35 U.S.C. 132(b) is properly excluded and that the calculation of the excluded period begins on the date of filing of the request for continued examination. At issue is what further processing or examination beyond the date of filing of the request for continued examination is not any time consumed by continued examination of the application under 35 U.S.C. 132(b). The USPTO indicated in September of 2000 in the final rule to implement the patent term adjustment provisions of the AIPA that once a request for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114 is filed in an application, any further processing or examination of the application, including granting of a patent, is by virtue of the continued examination given to the application under 35 U.S.C. See Changes to Implement Patent Term 132(b) and CFR 1.114. Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56366, 56376 (Sept. 18, 2000) (response to comment 8). Thus, the excluded period begins with the filing of the request for continued examination and ends with the issuance of the patent.

Patentee's argument that the period of time after the issuance of a notice of allowance on a request for continued examination is not "any time consumed by continued examination requested by the applicant under section 132(b)" within the meaning of 35 U.S.C. 154(b)(1)(B)(i) is not availing. limitation is not supported by the statutory language. Garcia v. United States, 469 U.S. 70, 75 (1984) ("only the most extraordinary showing of contrary intentions from [legislative history] would justify a limitation on the 'plain meaning' of the statutory language"). BP Am. Prod. Co. v. Burton, 549 U.S. 84, 91 (2006) ("Unless otherwise defined, statutory terms are generally interpreted in accordance with their ordinary meaning"). The statute provides for a guarantee of no more than 3-year application pendency, by providing for an adjustment in the patent term:

First, "Subject to the limitations of paragraph (2)," means that the limitations of paragraph 2 apply to this paragraph's adjustment of patent term. That is, the day-to-day extension of patent term for pendency beyond the 3 year period is restricted as follows: 1) "B delay" cannot accrue for days of "A delay" that overlap, 2) the patent term cannot be extended beyond

disclaimed term, and 3) the period of adjustment, including accrued "B delay," will be reduced for applicant delay.

Second, "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States," meaning that the condition must first occur that the issuance of an original patent (35 U.S.C. 153), not merely the issuance of a notice of allowance, is delayed due to the Office's failure to issue a patent (sign and record a patent grant in the name of the United States), not merely mail a notice of allowance, within 3 years after the actual filing date of the application in the United States. This provision gives the Office a three-year period to issue a patent (sign and record a patent grant in the name of the United States) after the application filing date before an adjustment will accrue for "B delay."

Third, "not including- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b); (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order section 181, or any time consumed by appellate review by the Board of Patent  $\dot{\text{A}}\text{ppeals}$  and Interferences or by a Federal court; or (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), meaning that the three-year period does not include "any time consumed by" or "any delay in processing," as specified in clauses (i)-This language correlates to 35 U.S.C. 154(b)(1)(A) which likewise provides the basis for determining the period given the Office to take the specified actions before an adjustment will accrue for "A delay" (e.g., extended for 1 day after the day after the period specified in clauses (i)-(iv)).

Furthermore, these clauses are interpreted using their ordinary meanings. Nonetheless, the context of the legislation should be considered. As stated in Wyeth v. Dudas, 580 F. Supp.2d 138(D.D.C., September 30, 2008), because the clock for calculating the 20-year patent term begins to run on the filing date, and not on the day the patent is actually granted, some of the effective term of a patent is consumed by the time it takes to prosecute the application. To mitigate this effect, the statute, inter alia, grants adjustments of patent term whenever the patent prosecution takes more than three years, regardless

of the reason. The time consumed by prosecution of the application includes every day the application is pending before the Office from the actual filing date of the application in the United States until the date of issuance of the patent. The time it takes to prosecute the application ends not with the mailing of the notice of allowance, but with the issuance of the patent.

Thus, not including "any time consumed by" means not including any days used to prosecute the application as specified in clauses (i)-(ii)2. Clause (i) specifies "any time consumed by continued examination of the application requested by the applicant under section 132(b)." Clause (ii) specifies "any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court." "Time" in the context of this legislation throughout refers to days. "Consumed by" means used by or used in the course of. Websters Collegiate Dictionary, (11th ed.). The "any" signifies that the days consumed by are "any" of the days in the pendency of the application, and not just days that occur after the application has been pending for 3 years. As such, "any time consumed by" refers to any days used in the course of 1) continued examination of the application under section 132(b) (the filing of a request for continued examination), 2) interference proceedings, 3) secrecy orders, and 4) appellate review. that 3-year period given to the Office to issue a patent before an adjustment will accrue for "B delay" does not include any days used in the course of or any time consumed by clauses (i)-(ii), including any time consumed by the filing of a request for continued examination.

Fourth, "the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued" meaning that the consequence of this failure is that

Clause (iii) provides for not including (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued. It is noted that paragraph (3)(C) allows with an adequate showing by applicant for reinstatement of no more than 3 months of the patent term reduced for applicant delay in taking in excess of three months to respond.

after "the end of that 3-year period" an additional 1 day of patent term will accrue for each day that the application is pending until the day the patent is issued.

The "time consumed by" or used in the course of the continued examination of the application requested by the applicant under section 132(b) does not end until issuance of the patent. 35 U.S.C. 132(b) was enacted under the same title, the "American Inventors Protection Act of 1999," as 35 U.S.C. Section 4403 of the AIPA amended 35 U.S.C. § 132 to provide, at the request of the applicant, for continued examination of an application for a fee (request for continued examination or RCE practice), without requiring the applicant to file a continuing application under 37 CFR 1.53(b) or a continued prosecution application (CPA) under 37 CFR 1.53(d). Thus, clause (i) is different from clause (ii) in that clause (i) refers to an examination process whereas clause (ii) refers to time consumed by proceedings (interferences, secrecy orders and appeals) in an application.

By nature, the time used in the course of the examination process continues to issuance of the patent. The examination process involves examining the application to ascertain whether it appears that the applicant is entitled to a patent under the See 35 U.S.C. 131 ("[t]he Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor"). If on examination it appears that the applicant is entitled to a patent, the USPTO issues a notice of allowance. See 35 U.S.C. 151 ("[i]f it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant"). If on examination it appears that the applicant is not entitled to a patent, the USPTO issues a notice (an Office action) stating the applicable rejection, objection, or other requirement, with the reasons therefor. See 35 U.S.C. 132 ("[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application"). Neither the issuance of a notice of allowance nor the insurance

of an Office action terminates the examination process. If after the issuance of an Office action under 35 U.S.C. 132 it subsequently appears that the applicant is entitled to a patent (e.g., in response to an argument or amendment by the applicant), the USPTO will issue a notice of allowance. Conversely, if after the issuance of a notice of allowance under 35 U.S.C. 151 it subsequently appears that the applicant is not entitled to a patent (e.g., in response to information provided by the applicant or uncovered by the USPTO), the USPTO will withdraw the application from issuance and issue an Office action under 35 U.S.C. 132 stating the applicable rejection, objection, or other requirement, with the reasons therefor.

As held in <u>Blacklight Power</u>, the USPTO's responsibility to issue a patent containing only patentable claims does not end with the issuance of a notice of allowance under 35 U.S.C. 151. See <u>BlackLight Power</u>, Inc. v. Rogan, 295 F.3d 1269, 1273 (Fed. Cir. 2002). Rather, if there is any substantial, reasonable ground within the knowledge or cognizance of the Director as to why an application should not issue, it is the USPTO's duty to refuse to issue the patent even if a notice of allowance has previously been issued for the application. See <u>In reDrawbaugh</u>, 9 App. D.C. 219, 240 (D.C. Cir 1896).

Moreover, the applicant continues to be engaged in the examination process after the mailing of the notice of 37 CFR 1.56 makes clear that the applicant has a allowance. duty to disclose information material to patentability as long as the application is pending before the USPTO (i.e., until a patent is granted or the application is abandoned). See 37 CFR 1.56(a) ("[t]he duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned"). 37 CFR 1.97 and 1.98 provide for the consideration of information submitted by the applicant after a notice of allowance has been mailed. See 37 CFR 1.97(d). In addition, 37 CFR 1.312 provides for the amendment of an application after a notice of allowance has been mailed. In fact, the request for examination procedures<sup>3</sup> permit the filing of a request for continued examination under 37 CFR 1.114 even after the issuance of a notice of allowance under 35 U.S.C. 151. See 37 CFR 1.114(a)(1).

Thus, on occasion, even where a request for continued examination has already been filed and a notice of allowance issued pursuant to that request, applicant may file a further request for continued examination.

As the examination process does not terminate with the mailing of the notice of allowance, the time consumed by continued examination requested by the applicant under section 132(b) does not terminate with the mailing of the notice of allowance. All the time the application is pending from the date of filing of the request for continued examination to the mailing of the notice of allowance through issuance of the patent is a consequence of the filing of the request for continued examination. Further action by the Office is pursuant to that request. Applicant has gotten further prosecution of the application without having to file a continuing application under 37 CFR 1.53(b).

All of the continued examination pursuant to the filing of the request by the applicant is properly excluded from the delay attributed to the Office. 35 U.S.C. 154(b)(1)(B)'s guarantee of a total application pendency of no more than three years provides for adjustment of the patent term for delay due to the Office's failure to issue the patent within three years, but does not include "any time consumed by continued examination requested by the applicant under 35 U.S.C. 132(b)." It is not necessary to mitigate the effect on the 20-year term to the extent that applicant has requested that the Office continue to examine the application via a request for continued examination, in lieu of, the filing of a continuing application under 37 CFR 1.53(b).

In this instance, a request for continued examination was filed on December 16, 2010, and the patent issued by virtue of that request on August 9, 2011. Pursuant to 35 U.S.C. 154(b)(1)(B)(i), the period beginning on December 16, 2010, and ending on August 9, 2011, is not included in calculating Office delay.

In view thereof, it is concluded that the patent term adjustment of 1,266 days indicated on the patent is correct.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

In re Patent No. 7,992,575 Application No. 11/363,664

9

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Attorney Advisor Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

FISH & RICHARDSON P.C. (BO) P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022

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MAY 3 1 2011

OFFICE OF PETITIONS

In re Application of

Susan LINDQUIST, et al.

Application No. 11/363,870

Filed: February 27, 2006 Attorney Docket No. **17481-005003**  DECISION GRANTING PETITION

UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed May 27, 2011, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on April 27, 2011 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>

Telephone inquiries should be directed to the undersigned at (571) 272-7253.

This application is being referred to Technology Center AU 1636 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.



Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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# MAÎLED JAN 2 7 2012 OFFICE OF PETITIONS

FISH & RICHARDSON P.C. (BO) P.O. BOX 1022 MINNEAPOLIS MN 55440-1022

In re Patent No. 8,039,209

LINDQUIST et al.

Issue Date: October 18, 2011 Application No. 11/363,870

Filed: February 7, 2006 Attorney Docket No. 17481-

005003

:

: DECISION ON REQUEST FOR

: RECONSIDERATION OF

: PATENT TERM ADJUSTMENT

: AND NOTICE OF INTENT TO

: ISSUE CERTIFICATE OF

·: CORRECTION

This is a decision on the petition filed on December 15, 2011, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand two hundred forty (1240) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED** to the extent indicated herein. The term of the above-identified patent is extended or adjusted by one thousand fifty-four (1054) days.

#### BACKGROUND.

On October 18, 2011, the above-identified application matured into U.S. Patent No. 8,039,209 with a revised patent term adjustment of 1106 days. On December 15, 2011, patentee timely submitted this request for reconsideration of patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 1240.

Patentee asserts that the Office should have entered a period of 88 days of applicant delay (not 90 days) pursuant to 37 CFR 1.704(b) for the filing of the reply on November 19, 2010, in response to the non-final Office action mailed May 21, 2010. Patentee asserts that the three-month due date should be calculated from August 23, 2010, because August 21, 2010, fell on a Saturday.

Patentee's assertion is well taken. The period of reduction of 90 days will be removed and a period of reduction of 88 days will be entered.

Next, patentee maintains that the Office incorrectly calculated Office delay pursuant to 37 CFR 1.702(b). Patentee contends that the Office erred in subtracting from the "B delay" a period of time that was not "consumed by continued examination of the application." Specifically, Patentee argues that (after the filing of the request for continued examination) the Office mailed a Notice of Allowance on June 9, 2011, thereby closing examination of the application on that date. Thus, Patentee argues no continued examination took place during the 132-day period from June 9, 2011 (the mailing date of the Notice of Allowance) until October 18, 2011 (the date the patent was issued). As such, patentee maintains that the "B delay" should include the 132 days and be increased from 818 to 950 days. Patentee concludes that the correct patent term adjustment is 1240 days (the sum of 489 days of "A delay" and 950 days of "B delay" minus 0 days of overlap between "A delay" and "B delay" minus 199 days of applicant delay).

#### RELEVANT STATUTE AND REGULATIONS

The statutory basis for calculation of "B delay" is 35 U.S.C. 154(b)(1)(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including -

- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);
- (ii) any time consumed by a proceeding under  $\cdot$  section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or
- (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

The implementing regulation, 37 CFR 1.702(b) provides that:

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

- (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);
- (2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);
- (3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
- (4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or
- (5) Any delay in the processing of the application by the Office that was requested by the applicant.

#### OPINION

Patentee's arguments have been considered, but not found persuasive. The Office calculated the period of "B delay" pursuant to 35 U.S.C. 154(b)(1)(B)(i) and 37 CFR 1.702(b)(1) as 818 days based on the application having been filed under 35 U.S.C. 111(a) on February 7, 2006, and the patent not having issued as of the day after the three year date, February 8, 2009, and a request for continued examination under 35 U.S.C. 132(b) having been filed on May 27, 2011. In other words, the

132-day period beginning on the date of mailing of the Notice of Allowance to the date of issuance of the patent was considered time consumed by continued examination of an application under 35 U.S.C. 132(b) and was not included in the "B delay."

The Office's calculation of "B delay" is correct. The "B delay" is an adjustment entered if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was However, the adjustment does not include, among other things, any time consumed by continued examination of the application at the request of the applicant under 35 U.S.C. 132(b) 1. Thus, with respect to calculating the "B delay", where applicant has filed a request for continued examination the period of adjustment is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the number of days in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

Further, counting the period of time excluded from the "B delay" for the filing of a request for continued examination under 35 U.S.C. 132(b), from the date on which the request for continued examination is filed to the date the patent is issued is proper. Patentee does not dispute that time consumed by continued

Pursuant to 35 U.S.C. 132(b), 37 CFR 1.114 provides for continued examination of an application, as follows:

<sup>(</sup>a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in \$ 1.17(e) prior to the earliest of:

<sup>(1)</sup> Payment of the issue fee, unless a petition under  $\S$  1.313 is granted;

<sup>(2)</sup> Abandonment of the application; or

<sup>(3)</sup> The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

<sup>(</sup>b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

examination of an application under 35 U.S.C. 132(b) is properly excluded and that the calculation of the excluded period begins on the date of filing of the request for continued examination. At issue is what further processing or examination beyond the date of filing of the request for continued examination is not any time consumed by continued examination of the application under 35 U.S.C. 132(b). The USPTO indicated in September of 2000 in the final rule to implement the patent term adjustment provisions of the AIPA that once a request for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114 is filed in an application, any further processing or examination of the application, including granting of a patent, is by virtue of the continued examination given to the application under 35 U.S.C. 132(b) and CFR 1.114. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56366, 56376 (Sept. 18, 2000) (response to comment 8). Thus, the excluded period begins with the filing of the request for continued examination and ends with the issuance of the patent.

Patentee's argument that the period of time after the issuance of a Notice of Allowance on a request for continued examination is not "any time consumed by continued examination requested by the applicant under section 132(b)" within the meaning of 35 U.S.C. 154(b)(1)(B)(i) is not availing. This limitation is not supported by the statutory language. Garcia v. United States, 469 U.S. 70, 75 (1984) ("only the most extraordinary showing of contrary intentions from [legislative history] would justify a limitation on the 'plain meaning' of the statutory language"). BP Am. Prod. Co. v. Burton, 549 U.S. 84, 91 (2006) ("Unless otherwise defined, statutory terms are generally interpreted in accordance with their ordinary meaning"). The statute provides for a guarantee of no more than 3-year application pendency, by providing for an adjustment in the patent term:

First, "Subject to the limitations of paragraph (2)," means that the limitations of paragraph 2 apply to this paragraph's adjustment of patent term. That is, the day-to-day extension of patent term for pendency beyond the 3 year period is restricted as follows: 1) "B delay" cannot accrue for days of "A delay" that overlap, 2) the patent term cannot be extended beyond disclaimed term, and 3) the period of adjustment, including accrued "B delay," will be reduced for applicant delay.

Second, "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States," meaning that the condition must first occur that the issuance of an original patent (35 U.S.C. 153), not merely the issuance of a notice of allowance, is delayed due to the Office's failure to issue a patent (sign and record a patent grant in the name of the United States), not merely mail a notice of allowance, within 3 years after the actual filing date of the application in the United States. This provision gives the Office a three-year period to issue a patent (sign and record a patent grant in the name of the United States) after the application filing date before an adjustment will accrue for "B delay."

Third, "not including- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b); (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), meaning that the three-year period does not include "any time consumed by" or "any delay in processing," as specified in clauses (i)-This language correlates to 35 U.S.C. 154(b)(1)(A) which likewise provides the basis for determining the period given the Office to take the specified actions before an adjustment will accrue for "A delay" (e.g., extended for 1 day after the day after the period specified in clauses (i)-(iv)).

Furthermore, these clauses are interpreted using their ordinary meanings. Nonetheless, the context of the legislation should be considered. As stated in <a href="Wyeth v. Dudas">Wyeth v. Dudas</a>, 580 F. Supp. 2d 138 (D.D.C. 2008), because the clock for calculating the 20-year patent term begins to run on the filing date, and not on the day the patent is actually granted, some of the effective term of a patent is consumed by the time it takes to prosecute the application. To mitigate this effect, the statute, inter alia, grants adjustments of patent term whenever the patent prosecution takes more than three years, regardless of the reason. The time consumed by prosecution of the application includes every day the application is pending before the Office

from the actual filing date of the application in the United States until the date of issuance of the patent. The time it takes to prosecute the application ends not with the mailing of the notice of allowance, but with the issuance of the patent.

Thus, not including "any time consumed by" means not including any days used to prosecute the application as specified in clauses (i)-(ii)<sup>2</sup>. Clause (i) specifies "any time consumed by continued examination of the application requested by the applicant under section 132(b)." Clause (ii) specifies "any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court." "Time" in the context of this legislation throughout refers to days. "Consumed by" means used by or used in the course of. Websters Collegiate Dictionary, (11th ed.). The "any" signifies that the days consumed by are "any" of the days in the pendency of the application, and not just days that occur after the application has been pending for 3 years. As such, "any time consumed by" refers to any days used in the course of 1) continued examination of the application under section 132(b) (the filing of a request for continued examination), 2) interference proceedings, 3) secrecy orders, and 4) appellate review. that 3-year period given to the Office to issue a patent before an adjustment will accrue for "B delay" does not include any days used in the course of or any time consumed by clauses (i)-(ii), including any time consumed by the filing of a request for continued examination.

Fourth, "the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued" meaning that the consequence of this failure is that after "the end of that 3-year period" an additional 1 day of patent term will accrue for each day that the application is pending until the day the patent is issued.

Clause (iii) provides for not including (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued. It is noted that paragraph (3)(C) allows with an adequate showing by applicant for reinstatement of no more than 3 months of the patent term reduced for applicant delay in taking in excess of three months to respond.

The "time consumed by" or used in the course of the continued examination of the application requested by the applicant under section 132(b) does not end until issuance of the patent. 35 U.S.C. 132(b) was enacted under the same title, the "American Inventors Protection Act of 1999," as 35 U.S.C. 154(b). Section 4403 of the AIPA amended 35 U.S.C. § 132 to provide, at the request of the applicant, for continued examination of an application for a fee (request for continued examination or RCE practice), without requiring the applicant to file a continuing application under 37 CFR 1.53(b) or a continued prosecution application (CPA) under 37 CFR 1.53(d). Thus, clause (i) is different from clause (ii) in that clause (i) refers to an examination process whereas clause (ii) refers to time consumed by proceedings (interferences, secrecy orders and appeals) in an application.

By nature, the time used in the course of the examination process continues to issuance of the patent. The examination process involves examining the application to ascertain whether it appears that the applicant is entitled to a patent under the See 35 U.S.C. 131 ("[t]he Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor"). If on examination it appears that the applicant is entitled to a patent, the USPTO issues a notice of allowance. See 35 U.S.C. 151 ("[i]f it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant"). If on examination it appears that the applicant is not entitled to a patent, the USPTO issues a notice (an Office action) stating the applicable rejection, objection, or other requirement, with the reasons therefor. See 35 U.S.C. 132 ("[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application"). Neither the issuance of a notice of allowance nor the insurance of an Office action terminates the examination process. If after the issuance of an Office action under 35 U.S.C. 132 it subsequently appears that the applicant is entitled to a patent (e.g., in response to an argument or amendment by the

applicant), the USPTO will issue a notice of allowance. Conversely, if after the issuance of a notice of allowance under 35 U.S.C. 151 it subsequently appears that the applicant is not entitled to a patent (e.g., in response to information provided by the applicant or uncovered by the USPTO), the USPTO will withdraw the application from issuance and issue an Office action under 35 U.S.C. 132 stating the applicable rejection, objection, or other requirement, with the reasons therefor.

As held in <u>Blacklight Power</u>, the USPTO's responsibility to issue a patent containing only patentable claims does not end with the issuance of a notice of allowance under 35 U.S.C. 151. <u>See BlackLight Power</u>, Inc. v. Rogan, 295 F.3d 1269, 1273 (Fed. Cir. 2002). Rather, if there is any substantial, reasonable ground within the knowledge or cognizance of the Director as to why an application should not issue, it is the USPTO's duty to refuse to issue the patent even if a notice of allowance has previously been issued for the application. <u>See In re Drawbaugh</u>, 9 App. D.C. 219, 240 (D.C. Cir 1896).

Moreover, the applicant continues to be engaged in the examination process after the mailing of the notice of allowance. 37 CFR 1.56 makes clear that the applicant has a duty to disclose information material to patentability as long as the application is pending before the USPTO (i.e., until a patent is granted or the application is abandoned). See 37 CFR 1.56(a) ("[t]he duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned"). 37 CFR 1.97 and 1.98 provide for the consideration of information submitted by the applicant after a notice of allowance has been mailed. See 37 CFR 1.97(d). In addition, 37 CFR 1.312 provides for the amendment of an application after a notice of allowance has been mailed. In fact, the request for examination procedures<sup>3</sup> permits the filing of a request for continued examination under 37 CFR 1.114 even after the issuance of a notice of allowance under 35 U.S.C. 151. See 37 CFR 1.114(a)(1).

As the examination process does not terminate with the mailing of the Notice of Allowance, the time consumed by continued examination requested by the applicant under section 132(b) does

Thus, on occasion, even where a request for continued examination has already been filed and a notice of allowance issued pursuant to that request, applicant may file a further request for continued examination.

not terminate with the mailing of the Notice of Allowance. All the time the application is pending from the date of filing of the request for continued examination to the mailing of the Notice of Allowance through issuance of the patent is a consequence of the filing of the request for continued examination. Further action by the Office is pursuant to that request. Applicant has gotten further prosecution of the application without having to file a continuing application under 37 CFR 1.53(b).

All of the continued examination pursuant to the filing of the request by the applicant is properly excluded from the delay attributed to the Office. 35 U.S.C. 154(b)(1)(B)'s guarantee of a total application pendency of no more than three years provides for adjustment of the patent term for delay due to the Office's failure to issue the patent within three years, but does not include "any time consumed by continued examination requested by the applicant under 35 U.S.C. 132(b)." It is not necessary to mitigate the effect on the 20-year term to the extent that applicant has requested that the Office continue to examine the application via a request for continued examination, in lieu of, the filing of a continuing application under 37 CFR 1.53(b).

In this instance, a request for continued examination was filed on May 27, 2011, and the patent issued by virtue of that request on October 18, 2011. Pursuant to 35 U.S.C. 154(b)(1)(B)(i), the period beginning on May 27, 2011, and ending on October 18, 2011, is not included in calculating Office delay.

Finally, a further review of the application history reveals that additional grounds for reduction of patent term adjustment pursuant to 37 CFR 1.704(c)(10) are warranted. Specifically, patentee submitted an Information Disclosure Statement (IDS) on March 11, 2011, after the mailing of the notice of allowance on February 7, 2011. A review of the IDS of March 11, 2011, reveals that it did not include a proper § 1.704(d) statement, 4

<sup>&</sup>lt;sup>4</sup> Pursuant to 37 CFR 1.704(d):

A paper containing only an information disclosure statement in compliance with \$\$ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is

which is a ground for reduction of patent term adjustment under 37 CFR 1.704(c)(10). The Office responded to the IDS on April 19, 2011. Accordingly, a period of reduction of 40 days will be entered.

Additionally, patentee should have been assessed a delay for the filing of the petition to withdraw from issue, RCE and the IDS on May 27, 2011, after the mailing of the notice of allowance on February 7, 2011 (and after payment of the issue fee on April 27, 2011). The Office mailed a response to the petition to withdraw from issue on May 31, 2011. Accordingly, the submission of the petition to withdraw from issue after the mailing of the notice of allowance is a proper basis under 37 CFR 1.704(c)(10) for reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping. See 37 CFR 1.704(c).

On June 9, 2011, the Office responded to the RCE and IDS filed May 27, 2011. A review of the IDS filed May 27, 2011, reveals that it did not include a statement under 37 CFR 1.704(d). Thus, patentee failed to engage in reasonable efforts to conclude prosecution of the application.

Pursuant to 37 CFR 1.704(c)(10), a first period of reduction of 5 days should have been entered for the submission of the petition to withdraw from issue, counting the number of days beginning on the date the petition was filed, May 27, 2011, and ending on the mailing date of the response to the petition, May 31, 2011. Pursuant to 37 CFR 1.704(c)(10), a second period reduction of 14 should have been entered for the submission of the RCE and IDS, counting the number of days beginning on the date the RCE and IDS were filed, May 27, 2011, and ending on the mailing date of the response to the RCE and IDS, June 9, 2011.

accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Emphasis added.

37 CFR 1.704(c) provides that "[c]ircumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application ... will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping." The first period of reduction of 5 days pursuant to 37 CFR 1.704(c)(10) totally overlaps with the second period of reduction of 14 days. Thus, a single period of reduction of 14 days will be entered for these two periods of reduction.

#### CONCLUSION

Accordingly, the patent term adjustment is 1054 days (489 days of "A delay" + 818 days of "B delay" - 0 days of overlap - 253 days of applicant delay).

The Office will sua sponte issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentee is given one (1) month or thirty (30) days, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand fifty-four (1054) days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Senior Petitions Attorney
Office of Petitions .

Enclosure: Copy of DRAFT Certificate of Correction

# **DRAFT COPY**

# UNITED STATES PATENT AND TRADEMARK OFFICE **CERTIFICATE OF CORRECTION**

**PATENT** 

8,039,209 B2

DATED

Oct. 18, 2011

INVENTOR(S): Lindquist et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

Subject to any disclaimer, the term of this patent is extended or adjusted [\*] Notice: under 35 USC 154(b) by (1106) days.

Delete the phrase "by 1106 days" and insert – by 1054 days--



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/06/2010

DOV ROSENFELD 5507 COLLEGE AVE SUITE 2 OAKLAND, CA 94618

Applicant : Richard T. Wales

Patent Number : 7660477

Issue Date : 02/09/2010

Application No. : 11/363 920

**Application No:** 11/363,920 **Filed :** 02/28/2006

: DECISION ON REQUEST FOR : RECALCULATION OF PATENT : TERM ADJUSTMENT IN VIEW

: OF WYETH AND NOTICE OF INTENT TO

: ISSUE CERTIFICATE OF CORRECTION

:

The Request for Recalculation is **GRANTED** to the extent indicated.

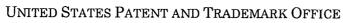
The patent term adjustment has been determined to be 1018 days. The USPTO will sua sponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

ACCENTURE/FENNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP 901 NEW YORK AVENUE WASHINGTON, DC 20001-4413

MAILED

JAN 05 2011 OFFICE OF PETITIONS

In re Application of Michael Mikurak

Application No. 11/363,926

Filed: February 27, 2006

Attorney Docket No. 10761.0201-01

**DECISION GRANTING PETITION** 

UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed December 30, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on December 6, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

Telephone inquiries regarding this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 3684 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/AMW/ April M. Wise Petitions Examiner Office of Petitions

<sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

FISH & RICHARDSON PC PO BOX 1022 MINNEAPOLIS MN 55440-1022

# MAILED

AUG 0 9 2011

OFFICE OF PETITIONS

In re Patent No. 7,939,310

39,310 : DECISION ON

Young, et al.

: REQUEST FOR RECONSIDERATION

Application No. 11/364,013

: of PATENT TERM ADJUSTMENT

Issue Date: May 24, 2011

: and

Filed: February 28, 2006

: NOTICE OF INTENT TO ISSUE

Attorney Docket No. 24525-0028001

: CERTIFICATE OF CORRECTION

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d)", filed July 22, 2011, requesting that the patent term adjustment indicated on the above-identified patent be corrected from one hundred ninety-seven (197) days to three hundred (300) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED** to the extent indicated herein.

On May 24, 2011, the instant application matured into U.S. Patent No. 7,947,496 with a patent term adjustment of one hundred ninety-seven (197) days. The Office determined a patent term adjustment of 197 days based upon 415 days of Office delay pursuant to 37 CFR 1.703(b), reduced by 218 days of Applicant delay due to 61 and 94 days of Applicant delay under 37 CFR 1.704(b), and 48 and 15 days of Applicant delay under 37 CFR 1.704(c)(8).

Patentees argue that even though they filed an RCE on April 20, 2010, they should be awarded 37 CFR 1.703(b) "over three year" delay from the time the Office mailed a Notice of Allowance on January 25, 2011 until the issue date of the patent. In other words, Patentee argue that no continued examination took place during this time period, and the Office should be accorded 120 additional days of delay pursuant to 37 CFR 1.703(b). Patentee's argument has been considered, but is not persuasive.

## RELEVANT STATUTE AND REGULATIONS

The statutory basis for calculation of "B delay" is 35 U.S.C. 154(b)(1)(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —

- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);
- (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or
- (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

The implementing regulation, 37 CFR 1.702(b) provides that:

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

- (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);
- (2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);
- (3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
- (4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or
- (5) Any delay in the processing of the application by the Office that was requested by the applicant.

#### **OPINION**

Patentee's arguments have been considered, but not found persuasive. The Office calculated the period of "B delay" pursuant to 35 U.S.C. 154(b)(1)(B)(i) and 37 CFR 1.702(b)(1) as 415 days based on the application having been filed under 35 U.S.C. 111(a) on February 28, 2006 and a request for continued examination under 132(b) having been filed on April 20, 2010. In other

words, the 120 day period beginning on the date of mailing of the notice of allowance on January 25, 2011 to the date of issuance of the patent was considered time consumed by continued examination of an application under 35 U.S.C. 132(b) and was not included in the "B delay."

The Office's calculation of "B delay" is correct. The "B delay" is an adjustment entered if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed. However, the adjustment does not include, among other things, any time consumed by continued examination of the application at the request of the applicant under 35 U.S.C. 132(b). So, with respect to calculating the "B delay" where applicant has filed a request for continued examination, the period of adjustment is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the number of days in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

Further, counting the period of time excluded from the "B delay" for the filing of a request for continued examination under 35 U.S.C. 132(b), from the date on which the request for continued examination is filed to the date the patent is issued is proper. Patentee does not dispute that time consumed by continued examination of an application under 35 U.S.C. 132(b) is properly excluded and that the calculation of the excluded period begins on the date of filing of the request for continued examination. At issue is what further processing or examination beyond the date of filing of the request for continued examination is not any time consumed by continued examination of the application under 35 U.S.C. 132(b). The USPTO indicated in September of 2000 in the final rule to implement the patent term adjustment provisions of the AIPA that once a request for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114 is filed in an application, any further processing or examination of the application, including granting of a patent, is by virtue of the continued examination given to the application under 35 U.S.C. 132(b) and CFR 1.114. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56366, 56376 (Sept. 18, 2000) (response to comment 8). Thus, the excluded period begins with the filing of the request for continued examination and ends with the issuance of the patent.

Pursuant to 35 U.S.C. 132(b), 37 CFR 1.114 provides for continued examination of an application, as follows:

<sup>(</sup>a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

<sup>(1)</sup> Payment of the issue fee, unless a petition under § 1.313 is granted;

<sup>(2)</sup> Abandonment of the application; or

<sup>(3)</sup> The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

<sup>(</sup>b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

Patentee's argument that the period of time after the issuance of a notice of allowance on a request for continued examination is not "any time consumed by continued examination requested by the applicant under section 132(b)" within the meaning of 35 U.S.C. 154(b)(1)(B)(i) is not availing. This limitation is not supported by the statutory language. Garcia v. United States, 469 U.S. 70, 75 (1984) ("only the most extraordinary showing of contrary intentions from [legislative history] would justify a limitation on the 'plain meaning' of the statutory language"). BP Am. Prod. Co. v. Burton, 549 U.S. 84, 91 (2006) ("Unless otherwise defined, statutory terms are generally interpreted in accordance with their ordinary meaning"). The statute provides for a guarantee of no more than 3-year application pendency, by providing for an adjustment in the patent term:

First, "Subject to the limitations of paragraph (2)," means that the limitations of paragraph 2 apply to this paragraph's adjustment of patent term. That is, the day-to-day extension of patent term for pendency beyond the 3 year period is restricted as follows: 1) "B delay" cannot accrue for days of "A delay" that overlap, 2) the patent term cannot be extended beyond disclaimed term, and 3) the period of adjustment, including accrued "B delay," will be reduced for applicant delay.

Second, "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States," meaning that the condition must first occur that the issuance of an original patent (35 U.S.C. 153), not merely the issuance of a notice of allowance, is delayed due to the Office's failure to issue a patent (sign and record a patent grant in the name of the United States), not merely mail a notice of allowance, within 3 years after the actual filing date of the application in the United States. This provision gives the Office a three-year period to issue a patent (sign and record a patent grant in the name of the United States) after the application filing date before an adjustment will accrue for "B delay."

Third, "not including- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b); (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), meaning that the three-year period does not include "any time consumed by" or "any delay in processing," as specified in clauses (i)-(iii). This language correlates to 35 U.S.C. 154(b)(1)(A) which likewise provides the basis for determining the period given the Office to take the specified actions before an adjustment will accrue for "A delay" (e.g., extended for 1 day after the day after the period specified in clauses (i)-(iv)).

Furthermore, these clauses are interpreted using their ordinary meanings. Nonetheless, the context of the legislation should be considered. As stated in Wyeth v. Dudas, (580 F. Supp. 2d 138), because the clock for calculating the 20-year patent term begins to run on the filing date, and not on the day the patent is actually granted, some of the effective term of a patent is consumed by the time it takes to prosecute the application. To mitigate this effect, the statute, inter alia, grants adjustments of patent term whenever the patent prosecution takes more than

three years, regardless of the reason. The time consumed by prosecution of the application includes every day the application is pending before the Office from the actual filing date of the application in the United States until the date of issuance of the patent. The time it takes to prosecute the application ends not with the mailing of the notice of allowance, but with the issuance of the patent.

Thus, not including "any time consumed by" means not including any days used to prosecute the application as specified in clauses (i)-(ii)2. Clause (i) specifies "any time consumed by continued examination of the application requested by the applicant under section 132(b)." Clause (ii) specifies "any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court." "Time" in the context of this legislation throughout refers to days. "Consumed by" means used by or used in the course of. Websters Collegiate Dictionary, (11th ed.). The "any" signifies that the days consumed by are "any" of the days in the pendency of the application, and not just days that occur after the application has been pending for 3 years. As such, "any time consumed by" refers to any days used in the course of 1) continued examination of the application under section 132(b)(the filing of a request for continued examination), 2) interference proceedings, 3) secrecy orders, and 4) appellate review. Thus, that 3-year period given to the Office to issue a patent before an adjustment will accrue for "B delay" does not include any days used in the course of or any time consumed by clauses (i)-(ii), including any time consumed by the filing of a request for continued examination.

Fourth, "the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued" meaning that the consequence of this failure is that after "the end of that 3-year period" an additional 1 day of patent term will accrue for each day that the application is pending until the day the patent is issued.

The "time consumed by" or used in the course of the continued examination of the application requested by the applicant under section 132(b) does not end until issuance of the patent. 35 U.S.C. 132(b) was enacted under the same title, the "American Inventors Protection Act of 1999," as 35 U.S.C. 154(b). Section 4403 of the AIPA amended 35 U.S.C. § 132 to provide, at the request of the applicant, for continued examination of an application for a fee (request for continued examination or RCE practice), without requiring the applicant to file a continuing application under 37 CFR 1.53(b) or a continued prosecution application (CPA) under 37 CFR 1.53(d). Thus, clause (i) is different from clause (ii) in that clause (i) refers to an examination process whereas clause (ii) refers to time consumed by proceedings (interferences, secrecy orders and appeals) in an application.

Clause (iii) provides for not including (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued. It is noted that paragraph (3)(C) allows with an adequate showing by applicant for reinstatement of no more than 3 months of the patent term reduced for applicant delay in taking in excess of three months to respond.

By nature, the time used in the course of the examination process continues to issuance of the patent. The examination process involves examining the application to ascertain whether it appears that the applicant is entitled to a patent under the law. See 35 U.S.C. 131 ("[t]he Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor"). If on examination it appears that the applicant is entitled to a patent, the USPTO issues a notice of allowance. See 35 U.S.C. 151 ("[i]f it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant"). If on examination it appears that the applicant is not entitled to a patent, the USPTO issues a notice (an Office action) stating the applicable rejection, objection, or other requirement, with the reasons therefor. See 35 U.S.C. 132 ("[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application"). Neither the issuance of a notice of allowance nor the insurance of an Office action terminates the examination process. If after the issuance of an Office action under 35 U.S.C. 132 it subsequently appears that the applicant is entitled to a patent (e.g., in response to an argument or amendment by the applicant), the USPTO will issue a notice of allowance. Conversely, if after the issuance of a notice of allowance under 35 U.S.C. 151 it subsequently appears that the applicant is not entitled to a patent (e.g., in response to information provided by the applicant or uncovered by the USPTO), the USPTO will withdraw the application from issuance and issue an Office action under 35 U.S.C. 132 stating the applicable rejection, objection, or other requirement, with the reasons therefor.

As held in <u>Blacklight Power</u>, the USPTO's responsibility to issue a patent containing only patentable claims does not end with the issuance of a notice of allowance under 35 U.S.C. 151. See <u>BlackLight Power</u>, Inc. v. Rogan, 295 F.3d 1269, 1273 (Fed. Cir. 2002). Rather, if there is any substantial, reasonable ground within the knowledge or cognizance of the Director as to why an application should not issue, it is the USPTO's duty to refuse to issue the patent even if a notice of allowance has previously been issued for the application. See <u>In re Drawbaugh</u>, 9 App. D.C. 219, 240 (D.C. Cir 1896).

Moreover, the applicant continues to be engaged in the examination process after the mailing of the notice of allowance. 37 CFR 1.56 makes clear that the applicant has a duty to disclose information material to patentability as long as the application is pending before the USPTO (i.e., until a patent is granted or the application is abandoned). See 37 CFR 1.56(a) ("[t]he duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned"). 37 CFR 1.97 and 1.98 provide for the consideration of information submitted by the applicant after a notice of allowance has been mailed. See 37 CFR 1.97(d). In addition, 37 CFR 1.312 provides for the amendment of an application after a notice of allowance has been mailed. In fact, the request for examination procedures3 permit the filing of a request for continued examination under 37 CFR 1.114 even after the issuance of a notice of allowance under 35 U.S.C. 151. See 37 CFR 1.114(a)(1).

Thus, on occasion, even where a request for continued examination has already been filed and a notice of allowance issued pursuant to that request, applicant may file a further request for continued examination.

As the examination process does not terminate with the mailing of the notice of allowance, the time consumed by continued examination requested by the applicant under section 132(b) does not terminate with the mailing of the notice of allowance. All the time the application is pending from the date of filing of the request for continued examination to the mailing of the notice of allowance through issuance of the patent is a consequence of the filing of the request for continued examination. Further action by the Office is pursuant to that request. Applicant has gotten further prosecution of the application without having to file a continuing application under 37 CFR 1.53(b).

All of the continued examination pursuant to the filing of the request by the applicant is properly excluded from the delay attributed to the Office. 35 U.S.C. 154(b)(1)(B)'s guarantee of a total application pendency of no more than three years provides for adjustment of the patent term for delay due to the Office's failure to issue the patent within three years, but does not include "any time consumed by continued examination requested by the applicant under 35 U.S.C. 132(b)." It is not necessary to mitigate the effect on the 20-year term to the extent that applicant has requested that the Office continue to examine the application via a request for continued examination, in lieu of, the filing of a continuing application under 37 CFR 1.53(b).

In this instance, a request for continued examination was filed on April 20, 2010, and the patent issued by virtue of that request on May 24, 2011. Pursuant to 35 U.S.C. 154(b)(1)(B)(i), the period beginning on April 20, 2010 and ending on May 24, 2011 is not included in calculating Office delay.

In addition, Patentees also point out that they should have been assessed seventeen (17) days of Applicant delay pursuant to 37 CFR 1.704(c)(10). A review of the record reveals that Applicants filed a RCE, subsequent to the Office's mailing of a Notice of Allowance, on April 20, 2010. In response, the Office mailed a non-final Office action on May 6, 2010. Accordingly, pursuant to 37 CFR 1.704(c)(10), 17 days of Applicant delay should have been assessed.

In view thereof, the correct number of days of patent term adjustment is **one hundred eighty** (180) days (415 days of "B" delay, reduced by 235 (61+48+17+94+15 days of Applicant delay and 358 days of overlap).

The application is being forwarded to the Certificate of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one hundred eighty (180) days.** 

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3207.

Cliff Congo Petitions Attorney Office of Petitions

## UNITED STATES PATENT AND TRADEMARK OFFICE DRAFT CERTIFICATE OF CORRECTION

: 7,947,496 B2

DATED

: May 24, 2011

INVENTOR(S): Young et al.,

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

Subject to any disclaimer, the term of this patent is extended or adjusted [\*] Notice: under 35 USC 154(b) by 197 days.

Delete the phrase "by 197 days" and insert - by 180 days--

Doc Code: PET.PTA.RCAL

Document Description: Request for Recalculation in view of Wyeth

PTO/SB/131 (01-10) Approved for use through 02/28/2011. OMB 0651-0020

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

Attorney Docket Number: \$0255.0028/P028 Patent Number: 7,667,868

Filing Date (or 371(b) or (f) Date): 03-01-2006 Issue Date: 02-23-2010

First Named Inventor:

Yoshinori Hayashi

Title: OPTICAL SCANNING DEVICE AND IMAGE FORMING APPARATUS

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-WYETH INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

	^^
Signature MMAN MM W	Date August \$6, 2010
Name (Print/Typed) Jennifer M. McCue	Registration Number 55,440
Note: Signatures of all the inventors or assignees of record of the entire interest or their representations of the signature. If necessary, subsee below*.	
*Total of forms are submitted.	

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/26/2010

DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403

Applicant : Yoshinori Hayashi

Patent Number: 7667868 : 02/23/2010 Issue Date

Application No: 11/364,073 Filed : 03/01/2006 : DECISION ON REQUEST FOR : RECALCULATION of PATENT

: TERM ADJUSTMENT IN VIEW : OF WYETH AND NOTICE OF INTENT TO

: ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 1029 days. The USPTO will sua sponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Paper No.

QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO CA 92121

# MAILED OCT 04 2011

### OFFICE OF PETITIONS

In re Patent No. 7,991,416

Lindner

Issue Date: August 2, 2011 Application No. 11/364,145

Filed: February 27, 2006

Atty Docket No. 050729

: DECISION ON REQUEST

: FOR

: RECONSIDERATION OF

: PATENT TERM ADJUSTMENT

: and

: NOTICE OF INTENT TO ISSUE

: CERTIFICATE OF CORRECTION

This is a decision on the petition filed on September 30, 2011, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand two hundred fifty-three (1253) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand two hundred fifty-three (1253) days is **GRANTED**.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Patentee correctly argues that the over three year period was not properly calculated beginning on February 28, 2009 and ending on January 10, 2011, the day before the first RCE was filed, which amounts to 682 days for "B" delay. See U.S.C. 154(b)(1)(B)(i). The Office used an incorrect date for the filing of the RCE. The period of B delay of 317 days based on

the incorrect date has been removed and a period of 682 days has been entered.

The Office will sua sponte issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given one (1) month or thirty (30) days, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one thousand two hundred fifty-three (1253) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

in¢y Jahnson

Senior Petitions Attorney

Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

## UNITED STATES PATENT AND TRADEMARK OFFICE **CERTIFICATE OF CORRECTION**

PATENT

7,991,416 B2

DATED

August 2, 2011

**DRAFT** 

INVENTOR(S): Lindner

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 888 days

Delete the phrase "by 888 days" and insert - by 1253 days--



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.usplo.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
11/364,168	03/01/2006	Yoram Nelken	40003959-0007-002	9037	
26263 SNR DENTON	16263 7590 01/20/2012 SNR DENTON US LLP		EXAM	INER	
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			ART UNIT	PAPER NUMBER	
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	,		MAIL DATE	DELIVERY MODE	
			01/20/2012	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.





Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

# JAN 2 0 2012

Tarek N. Fahmi SNR Denton US LLP PO BOX 061080 Chicago, Illinois 60606-1080

In re application of

Yoram Nelken

Application No. 11/364,168

Filed: March 1, 2006

For: AUTOMATIC SCHEDULING

**METHOD AND APPARATUS** 

DECISION ON PETITION

TO ACCEPT COLOR PHOTOGRAPHS

UNDER 37 C.F.R. SECTION 1.84(a)(2)

This is a decision on the petition filed on November 17, 2006 requesting acceptance of color photographs under 37 C.F.R. Section 1.84(b)(2).

The petition to accept color drawings is **DISMISSED**.

The petition requests that the United States Patent and Trademark Office accept color photographs in lieu of black and white drawings. Specifically, although Applicant does not specify in its petition which Figures are at issue, it is evident that Figures 20–31 are pertinent to the petition, comprising screen shot photographs showing exemplary windows of preferred implementations of Applicant's invention. See Applicant's Specification, March 1, 2006, pg. 5.

37 C.F.R. Section 1.84(b)(1) and (2) set forth the following regarding photographs:

(b) Photographs .—

(1) Black and white. Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. The Office will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. For example, photographs or photomicrographs of: electrophoresis gels, blots (e.g., immunological, western, Southern, and northern), autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, and, in a design patent application, ornamental effects, are acceptable. If the subject matter of the application admits of illustration by a drawing, the examiner may require a drawing in place of the photograph. The photographs must be of sufficient quality so that all details in the photographs are reproducible in the printed

patent.

(2) Color photographs. Color photographs will be accepted in utility and design patent applications if the conditions for accepting color drawings and black and white photographs have been satisfied. See paragraphs (a)(2) and (b)(1) of this section.

Furthermore, 37 C.F.R Section 1.84, Standards for Drawings, sets forth the following:

§ 1.84 Standards for drawings.

(a) Drawings. There are two acceptable categories for presenting drawings in utility and design patent applications.

(1) Black ink. Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings; or

- (2) Color. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility or design patent application or the subject matter of a statutory invention registration. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13), or in an application, or copy thereof, submitted under the Office electronic filing system. The Office will accept color drawings in utility or design patent applications and statutory invention registrations only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:
- (i) The fee set forth in § 1.17(h);

(ii) Three (3) sets of color drawings;

(iii) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings: The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

**NOTE**: According to Section H of the Legal Framework for EFS-Web (17DEC09),"only one set of such color drawings is necessary when filing via EFS-Web."

As such, for a petition for color photographs to be granted, color photography must be the only practicable medium for illustrating the claimed invention, and the conditions for accepting color drawings and black and white photographs must have been satisfied, whereby the petition must include all of the requirements of 37 C.F.R. 1.84 (a)(2)(i)–(iii).

While Applicant's petition was accompanied by 1.84(a)(2)(i) the fee set forth in Section 1.17(h), (ii) three sets of color photographs, and (iii) a proposed amendment to the specification comprising the required language in the first paragraph of the brief description of the drawings, Applicant has not offered any evidence as to why color photography is the only practicable

medium for illustrating the claimed invention. Also, upon further consideration of the screenshots of Figures 20–31, there is no evidence that reducing these color photographs to black and white drawings would prevent them from accurately depicting the windows, calendars, tables, and other data, or result in a loss of certain features if reproduced in black and white. Therefore, it is determined that color photography is not the only practicable medium for illustrating the claimed invention.

As a result, Applicant's submission does not meet all the criteria set out above. Thus, the petition is **DIMISSED**.

Telephone inquiries should be directed to Beth Boswell, Supervisory Patent Examiner, at (571) 272-6737.

Beth Boswell

Supervisory Patent Examiner, Art Unit 3623

Patent Technology Center 3600

(571) 272-6737

Doc Code: PET.PTA.RCAL

**Document Description: Request for Recalculation in view of Wyeth** 

Approved for use through 02/28/2011. OMB 0651-0020

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

Attorney Docket Number: 050347

Patent Number: 7,656,743

Filing Date (or 371(b) or (f) Date): 02-28-2006

Issue Date: 2-2-2010

First Named Inventor:

່ຶ Vaishnav Srinivas

Title: CLOCK SIGNAL GENERATION TECHNIQUES FOR MEMORIES THAT DO NOT GENERATE A STROBE

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-WYETH INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

Signature /Ramin Mobarhan, Reg# 50,182/	Date 07-29-2010
Name (Print/Typed) Ramin Mobarhan	Registration Number 50182
Note: Signatures of all the inventors or assignees of record of the entire interest or their representations of the entire interest or their representations of the entire interest or their representations.	

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.

V	*Total of_1	forms are submitted
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The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.** 

# Instruction Sheet for: REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

(Not to be Submitted to the USPTO)

This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A).

This form must be filed within 180 days of the day the patent was granted, with the following exception:

Patentees who received a decision from the USPTO under the USPTO's pre-<u>Wyeth</u> interpretation of 35 U.S.C. 154(b)(2)(A) may file a request for reconsideration of that decision if such a request for reconsideration is filed within **two months** of the date of the decision (37 CFR 1.181(f)). If the patentee's sole basis for requesting reconsideration of the decision is the USPTO's pre-<u>Wyeth</u> interpretation of 35 U.S.C. 154(b)(2)(A), the request for reconsideration need only state that reconsideration is being requested in view of <u>Wyeth</u> (this form may be used for this purpose if it is filed within **two months** of the date of the decision from the USPTO).

Do not use this form if the application has been allowed, but not yet issued as a patent.

- 1. For patents issued before March 2, 2010: A request for reconsideration under 37 CFR 1.705(d) and the fee set forth in 37 CFR 1.18(e) are not required, provided that the patentee's sole basis for requesting recalculation of the PTA in the patent is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A) and this form is filed within 180 days of the day the patent was granted.
- 2. For patents issued on or after March 2, 2010 (do not use this form): Patentees seeking a revised PTA in a patent issued on or after March 2, 2010, must file a request for reconsideration under 37 CFR 1.705(d) that complies with the requirements of 37 CFR 1.705(b)(1) and (b)(2) within two months of the day the patent issued.

For more information, see "Notice Concerning Calculation of the Patent Term Adjustment With Respect to the Overlapping Delay Provision of 35 U.S.C. 154(b)(2)(A)" available on the USPTO Web site at http://www.uspto.gov/patents/law/notices/2010.jsp.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

### Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

- 1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
- 2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
- A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record
- 4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
- 5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
- 6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
- 7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
- 8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
- 9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/11/2010

QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121

**Applicant**: Vaishnav Srinivas

Patent Number : 7656743

Issue Date : 02/02/2010

Application No. : 11/364 206

**Application No:** 11/364,296 **Filed :** 02/28/2006

: DECISION ON REQUEST FOR : RECALCULATION of PATENT

: TERM ADJUSTMENT IN VIEW : OF WYETH AND NOTICE OF INTENT TO

: OF WYETH AND NOTICE OF INTENT TO : ISSUE CERTIFICATE OF CORRECTION

:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be  $\bf 96$  days. The USPTO will  $\it suasponte$  issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

NASH & TITUS, LLC 21402 UNISON RD MIDDLEBURG VA 20117

MAILED

MAR 07 2011

In re Application of Kevin K. Pitzer et al.

OFFICE OF PETITIONS

Application No. 11/364,425

**DECISION ON PETITION** 

Filed: February 28, 2006

Attorney Docket No. ARMY 120C

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 11, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Restriction Requirement, mailed November 02, 2006, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). The response dated October 5, 2007, was filed after the expiration of the extendable time period. Accordingly, the application became abandoned on December 03, 2006.

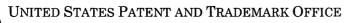
The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) a reply to the Restriction Requirement, (2) the petition fee of \$1620, and (3) a proper statement of unintentional delay. Accordingly, the reply to the Restriction Requirement on November 2, 2006, submitted with the petition is accepted as having been unintentionally delayed.

The application is being forwarded to the Technology Center Group Art Unit 1624 for further processing. This decision ratifies the prosecution of the application from the mailing date of the Non-final Office action of May 13, 2008, until the mailing date of the instant decision.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at (571) 272-2783.

Ramesh Krishnamurthy

Petitions Examiner
Office of Petitions





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Gus Hampilos Patent Counsel Engelhard Corporation 101 Wood Avenue Iselin NJ 08830

MAILED

MAR 08 2011

**OFFICE OF PETITIONS** 

In re Application of Speronello, et al.

Application No. 11/364,527

Filed: February 28, 2006 Attorney Docket No. 5164

For: CHLORINE DIOXIDE BASED

CLEANER/SANITIZER

ON PETITION

This is a decision on the petition, filed January 31, 2011, under 37 CFR 1.137(b) to revive the above-identified application.

### The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely submit a reply within three (3) months of the mailing of the March 17, 2010 final Office action. No response being received and no extensions of time being obtained under the provisions of 37 CFR 1.136(a), this application became abandoned on June 18, 2010. A Notice of Abandonment was mailed on October 1, 2010.

Applicants have submitted a RCE and required \$810.00 fee and amendment in reply to the March 17, 2010 final Office action, an acceptable statement of the unintentional nature of the delay in responding to the March 17, 2010 final Office action, and the \$1,620.00 petition fee.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, practitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, practitioner must notify the Office.

All of the requirements under 37 CFR 1.137(b) being met, the petition is granted.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney document must be submitted. While a courtesy copy of this decision is being mailed to the person signing the petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

After the mailing of this decision, the application will be returned to Technology Center AU 1616 for consideration of the RCE and amendment filed on January 31, 2011.

Telephone inquiries should be directed to the undersigned at (571) 272-3230.

Shurene Willis Brantley
Shirene Willis Brantley

Senior Petitions Attorney

Office of Petitions

Office of the Deputy Commissioner

for Patent Examination Policy

CC: STUART D. FRENKEL

FRENKEL & ASSOCIATES, P.C.

3975 UNIVERSITY DRIVE, SUITE 330

FAIRFAX, VA 22030



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

# EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON MA 02205

MAILED

JAN 1 1 2011

OFFICE OF PETITIONS

In re Application of

DIPIPPO, Joe

Application No. 11/364,592

Filed: February 28, 2006

Attorney Docket No. 84987(303923)

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 23, 2010.

#### The request is APPROVED.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by Joshua Jones on behalf of all attorneys of record who are associated with customer No. 21874. All attorneys/agents associated with the Customer Number 21874 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the inventor Joe Dipippo at the address indicated below.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

/Tredelle D. Jackson/ Paralegal Specialist Office of Petitions

cc:

JOE DIPIPPO 36 MANCHESTER ROAD EASTCHESTOR NY 10709



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO. FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO. CONFIRMATION NO. 11/364.682 02/28/2006 Hira L. Nakhasi 015280-569200US 9465 **EXAMINER** 01/11/2011 TOWNSEND AND TOWNSEND AND CREW, LLP ARCHIE, NINA TWO EMBARCADERO CENTER PAPER NUMBER ART UNIT 8TH FLOOR SAN FRANCISCO, CA 94111

1645

MAIL DATE DELIVERY MODE
01/11/2011 PAPER

#### **ACKNOWLEDGEMENT OF REQUEST**

Notice of Allowance/Allowability Mailed

The request to print a color drawing reference as the first paragraph in the portion of the specification containing a brief description of the drawings as required by 37 CFR 1.84 and MPEP § 608.02 has been received by the United States Patent and Trademark Office and will be entered into the specification.

571-272-4200 or 1-888-786-0101 Application Assistance Unit Office of Data Management



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

January 11, 2011

TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO CA 94111

In re Application of : **DECISION ON PETITION** 

NAKHASI, HIRA L., ET AL

Application No: 11/364682 : ACCEPTANCE OF COLOR

Filed: 02/28/2006 : DRAWINGS

Attorney Docket: 015280-569200US

This is a decision on the Petition to Accept Color Drawings under 37 C.F.R 1.84 (a) (2), received in the United States Patent and Trademark Office (USPTO) February 28, 2006.

The petition is **GRANTED**.

A grantable petition under 37 C.F.R. 1.84(a) (2) must be accompanied by the following.

- 1. The fee set forth under 37 C.F.R. 1.17(h),
- 2. Three (3) sets of the color drawings in question, or (1) set if filed via EFS, and
- 3. The specification containing the following language as the first paragraph in that portion of the specification relating to the brief description of the drawings.

"The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee."

The petition was accompanied by all of the required fees and drawings. The specification contains the appropriate language. Therefore, the petition is <u>GRANTED.</u>

Telephone inquires relating to this decision may be directed to the undersigned in the Office of Data Management at 571-272-4200.

/Bernadette Queen/ Quality Control Specialist Office of Data Management Publications Branch

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

MAILED

MAY 23 2011

ORRICK HERRINGTON & SUTCLIFFE, LLP IP PROSECUTION DEPARTMENT 4 PARK PLAZA SUITE 1600 IRVINE, CA 92614-2558

OFFICE OF PETITIONS

In re Application of

David C. Forster et al

Application No. 11/364,724

Filed: February 27, 2006

Attorney Docket No. 14992.4004

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed April 22, 2011, to revive the above-identified application.

### The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is not final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item (1).

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of October 12, 2010. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). *See* MPEP 711.03(c)(III)(A)(2). Since the amendment submitted does not *prima facie* place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), RCE, or the filing of a continuing application under 37 CFR 1.53(b).

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the \$555 extension of time submitted with the petition on April 22, 2011 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credit to petitioner's credit card.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop PETITIONS

Commissioner for Patents Post Office Box 1450

Alexandria, VA 22313-1450

By hand:

**Customer Service Window** 

Randolph Building 401 Dulany Street Alexandria, VA 22314

•

By facsimile:

(571) 273-8300

ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at

(571) 272-3210.

Trvin Dingle

Petitions Examiner Office of Petitions

Attachment: Advisory Action

	Application No.	Applicant(s)		
Advisory Action	11/364,724	FORSTER ET AL.		
Before the Filing of an Appeal Brief	Examiner	Art Unit		
	CHRISTOPHER L. TEMPLETON	3773		
The MAILING DATE of this communication appe	ars on the cover sheet with the c	orrespondence address		
THE REPLY FILED <u>22 April 2011</u> FAILS TO PLACE THIS APP	LICATION IN CONDITION FOR AL	LOWANCE.		
1.  The reply was filed after a final rejection, but prior to or on this application, applicant must timely file one of the follow places the application in condition for allowance; (2) a No a Request for Continued Examination (RCE) in compliance time periods:	wing replies: (1) an amendment, aff stice of Appeal (with appeal fee) in c	idavit, or other evidence, which compliance with 37 CFR 41.31; or (		
a) The period for reply expires 3 months from the mailing date				
no event, however, will the statutory period for reply expire I	b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPER 706 07(f)			
have been filed is the date for purposes of determining the period of ex under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the s set forth in (b) above, if checked. Any reply received by the Office later	Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1:704(b).			
<ol> <li>The Notice of Appeal was filed on A brief in comp filing the Notice of Appeal (37 CFR 41.37(a)), or any exte a Notice of Appeal has been filed, any reply must be filed AMENDMENTS</li> </ol>	nsion thereof (37 CFR 41.37(e)), to	avoid dismissal of the appeal. Sind		
3. The proposed amendment(s) filed after a final rejection,	but prior to the date of filing a brief	will not be entered because		
(a) \( \sum \) They raise new issues that would require further co				
(b) They raise the issue of new matter (see NOTE belo				
(c) They are not deemed to place the application in be	tter form for appeal by materially re	ducing or simplifying the issues for		
appeal; and/or (d) ☐ They present additional claims without canceling a	corresponding number of finally rei	ected claims		
NOTE: See Continuation Sheet. (See 37 CFR 1.1				
4. The amendments are not in compliance with 37 CFR 1.1	1 7	empliant Amendment (PTOL-324).		
5. Applicant's reply has overcome the following rejection(s)	:	•		
<ol> <li>Newly proposed or amended claim(s) would be all non-allowable claim(s).</li> </ol>	llowable if submitted in a separate,	timely filed amendment canceling t	he	
7.  For purposes of appeal, the proposed amendment(s): a) how the new or amended claims would be rejected is pro The status of the claim(s) is (or will be) as follows:	⊠ will not be entered, or b) ☐ wi vided below or appended. ´	Il be entered and an explanation of		
Claim(s) allowed:				
Claim(s) objected to: <u>46</u> . Claim(s) rejected: <u>30-45 and 47-57</u> .	·			
Claim(s) vijected: 50 40 47 57.  Claim(s) withdrawn from consideration:				
AFFIDAVIT OR OTHER EVIDENCE				
<ol> <li>The affidavit or other evidence filed after a final action, but because applicant failed to provide a showing of good an was not earlier presented. See 37 CFR 1.116(e).</li> </ol>			nd	
<ol> <li>The affidavit or other evidence filed after the date of filing entered because the affidavit or other evidence failed to showing a good and sufficient reasons why it is necessar</li> </ol>	overcome all rejections under appe	al and/or appellant fails to provide a	a	
10. ☐ The affidavit or other evidence is entered. An explanatio REQUEST FOR RECONSIDERATION/OTHER	n of the status of the claims after e	ntry is below or attached.		
11. The request for reconsideration has been considered bu	ut does NOT place the application i	n condition for allowance because:		
12. Note the attached Information Disclosure Statement(s).  13. Other:	(PTO/SB/08) Paper No(s)			

### **Continuation Sheet (PTOL-303)**

Application No.

Continuation of 3. NOTE: The addition of the new independent claim requires further consideration due to new dependency of all dependent claims and further consideration for antecedent bases of all the dependent claims.



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

ORRICK HERRINGTON & SUTCLIFFE, LLP IP PROSECUTION DEPARTMENT 4 PARK PLAZA, SUITE 1600 IRVINE, CA 92614-2558

MAILED

JUL 25-2011

OFFICE OF PETITIONS

In re Application of

David C. Forster et al

Application No. 11/364,724

Filed: February 27, 2006

Attorney Docket No. 14992.4004

ON PETITION

This is a decision on the petition filed July 8, 2011, which is being treated as a renewed petition under the unintentional provisions of 37 CFR 1.137(b), to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of \$405 and the submission required by 37 CFR 1.114; (2) the petition fee of \$810; and (3) a proper statement of unintentional delay.

The \$555 extension of time submitted with this renewed petition is unnecessary and will be credit to petitioner's credit card.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3210.

This application is being referred to Technology Center AU 3773 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Petition Examiner
Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

KF ROSS PC 5683 RIVERDALE AVENUE SUITE 203 BOX 900 BRONX NY 10471-0900 MAILED

JAN 1 2 2011

OFFICE OF PETITIONS

In re Patent No. 7,669,932 Issue Date: March 2, 2010 Application No. 11/364,805 Filed: February 28, 2006 Attorney Docket No. 23555

**DECISION ON PETITION** 

This is a decision on the Statement Under 37 CFR 3.81(b) and 37 CFR 1.323 Re Assignment, filed April 13, 2010, requesting correction on the Title Page of the subject patent to identify the correct spelling of the second inventor's name and correct residence. The statement is being treated as a Petition Under 37 CFR 3.81(b). A completed Certificate of Correction Form (PTO/SB/44) was submitted with petition

The petition under 37 CFR 3.81(b) is **GRANTED**.

Petitioner urges that the present Petition was submitted to correct the spelling of the second inventor's name and correct residence. Accordingly, petitioner requests, in effect, that the Title Page of the above-identified patent be corrected, via issuance of a Certificate of Correction, to correct the spelling of the inventor's name and correct residence identified thereon from:

"Svan Spielmann, Riverdale (Bronx), NY (US)"

to:

-Sven Spielmann, Amberg, DE -

37 CFR 3.81(b), effective June 25, 2004, reads:

After payment of the issue fee: Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a) and the processing fee set forth in § 1.17(i) of this chapter.



U.S. Patent No. 7,669,932 Application No. 11/364,805 Decision on Petition under 37 CFR 3.81

Page 2

The requisite \$100.00 fee (Fee Code 1811), as set forth under 37 CFR 1.20(a), and the requisite \$100.00 of the processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(i) have been previously submitted. However, an additional \$30.00 is needed towards the processing fee. Since, the petition was accompanied deposit account authorization to charge any required fees, the additional \$30.00 has been charged as authorized. Further, Office assignment records are consistent with the requested correction. Accordingly, since the Petition complies with the provisions of 37 CFR 3.81(b), it is appropriate for any other reasons that the Office may have to issue a Certificate of Correction in accordance with the content of the Form (PTO/SB/44) that was previously submitted.

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

Any questions concerning the issuance of a Certificate of Correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,669,932.

Cheryl Gibson-Baylor

Petitions Examiner
Office of Petitions

1 sho lie beidi

### SPE RESPONSE FOR CERTIFICATE OF CORRECTION

		Pa	aper No.:7/2011		
DATE	: July 21, 2011				
TO SPE OF	: ART UNIT 1634				
SUBJECT	: Request for Certificate of Correct	etion on Patent No.: 11/364,842			
A response is	requested with respect to the accomp	panying request for a certificate of c	correction.		
Please complete this form and return with file, within <b>7</b> days to: <b>Certificates of Correction Branch - PK 3-910</b> Palm location <b>7590</b> - Tel. No. 305-8201					
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.					
Thank You F	For Your Assistance	Certificates of Correction	Branch		
	for issuing the above-identified on the appropriate box.	correction(s) is hereby:			
⊠ Ap	Approved All changes apply.				
□Ар	Approved in Part Specify below which changes do not apply.		not apply.		
☐ De	nied	State the reasons for denial below.			
Comments:					
		SPE: <u>Dave Nguyen</u>	Art Unit 1634		



COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspio.gov

Paper No.

MAILED

SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938

MINNEAPOLIS MN 55402

SEP 2 1 2010

**OFFICE OF PETITIONS** 

In re Patent No. 7,642,391 : DECISION ON REQUEST

Urgaonkar et al. : FOR

Issue Date: January 5, 2010 : RECONSIDERATION OF

Application No. 11/364,878 : PATENT TERM ADJUSTMENT Filed: February 28, 2006 : and NOTICE OF INTENT TO

Atty Docket No. 900.218US1 : ISSUE CERTIFICATE OF CORRECTION

This is a decision on the "APPLICATION FOR POST-ISSUE PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," which is being treated as a petition pursuant to 37 C.F.R. 1.705(d), filed June 21, 2010. Patentee requests that the patent term adjustment be corrected from nine hundred and eighty-three (983) days to one thousand, one hundred and ninety-eight (1198) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **DISMISSED**.

Patentee is given one (1) month or thirty (30) days, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 C.F.R. § 1.136.

Application No. 11/364,878 matured into U.S. patent No. 7,642,391 on January 5, 2010, with a patent term adjustment of 887 days. On May 19, 2010, Patentee filed a Request for Recalculation of Patent Term Adjustment in view of Wyeth. On May 21, 2010, the Office mailed a "DECISION ON REQUEST FOR RECALCULATION of PATENT TERM ADJUSTMENT IN VIEW OF WYETH AND NOTICE OF INTENT TO ISSUE CERTIFICATE OF CORRECTION," indicating that the patent term adjustment had been determined to be 983 days.

Patentee has indicated that this patent is not subject to a terminal disclaimer.1

Patentee contests two periods of delay.

First, this application was filed on February 28, 2006, and a notice of allowance was mailed 14 months and 887 days later on October 1, 2009. This constitutes 887 days of delay pursuant to 37 C.F.R. § 703(a)(2). However, Patentee requests clarification, and Patentee asserts "...these 887 days credit to Applicant's patent term have now been reduced to 672 by USPTO without any basis or justification."

Secondly, this patent issued three years and 311 days after the date on which this application was filed. As such, Patentee argues that the B-delay (37 C.F.R. § 1.703(b)) should be 311 days (887 examination delay + 311 B delay - 0 Applicant delay = 1198).

Both points can be explained by the fact that Patentee has failed to take into account the overlap when calculating the patent term adjustment: the entire 215-day period from February 28, 2009 to October 1, 2009 overlaps with the period of B-delay.

Regarding the first point, when the computer processed the May 19, 2010 Request for Recalculation of Patent Term Adjustment in view of Wyeth, instead of clearly showing that there were 215 days of overlap, it instead backed 215 days out of the 887 days. of examination delay to arrive at 672 (887 - 215 = 672) days.

Regarding the second point, the patent term adjustment of 983 (887 examination delay + 311 B-delay - 215 overlap - zero applicant delay) days as set forth in the mailing of May 21, 2010 is correct.

The patent is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by nine hundred and eighty-three (983) days, as noted in the May 21, 2010 mailing.

<sup>1</sup> Statement of facts submitted concurrently with this petition, page 1.

The Office acknowledges submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e). No additional fees are required.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail, hand-delivery, or facsimile. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.

Telephone inquiries specific to this matter should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

Anthony Knight

Director

Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

<sup>&</sup>lt;sup>2</sup> Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

<sup>&</sup>lt;sup>3</sup> Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314

<sup>4 (571) 273-8300 -</sup> please note this is a central facsimile number.

https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

## UNITED STATES PATENT AND TRADEMARK OFFICE **CERTIFICATE OF CORRECTION**

**PATENT** 

: 7,642,391 B1

DATED

January 5, 2010

DRAFT

INVENTOR(S): Urgaonkar et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 887 days

Delete the phrase "by 887 days" and insert - by 983 days--



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.usplo.gov

•				
APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/365,025	03/01/2006	3/01/2006 Robert Paul Morris	I378/US	1455
52354	7590 11/22/2010		EXAM	INER
SCENERA R	RESEARCH, LLC		BRANSKE	, HILARY
JENKINS, WILSON, TAYLOR & HUNT, P.A.		ART UNIT	PAPER NUMBER	
5400 Trinity R Suite 303	Coad		2437	
Raleigh, NC 27607		DATE MAILED: 11/22/2010		

Please find below and/or attached an Office communication concerning this application or proceeding.

The request for deferral/suspension of action under 37 CFR 1.103 has been approved.



Scenera Research, LLC Jenkins, Wilson, Taylor & Hunt, P.A. 5400 Trinity Road Suite 303 Raleigh NC 27607

In re Application of:

Morris

Appl. No.: 11/365025 Filed: March 1, 2006

For: Methods, Systems and Computer Program Products for Providing a Client Device with Temporary Access to a Service During Authentication of the Client Device DECISION ON PETITION UNDER 37 CFR § 1.103(a)

This is a decision on the petition for suspension of prosecution under 37 CFR § 1.103(a) filed on November 2, 2010. This is the second petition for suspension. The first suspension was filed on February 9, 2010 and Granted on May 18, 2010.

#### The petition is **GRANTED**.

Pursuant to applicant's request filed on November 2, 2010, action by the Office is suspended on this application under 37 CFR § 1.103(a) for a period of six (6) months from November 2, 2010. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

Any inquiry concerning this decision should be directed to Tod Swann whose telephone number is (571) 272-3612.

Tod Swann, SPRE/QAS Technology Center 2400



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/365,025	03/01/2006	Robert Paul Morris	I378/US	1455
52354 SCENERA RE	7590 07/05/2011	EXAM	INER	
SCENERA RESEARCH, LLC JENKINS, WILSON, TAYLOR & HUNT, P.A.			BRANSKE, HILARY	
5400 Trinity Road Suite 303			ART UNIT	PAPER NUMBER
Raleigh, NC 2	Raleigh, NC 27607			
			MAIL DATE	DELIVERY MODE
			07/05/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Scenera Research, LLC Jenkins, Wilson, Taylor & Hunt, P.A. 5400 Trinity Road Suite 303 Raleigh NC 27607

MAILED

JUL 05 2011

DIRECTOR OFFICE TECHNOLOGY CENTER 2400 ~

*In re* Application of:

**Morris** 

Appl. No.: 11/365025 Filed: March 1, 2006

For: Methods, Systems and Computer Program Products for Providing a Client Device with Temporary Access to a Service During Authentication of the Client Device

**DECISION ON PETITION** UNDER 37 CFR § 1.103(a)

This is a decision on the petition for suspension of prosecution under 37 CFR § 1.103(a) filed on May 9, 2011. This is the third petition for suspension. The second suspension was filed on November 2, 2010 and Granted on November 22, 2010. The first suspension was filed on February 9, 2010 and Granted on May 18, 2010.

#### The petition is **GRANTED**.

Pursuant to applicant's request filed on May 9, 2011, action by the Office is suspended on this application under 37 CFR § 1.103(a) for a period of six (6) months from May 9, 2011. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

Any inquiry concerning this decision should be directed to Christopher Grant whose telephone number is (571) 272-7294.

Christopher Grant, WQAS

Technology Center 2400



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
11/365,025	03/01/2006	Robert Paul Morris	I378/US	1455
52354 75	01/06/2012		EXAM	INER
SCENERA RESEARCH, LLC		BRANSKE, HILARY		
5400 Trinity Ro	LSON, TAYLOR & HUNT oad	, P.A.	ART UNIT	PAPER NUMBER
Suite 303	F :		2437	
Raleigh, NC	27607.		DATE MAILED: 01/06/2012	2

Please find below and/or attached an Office communication concerning this application or proceeding.

The request for deferral/suspension of action under 37 CFR 1.103 has been approved.



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/365,025	03/01/2006	Robert Paul Morris	I378/US	1455
	7590 01/06/2012 SEARCH LLC		EXAM	INER
JENKINS, WI	SCENERA RESEARCH, LLC JENKINS, WILSON, TAYLOR & HUNT, P.A.		BRANSKE, HILARY	
5400 Trinity R Suite 303	oad	,	ART UNIT	PAPER NUMBER
Raleigh, NC 27	7607		2437	
			MAIL DATE	DELIVERY MODE
		•	01/06/2012	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Scenera Research, LLC Jenkins, Wilson, Taylor & Hunt, P.A. 5400 Trinity Road Suite 303 Raleigh NC 27607

MAILED

JAN 06 2012

DIRECTOR OFFICE TECHNOLOGY CENTER 2400

In re Application of:

Morris

Appl. No.: 11/365025 Filed: March 1, 2006

For: Methods, Systems and Computer Program Products for Providing a Client Device with Temporary Access to a Service During Authentication of the Client Device DECISION ON PETITION UNDER 37 CFR § 1.103(a)

This is a decision on the petition for suspension of prosecution under 37 CFR § 1.103(a) filed on November 9, 2011. This is the fourth petition for suspension.

#### The petition is **GRANTED**.

Pursuant to applicant's request filed on November 9, 2011, action by the Office is suspended on this application under 37 CFR § 1.103(a) for a period of six (6) months from the mailing of this letter. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

Any inquiry concerning this decision should be directed to Christopher Grant whose telephone number is (571) 272-7294.

/Christopher Grant/ Christopher Grant, WQAS Technology Center 2400



#### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/05/2010

TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834

Applicant : Tetsuya Fushimi

Patent Number: 7668060 Issue Date : 02/23/2010

Application No: 11/365,029 Filed : 02/28/2006 : DECISION ON REQUEST FOR : RECALCULATION of PATENT

: TERM ADJUSTMENT IN VIEW

: OF WYETH AND NOTICE OF INTENT TO

: ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 920 days. The USPTO will sua sponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

DATE	: 4/28/11	Paper No.: 042
TO SPE OF	: ART UNIT	
SUBJECT: Request for Certificate of Correction for Appl. No.: 11/365.085 Patent No. 7.555,505		ion for Appl. No.: <u>11/365.085</u> Patent No. <u>7.555,505</u>
		CofC mailroom date 4/19/11
Please resp	ond to this request for a cert	ificate of correction within 7 days.
FOR IFW FI	ILES:	
IFW applica		orrections as shown in the <b>COCIN</b> document(s) in the should be introduced, nor should the scope or
	plete the response (see belonent code <b>COCX</b> .	w) and forward the completed response to scanning
FOR PAPE	R FILES:	
		orrections as shown in the attached certificate of see below) and forward it with the file to:
	ficates of Correction Brand	
	Iolph Square – 9D10-A Location 7580	Fract C White I IF
	• •	_Ernest C. White, LIE
	• •	Certificates of Correction Branch
Palm	Location 7580	
Palm Thank You	Location 7580  For Your Assistance	Certificates of Correction Branch 703-756-1814
Palm Thank You The reques	Location 7580  For Your Assistance	Certificates of Correction Branch
Palm  Thank You  The reques  Note your decision	For Your Assistance	Certificates of Correction Branch 703-756-1814
Palm  Thank You  The reques  Note your decision	For Your Assistance It for issuing the above-iden on the appropriate box.	Certificates of Correction Branch 703-756-1814 entified correction(s) is hereby:
Palm  Thank You  The reques  Note your decision	For Your Assistance st for issuing the above-ide n on the appropriate box. Approved	Certificates of Correction Branch 703-756-1814 entified correction(s) is hereby:  All changes apply.
Palm Thank You The reques Note your decision	For Your Assistance  It for issuing the above-ide non the appropriate box.  Approved  Approved in Part	Certificates of Correction Branch 703-756-1814  Intified correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.  In the certificate of re approved. They



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Decision Date: October 7,2011

In re Application of : DECISION ON REQUEST TO WITHDRAW AS

Tracy Maahs ATTORNEY/AGENTOF RECORD

Application No: 11365088

Filed: 28-Feb-2006

Attorney Docket No: USGINZ00740

This is an electronic decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed October 7,2011

The request is **APPROVED.** 

The request was signed by Johney U. Han (registration no. 45565) on behalf of all attorneys/agents associated with Customer Number 40518 . All attorneys/agents associated with Cusotmer Number 40518 have been withdrawn.

Since there are no remaining attorneys of record, all future communications from the Office will be directed to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71, with correspondence address:

Name USGI Medical, Inc.

Name2

Address 1 1140 Calle Cordillera

Address 2

City San Clemente

State CA

Postal Code 92673

Country US

As a reminder, requester is required to inform the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 of the electronically processed petition.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

Office of Petitions

REQUEST FOR WITHDRAWAL AS ATTORNI CORRESPONDENCE ADDRESS	EY OR AGENT AND CHANGE OF			
11365088				
28-Feb-2006				
Tracy Maahs				
3779	3779			
MATTHEW KASZTEJNA				
USGINZ00740				
Methods and apparaus for off-axis visualiza	Methods and apparaus for off-axis visualization			
	t application and 40518			
those described in 37 CFR:				
· · · · · · · · · · · · · · · · · · ·	response period, that the practitioner(s)			
	ient all papers and property (including funds)			
☑ I/We have notified the client of any responses that may be due and the time frame within which the client must respond				
	st named inventor or assignee that has			
USGI Medical, Inc.				
1140 Calle Cordillera				
San Clemente				
CA				
92673				
US				
	28-Feb-2006  Tracy Maahs  3779  MATTHEW KASZTEJNA  USGINZ00740  Methods and apparaus for off-axis visualization of the above identified patent associated with Customer Number:  those described in 37 CFR:  notice to the client, prior to the expiration of the oloyment  lient or a duly authorized representative of the client or a duly authorized representative of the client to 37 CFR 3.71:  USGI Medical, Inc.  1140 Calle Cordillera  San Clemente  CA  92673			

I am authorized to sign on behalf of myself and all withdrawing practitioners.		
Signature /Johney U. Han/		
Name Johney U. Han		
Registration Number 45565		



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

WYATT, TARRANT & COMBS, LLP 1715 AARON BRENNER DRIVE SUITE 800 MEMPHIS TN 38120-4367

**MAILED** 

OCT 2 0 2010

In re Application of : OFFICE OF PETITIONS

Wayne S. Freeze : Application No. 11/365,131 : DECISION ON PETITION

Filed: March 1, 2006 :

Attorney Docket No. A310511.1US

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 29, 2010, to revive the above-identified application.

#### The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the final Office action mailed, January 21, 2010, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on April 22, 2010. A Notice of Abandonment was mailed July 29, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of \$405.00 and the submission required by 37 CFR 1.114; (2) the petition fee of \$810.00; and (3) a proper statement of unintentional delay.

Additionally, 37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is **not** a correct reading of the statement appearing in the petition.

Further, it is not apparent whether the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute this patent application. In accordance with 37 CFR 1.34(a), the signature appearing on the petition shall constitute a

representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

This matter is being referred to Technology Center AU 2121 for processing of the Request for Continued Examination under 37 CFR 1.114 and the Amendment filed with the instant petition.

Joan Olszewski

**Petitions Examiner** 

Office of Petitions



ANDREW F. SAYKO, JR 1014 CROOKED OAKS LANE SEABROOK ISLAND SC 29455 MAILED
JAN 03 2011
OFFICE OF PETITIONS

In re Application of

Richard Snow

Application No. 11/365,134

Filed: 03/01/2006

Title: METHOD AND SYSTEM FOR

ORDERING AND DELIVERING A

**PRODUCT** 

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 14, 2010, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before December 9, 2010, as required by the Notice of Allowance and Fee(s) Due, mailed September 9, 2010. Accordingly, the date of abandonment of this application is December 10, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied: (1) the reply in the form of payment of the issue fee and the publication fee; (2) the petition fee; and (3) a proper statement of unintentional delay.

This application is being referred to the Office of Data Management for processing into a patent.

Telephone inquiries specifically concerning this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell Senior Petitions Attorney

Christina Partera Donnell

Office of Petitions



CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD. 11TH FLOOR, SEVEN PENN CENTER 1635 MARKET STREET PHILADELPHIA PA 19103-2212 MAILED

JAN 25 2011

OFFICE OF PETITIONS

In re Application of

Charles Leonhardt, et al.

Application No. 11/365,167

Filed: March 1, 2006

Attorney Docket No. D2052/20001

**DECISION ON PETITION** 

TO MAKE SPECIAL UNDER

37 CFR 1.102(c)(1)

This is a decision on the petition under 37 CFR 1.102(c)(1), filed January 7, 2011, to make the above-identified application special based on applicant's age as set forth in M.P.E.P. § 708.02, Section IV.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section IV: Applicant's Age must be accompanied by evidence showing that at least one of the applicants is 65 years of age, or more, such as a birth certificate or a statement by applicant. No fee is required

The instant petition includes a statement from the inventor, Charles Leonhardt declaring that he is 65 years of age or older. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Terri Johnson at 571-272-2991.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

The application is being forwarded to the Technology Center Art Unit 1612 for action on the merits commensurate with this decision.

/Terri Johnson/ Terri Johnson Petitions Examiner Office of Petitions Doc Code: PET.PTA.RCAL

**Document Description: Request for Recalculation in view of Wyeth** 

Approved for use through 02/28/2011. OMB 0651-0020

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

Attorney Docket Number: Cortes 4-4-13 (M)-US-NP

Patent Number: 7,660,321

Filing Date (or 371(b) or (f) Date): March 1, 2006

Issue Date: February 9, 2010

First Named Inventor:

Mauricio Cortes

Title: System and method for prioritizing session initiation protocol messages

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-WYETH INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

<sub>Signature</sub> /Gregory J. Murgia/	Date August 9, 2010
Name (Print/Typed) Gregory J. Murgia	Registration Number 41,209

<u>Note</u>: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*

~	*Total of1	forms are submitted
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The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.** 



#### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/16/2010

Michael G. Fletcher FLETCHER YODER P.O. Box 692289 Houston, TX 77269-2289

Applicant : Mauricio Cortes

Patent Number: 7660321 Issue Date : 02/09/2010

**Application No:** 11/365,240 Filed : 03/01/2006 : DECISION ON REQUEST FOR : RECALCULATION of PATENT

: TERM ADJUSTMENT IN VIEW : OF WYETH AND NOTICE OF INTENT TO

: ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 610 days. The USPTO will sua sponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

#### SPE RESPONSE FOR CERTIFICATE OF CORRECTION

PAPER NO.:

DATE

: 8/26/10

TO SPE OF

: ART UNIT: 3771 Attn: YU JUSTINE R (SPE)

SUBJECT

: Request for Certificate of Correction for Appl. No.: 11/365243 Patent No.: 7334577

Please respond to this request for a certificate of correction within 7 days.

#### **FOR IFW FILES:**

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

#### **FOR PAPER FILES:**

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square Building (RSQ)
2800 South Randolph Street, Suite 9XXXX
Arlington, VA 22206
PALM Location 7580

Please check the Drawings

Tasneem Siddiqui

Certificates of Correction Branch 703-756-1593

#### Thank You for Your Assistance

The request for issuing the above-identified correction(s) is hereby:  Note your decision on the appropriate box.				
X Approved	All changes apply.			
☐ Approved in Part	Specify below which changes do not apply			
☐ Denied	State the reasons for denial below.			
Comments: Approved.	· · · · · · · · · · · · · · · · · · ·			
	·			

/Justine Yu/

3771

DEPARTMENT OF THE AIR FORCE AFMC LO/JAZ BLdg 11, Room D18 WRIGHT-PATTERSON AFB OH 45433-7109

In re Application of

OCT -6 2011

NUNEZ, ABEL S. et al.

**DECISION ON PETITION** 

Application No. 11/365,247

Filed: March 1, 2006

Attorney Docket No.: AFD 784

This is a decision on the Petition To Withdraw Holding Of Abandonment received in the United States Patent and Trademark Office (USPTO) on September 20, 2011.

The petition is **GRANTED**.

The application was held abandoned for failure to timely pay the issue fee as required by the Notice of Allowance and Fee(s) Due mailed July 17, 2008, which set forth a three (3) month statutory period for reply. Accordingly, the Notice of Abandonment was mailed on November 10, 2008.

The petitioner has demonstrated that the Fee Transmittal was timely with Certificate of Mailing date of September 11, 2008.

In view of the foregoing, the holding of abandonment for failure to timely pay the issue fee is hereby withdrawn and the application restored to pending status.

Telephone inquires concerning this decision be directed to the undersigned in the Office of Patent Publication at 703-756-1547.

Kay D. Pinkney

Application Assistance Unit Office of Data Management



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

TUNG & ASSOCIATES / RANDY W. TUNG, ESQ. 838 W. LONG LAKE RD. SUITE 120 BLOOMFIELD HILLS MI 48302

MAILED
APR 1 9 2011
OFFICE OF PETITIONS

In re Application of

Tsai et al.

Application No. 11/365,288

Filed: March 1, 2006

Attorney Docket No. 92,000-118

**ON PETITION** 

This is a decision on the petition, filed December 9, 2010, which is being treated as a petition under 37 CFR 1.181, requesting withdrawal of the holding of abandonment in the above-identified application.

#### The petition is **GRANTED**.

This application was held abandoned for failure to timely respond to the Notice of Allowance of August 19, 2010, which set a three (3) month statutory period for reply. Accordingly, a reply was due on or before November 19, 2010.

Petitioner states that a timely reply, which included the Issue Fee Transmittal with authorization to charge the issue and publication fees, was sent via facsimile September 1, 2010. Petitioner has submitted a copy of the previously faxed correspondence, which bears a certificate of facsimile transmission dated September 1, 2010, which would have rendered the reply timely if received.

The file record does not include the originally submitted papers. Failure to receive correspondence which includes a certificate of mailing or certificate of facsimile transmission is addressed in 37 CFR 1.8(b), reproduced below:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

The petition satisfies the above requirements of 37 CFR 1.8(b). Accordingly, the holding of abandonment for failure to timely file a reply to the Notice of Allowance of August 19, 2010 is hereby withdrawn and the application restored to pending status.

The copy of the reply received with the petition will be accepted in place of the reply shown to have been transmitted by facsimile on September 1, 2010.

This matter is being referred to the Office of Data Management for processing into a patent.

Liana Walsh

Petitions Examiner Office of Petitions



KIRTON & MCCONKIE 1800 EAGLE GATE TOWER **60 EAST SOUTH TEMPLE** SALT LAKE CITY UT 84111

### MAILED

MAR 252011

**OFFICE OF PETITIONS** 

In re Application of

Brazell et al.

Application Number: 11/365,405 Filing or 371(c) Date: 03/01/2006

Attorney Docket Number: 11897.72

**DECISION ON PETITION** 

UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition, filed on February 3, 2011, which is treated as a petition under 37 CFR 1.78(a)(3), to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed non-provisional applications listed in the accompanying amendment.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- the reference required by 35 U.S.C. § 120 and 37 CFR **(1)** 1.78(a)(2)(i) of the prior-filed application, unless previously submitted:
- the surcharge set forth in § 1.17(t); and **(2)**
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with item (1)

A review of Office computer database records indicates that there is a lack of common inventorship between the instant nonprovisional application and nonprovisional application Nos. 10/145,920 and 11/292,755, noted in the amendment submitted concurrently with the instant petition. The statute requires that the applications claiming benefit of the earlier filing date under 35 U.S.C. §119(e) or 120 be filed by an inventor or inventors named in the prior-filed nonprovisional or provisional application.

For the above-noted reasons, the petition under 37 CFR 1.78(a)(3) cannot be granted.

If reconsideration of this decision is desired, and in order to expedite consideration thereof, petitioner may wish to submit the renewed petition by facsimile transmission to the number indicated below and to the attention of the undersigned.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop PETITIONS

Commissioner for Patents Post Office Box 1450

Alexandria, VA 22313-1450

By hand:

Customer Service Window

Mail Stop Petitions Randolph Building 401 Dulany Street Alexandria, VA 22314

By fax:

(571) 273-8300

ATTN: Office of Petitions

A reply may also be filed via EFS-Web.

Any questions concerning this matter may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

Christopher Bottorff

Child Booth

Supervisor

Office of Petitions



KIRTON & MCCONKIE 1800 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY UT 84111

# MAILED

NOV 08 2011

#### OFFICE OF PETITIONS

In re Application of

Brazell et al.

Application Number: 11/365,405

11/365,405

Filing or 371(c) Date: 03/01/2006 Attorney Docket Number: 11897.72 DECISION ON PETITION

UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition, filed on October 18, 2011, which is treated as a renewed petition under 37 CFR 1.78(a)(3), to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed non-provisional applications listed in the accompanying amendment.

#### The petition is again **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in  $\S 1.17(t)$ ; and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with item (1)

A review of Office computer database records indicates that there is a lack of common inventorship between the instant nonprovisional application and nonprovisional application Nos. 10/145,920 and 11/292,755, noted in the amendment submitted concurrently with the instant petition. The statute requires that the applications claiming benefit of the earlier filing date under 35 U.S.C. §119(e) or 120 be filed by an inventor or inventors named in the prior-filed nonprovisional or provisional application.

For the above-noted reasons, the petition under 37 CFR 1.78(a)(3) cannot be granted.

If reconsideration of this decision is desired, and in order to expedite consideration thereof, petitioner may wish to submit the renewed petition by EFS-Web, accompanied by a telephone call to Senior Petitions Attorney Douglas I. Wood, at 571-272-3231, giving notice of the filing of the renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop PETITIONS

Commissioner for Patents Post Office Box 1450

Alexandria, VA 22313-1450

By hand:

Customer Service Window

Mail Stop Petitions Randolph Building 401 Dulany Street Alexandria, VA 22314

By fax:

(571) 273-8300

**ATTN: Office of Petitions** 

A reply may also be filed via EFS-Web.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3231.

Douglas I. Wood

Senior Petitions Attorney

Office of Petitions



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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

CHOATE, HALL & STEWART LLP TWO INTERNATIONAL PLACE BOSTON MA 02110 MAILED
DEC 0 2 2010
OFFICE OF PETITIONS

In re Application of

Lentini et al.

Application No. 11/365,482

Filed: March 1, 2006

Attorney Docket No. 2006579-0383 (CTX-

130CPCN)

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 10, 2010.

The request is **NOT APPROVED**.

The Office strongly encourages practitioner(s) requesting withdrawal from representation as practitioner of record in an application to review the record to determine whether he or she is, in fact, of record and how he or she was made of record. For example, the practitioner(s) should determine whether he or she was appointed by naming each practitioner individually or through the use of a Customer Number. If the practitioner(s) was appointed by a specific designation, then the Request should ask that each specified practitioner be withdrawn and should list each practitioner(s) in the Request.

In the instant application, the practitioners were appointed via Customer Number. Therefore, a request to withdraw cannot be approved without providing the appropriate Customer Number.

Further, the Office will <u>only</u> accept correspondence address changes to the most current address information provided for the assignee of the entire interest who properly became of record under 37 CFR 3.71, or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor.

The Office will not change the correspondence address to that of a new practitioner unless the Request is accompanied by a power of attorney to a new practitioner (e.g., Form PTO/SB/82). This includes address changes to law, firms, where no new power of attorney has been filed in the application. If the applicants wish future correspondence to be mailed to a new law firm, a new power of attorney should be submitted in the application and should include the desired change of correspondence address.

All future communications from the Office will be directed to above-listed address until otherwise properly notified by the applicant or a proper change of correspondence address have been submitted.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-3206. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Liana Walsh Petitions Exami

Petitions Examiner Office of Petitions

Janawalk

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#### UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET

ALEXANDRIA, VA 22314

MAILED

NOV 0 5 2010

OFFICE OF PETITIONS

In re Application of Tadashi Noguchi

Application No.: 11/365,519

Filed: March 2, 2006

Attorney Docket No.: 287119US2SX

ON PETITION

This is a decision on the petition, filed November 4, 2010, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on September 30, 2010, cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. \(^1\)

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 2882 for further processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement (IDS).

/SDB/

Sherry D. Brinkley Petitions Examiner Office of Petitions

<sup>&</sup>lt;sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s)
Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

FLEIT GIBBONS GUTMAN BONGINI & BIANCO PL 21355 EAST DIXIE HIGHWAY SUITE 115 MIAMI FL 33180

MAILED

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OFFICE OF PETITIONS

In re Application of

Avishal Wool

Application No. 11/365,616

Filed: March 2, 2006

Attorney Docket No. 7093-X09-007

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 21, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of the issue and publication fees; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice of Allowance mailed February 16, 2010, is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This application is being referred to the Office of Data Management to be processed into a patent.

/KOC/ Karen Creasy Petitions Examiner Office of Petitions



ETHAN D. CIVAN 170 SOMERSET DRIVE BLUE BELL PA 19422

MAILED

SEP 1 4 2010

In re Application of

Joseph Abadi

Application No. 11/365,720

Filed: March 1, 2006

Attorney Docket No. 2003-0210-US

OFFICE OF PETITIONS

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 28, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others.

The request was signed by Ethan D. Civan, the sole attorney of record. All attorneys/agents associated with this application have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

There is an outstanding Office action mailed August 14, 2010 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to undersigned at 571-272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

/AMW/ April M. Wise Petitions Examiner Office of Petitions

cc:

JOSEPH ABADI 2069 WEST STREET BROOKLYN, NY 11223



55863

# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NUMBER

ETHAN D. CIVAN 170 SOMERSET DRIVE BLUE BELL, PA 19422

FILING OR 371(C) DATE

FIRST NAMED APPLICANT

ATTY. DOCKET NO./TITLE

11/365,720

03/01/2006

Joseph Abadi

2006-0210-US **CONFIRMATION NO. 9962** 

**POWER OF ATTORNEY NOTICE** 

Date Mailed: 09/08/2010

# NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 06/28/2010.

• The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

/amwise/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

SAUL EWING LLP (PHILADELPHIA) ATTN: PATENT DOCKET CLERK CENTRE SQUARE WEST 1500 MARKET STREET, 38<sup>TH</sup> FLOOR PHILADELPHIA PA 19102-2186 MAILED
JUL 28 2011
OFFICE OF PETITIONS

In re Application of

**ABADI** 

Application No. 11/365,720

ON PETITION

Filed: March 1, 2006

Attorney Docket No. 361797.00001

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 7, 2011, to revive the above-identified application.

#### The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of October 13, 2010. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is January 14, 2011. A Notice of Abandonment was mailed May 10, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of \$405, and the submission required by 37 CFR 1.114; (2) the petition fee of \$810; and (3) a proper statement of unintentional delay.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6735.

This application is being referred to Technology Center AU 3625 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

/Diane C. Goodwyn/ Diane C. Goodwyn Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

CHARLES B. PERRY 5502 KENILWORTH AVE. #303 RIVERDALE, MD 20737

MAILED

OCT 2 6 2010

OFFICE OF PETITIONS

In re Application of

**Charles Burnett Perry** 

Application No. 11/365,788

Filed: March 2, 2006

Attorney Docket No. None

**ON PETITION** 

This is a decision on the petition, filed August 26, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the aboveidentified application.

#### The petition is **DISMISSED**.

Any request for reconsideration of this decision should be filed within two (2) months from the mail date of this decision. Note 37 CFR 1.181(f). The request for reconsideration should include a cover letter and be entitled as a "Renewed Petition under 37 CFR 1.181 to Withdraw the Holding of Abandonment."

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, December 7, 2007, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on March 8, 2008. A Notice of Abandonment was mailed on June 12, 2008. On August 26, 2010, the present petition was filed.

Petitioner asserts that the Office Action of December 7, 2007 was not received; however, petitioner indicates that he moved on "09/2007...and put in for a change of address with the post office..."

37 CFR 1.33(a) provides that the application must specify a correspondence address to which the Office will send notice, letters, and other communications relating to the application. Where an attorney or agent of record (or applicant, if he or she is prosecuting the application pro se) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office of the new correspondence address (including ZIP Code). See 37 CFR 11.11.

The present petition does not include a statement that a change of correspondence address was filed with the U.S. Patent and Trademark Office prior to the mailing of the Office action on December 7, 2007. Further, a review of the written record fails to show that a change of correspondence address was filed. Consequently, the Office action on December 7, 2007 was properly mailed to the applicant at the address of record. A copy of the non-final Office action accompanies this decision, per applicant's request.

Since the petition does not include sufficient evidence to support a conclusion that the abandonment should be withdrawn, the petition is dismissed.

The correspondence address is being updated in view of the present notification that the correspondence address has changed.

Petitioner is strongly encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137(a).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed. In nonprovisional utility application abandoned for failure to respond to a non-final Office action, the required reply may be met by filing either (A) an argument or amendment under 37 CFR 1.111 or (B) a continuing application under 37 CFR 1.53(b).
- (2) The petition fee as set forth in 37 CFR 1.17(m), \$810.00 for a small entity;
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

A form for filing a petition to revive an unintentionally abandoned application accompanies this decision for petitioner's convenience. If petitioner desires to file a petition under 37 CFR 1.137(b) instead of filing a request for reconsideration, petitioner must complete the enclosed petition form (PTO/SB/64) and pay the \$810.00 petition fee.

Petitioner may wish to consider hiring a registered patent attorney or agent to assist in the prosecution of this application. Additionally, petitioner is encouraged to contact the Inventors Assistance Center (IAC) by telephone at 800-786-9199 or 571-272-1000, Monday through Friday from 8:30 AM to 5:30 PM (EST). The IAC provides patent information and services to the public and is staffed by former Supervisory Patent Examiners and experienced Primary Examiners who answer general questions concerning patent examining policy and procedure.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

By mail:

Mail Stop PETITIONS

Commissioner for Patents Post Office Box 1450

Alexandria, VA 22313-1450

By hand:

**Customer Service Window** 

Mail Stop Petitions Randolph Building 401 Dulany Street Alexandria, VA 22314

By fax:

(571) 273-8300

ATTN: Office of Petitions

By internet:

EFS-Web<sup>1</sup>

Any questions concerning this matter may be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley Petitions Examiner Office of Petitions

Enclosures: Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b); Form PTO/SB/64, Privacy Act Statement

<sup>&</sup>lt;sup>1</sup> www.uspto.gov/ebc/efs\_help.html (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197)



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/365,788	03/02/2006	Charles Burnett Perry		2042
CHARLES B. 1	7590 12/07/2007 PFRRY		EXAM	INER
P.O. BOX 939		FELTEN, DANIEL S		
RIVERDALE,	MD 20738		ART UNIT	PAPER NUMBER
			3694	
			MAIL DATE	DELIVERY MODE
			12/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

···			
	Application No.	Applicant(s)	
	11/365,788	PERRY, CHARLES BUR	NETT
Office Action Summary	Examiner	Art Unit	·· <del>····</del> ···
	Daniel S. Felten	3694	
- The MAILING DATE of this communication Period for Reply	appears on the cover sheet w	th the correspondence address -	-
A SHORTENED STATUTORY PERIOD FOR REWHICHEVER IS LONGER, FROM THE MAILING.  Extensions of time may be available under the provisions of 37 CF after SIX (6) MONTHS from the mailing date of this communication if NO period for reply is specified above, the maximum statutory properties of the period for reply within the set or extended period for reply will, by some Any reply received by the Office later than three months after the rearned patent term adjustment. See 37 CFR 1.704(b).	G DATE OF THIS COMMUNION OF THIS COMMUNION OF THIS COMMUNION OF THE STATE OF THE ST	CATION. reply be timely filed ITHS from the mailing date of this communica BANDONED (35 U.S.C. § 133).	•
Status			
1)⊠ Responsive to communication(s) filed on <u>(</u>	02 March 2006.		
	This action is non-final.		
3) Since this application is in condition for all	owance except for formal mate	ers, prosecution as to the merits	s is
closed in accordance with the practice und	ler <i>Ex parte Quayle</i> , 1935 C.C	). 11, 453 O.G. 213.	
Disposition of Claims			
4) Claim(s) is/are pending in the applic	cation.		
4a) Of the above claim(s) is/are with	drawn from consideration.		
5) Claim(s) is/are allowed.			
6) Claim(s) is/are rejected.			
7) Claim(s) is/are objected to.			
8) Claim(s) are subject to restriction a	na/or election requirement.		
Application Papers			,
9) The specification is objected to by the Exam			
10) The drawing(s) filed on is/are: a)	accepted or b) objected to	by the Examiner.	
Applicant may not request that any objection to	• • • • • • • • • • • • • • • • • • • •	• •	
Replacement drawing sheet(s) including the co		• •	
	e Examiner. Note the attacher	JOINCE ACTION OF JOHN PTO-132	<b>-</b> .
Priority under 35 U.S.C. § 119			
<ul> <li>12) Acknowledgment is made of a claim for for a) All b) Some * c) None of:</li> <li>1 Certified copies of the priority documents</li> <li>2 Certified copies of the priority documents</li> </ul>	nents have been received.		
3. Copies of the certified copies of the			
application from the International Bu	reau (PCT Rule 17.2(a)).		
* See the attached detailed Office action for a	list of the certified copies not	received.	
Attachment(s)		•	
<ol> <li>Notice of References Cited (PTO-892)</li> <li>Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> </ol>		Summary (PTO-413) s)/Mail Date	
Information Disclosure Statement(s) (PTO/SB/08)     Paper No(s)/Mail Date		nformat Patent Application	

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#### **DETAILED ACTION**

1. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site http://www.uspto.gov in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450.

### Specification

2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

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Art Unit: 3694

Page 3

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (1) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

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#### Content of Specification

- (a) <u>Title of the Invention</u>: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) <u>Statement Regarding Federally Sponsored Research and Development</u>: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).
- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.
- (f) <u>Background of the Invention</u>: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) <u>Field of the Invention</u>: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
  - (2) Description of the Related Art including information disclosed under 37

    CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (g) <u>Brief Summary of the Invention</u>: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and

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preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

- (h) <u>Brief Description of the Several Views of the Drawing(s)</u>: See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (l) <u>Sequence Listing.</u> See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

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2. 3.

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A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because The specification is not compliant to the requirements and standards of the United States Patent Office. It is suggested that the applicant acquire any published patent over the past 25 years to understand the format used to submitted an application to the U.S. Patent Office.

3. A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

#### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742.

The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel S Feltel Examiner Art Unit 3694

DSF 12/03/2007

SPE RESPONSE FO	OR CERTIFICATE OF CORRECTION
DATE :	Paper No.:
TO SPE OF : ART UNIT 2624	, .
SUBJECT : Request for Certificate of Correct	ion for Appl. No.: <u>///3/65 8/63</u> Patent No.: <u>7809/69/8</u>
Please respond to this request for a cert	ificate of correction within 7 days.
FOR IFW FILES:	
Please review the requested changes/co the IFW application image. No new mat meaning of the claims be changed.	orrections as shown in the COCIN document(s) in the should be introduced, nor should the scope or
Please complete the response (see belousing document code COCX.	ow) and forward the completed response to scanning
FOR PAPER FILES:	
Please review the requested changes/cc correction. Please complete this form (s	orrections as shown in the attached certificate of see below) and forward it with the file to:
Certificates of Correction Brand Randolph Square – 9D10-A Palm Location 7580	
·	<u> Virginia Tolbert</u>
$\sim$ $\lambda$	Certificates of Correction Branch
VILE	571-272-0460
SPE, 2624	Thank You For Your Assistance
The request for issuing the above-ide Note your decision on the appropriate box.	ntified correction(s) is hereby:
<b>☑</b> Approved	All changes apply.
☐ Approved in Part	Specify below which changes do not apply.
☐ Denied	State the reasons for denial below.
Comments:	·
· · · · · · · · · · · · · · · · · · ·	

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/03/2010

YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314

**Applicant**: Pekka Janhunen

Patent Number : 7641151

Issue Date : 01/05/2010

Application No. 11/265 875

**Application No:** 11/365,875 **Filed** : 03/02/2006

: DECISION ON REQUEST FOR : RECALCULATION of PATENT

: TERM ADJUSTMENT IN VIEW

: OF WYETH AND NOTICE OF INTENT TO

: ISSUE CERTIFICATE OF CORRECTION

:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 648 days. The USPTO will suasponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/06/2010

FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007

Applicant: Kazuhiro Saito: DECISION ON REQUEST FORPatent Number: 7661740: RECALCULATION of PATENTIssue Date: 02/16/2010: TERM ADJUSTMENT IN VIEW

Application No: 11/365,931 : OF WYETH AND NOTICE OF INTENT TO Filed : 03/02/2006 : ISSUE CERTIFICATE OF CORRECTION

155UE CERTIFICATE OF CORREC

:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 924 days. The USPTO will suasponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



COMMISSIONER FOR PATENTS UNITED STATES PATENT AND TRADEMARK OFFICE P.O. BOX 1450 ALEXANDRIA, VA 22313-1450 www.uspto.gov

**DATE:** November 3, 2011

**TO:** Certificates of Correction Branch

**FROM:** John Q. Nguyen

SPE, Art Unit 3665

**SUBJECT:** REQUEST FOR CERTIFICATE OF CORRECTION

Please issue a Certificate of Correction in U. S. Letters Patent No. 7,612,869 as specified on the attached Certificate.

/John Q. Nguyen/

John Q. Nguyen, SPE Art Unit 3665

### **CERTIFICATE**

Patent No. 7,612,869 Patented: 11/3/2009

On petition requesting issuance of a certificate for correction of inventorship pursuant to 35 U.S.C. 256, it has been found that the above identified patent, through error and without deceptive intent, improperly sets forth the inventorship. Accordingly, it is hereby certified that the correct inventorship of this patent is:

Francisco Pereira, Darius Modarress, Mory Gharib, Dana Dabiri, David Jeon and Emilio Castano Graft.

/John Q. Nguyen/ Supervisory Patent Examiner Art Unit 3665



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

GAURAV TEWARI 3978 PAN AM EXPRESSWAY NORTH SAN ANTONIO TX 78219 MAILED

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OFFICE OF PETITIONS

In re Application of

Tewari

Application No. 11/366,148

**DECISION ON PETITION** 

Filed: March 2, 2006

Attorney Docket No. TEW-11

This is a decision on the petition filed under 37 CFR 1.137(b) in the above-identified application filed on February 10, 2011.

### The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This above-identified application became abandoned for failure to timely file a reply to a non-final Office action mailed June 29, 2009. The Office Action set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on September 30, 2009. This decision precedes the mailing of a Notice of Abandonment.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item(s) 1.

As to item (1), applicant has failed to provide a complete response to the non-final Office action. The Office is in receipt of the amendment. However, a review of the drawings shows they do not meet the requirements of 37 CFR 1.121. When the Office receives replacement sheets of drawings for patent applications after the application has been filed, a cover letter identifying the drawings by application number should accompany them. The application number and other identifying indicia should be placed on each sheet of drawings in accordance with 37 CFR

Application No. 11/366,148

Page 2

1.84(c). Each drawing sheet submitted after the filing date of the application must be identified as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

It is noted that two request to enter a power of attorney and change the correspondence address were submitted on November 30, 2010. The one request included customer number 21619 and the other included customer number 75076. Since it is not clear which customer number should be entered, neither request will be entered. On renewed petition, a clear indication as to which customer number applicant desires for the power of attorney and correspondence address of record.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop PETITIONS

Commissioner for Patents Post Office Box 1450

Alexandria, VA 22313-1450

By hand:

**Customer Service Window** 

Mail Stop Petitions Randolph Building 401 Dulany Street

Alexandria, VA 22314

By fax:

(571) 273-8300

ATTN: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (571) 272-3215.

Charlema Grant

**Petitions Attorney** 

Office of Petitions

Cc:

Robert Groover III P.O. Box 802889 ·

Dallas, Texas 75380-2889



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

# NOVARTIS INSTITUTES FOR BIOMEDICAL RESEARCH, INC. 220 MASSACHUSETTS AVENUE CAMBRIDGE MA 02139

MAILED

DEC 22 2010

OFFICE OF PETITIONS

In re Application of

Davis et al.

Application No. 11/366,462

Filed: March 3, 2006

Attorney Docket No. 34748-US-DIV02

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 1, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the final Office action mailed, March 24, 2010, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on June 25, 2010. A Notice of Abandonment was mailed October 29, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a continuation, (2) the petition fee of \$1,620.00, and (3) a proper statement of unintentional delay.

The above-identified application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the above-identified application, the above-identified application is again abandoned in favor of continuing application No. 12/917,019, filed November 1, 2010.

Further, it is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was

unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

Joan Olszewski

**Petitions Examiner** 

Joan Olynh.

Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036

MAILED

APR 1.8 2011

OFFICE OF PETITIONS

In re Application of

Yoichi Iwasaki, et al.

Application No.: 11/366,509

Filed: March 3, 2006

Attorney Docket No.: 062183

ON PETITION

This is a decision on the petition, filed April 14, 2011, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on March 9, 2011, cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 3741 for further processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement (IDS).

/SDB/

Sherry D. Brinkley Petitions Examiner Office of Petitions

<sup>&</sup>lt;sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). <u>Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.</u>



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850

MAILED

NOV 0 4 2010
OFFICE OF PETITIONS

In re Application of **Hiroyuki NAGASAKA** 

Application No. 11/366,746

Filed: March 3, 2006

Attorney Docket No. 125158.01

DECISION GRANTING PETITION

UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed November 3, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on September 29, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>

Telephone inquiries should be directed to the undersigned at (571) 272-7253.

This application is being referred to Technology Center AU 2882 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). <u>Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.</u>



### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/366,792	03/02/2006	Robert P. Morris	1386/US	6141
49278 SCENERA RE	7590 12/15/2010 SEARCH, LLC		EXAM	INER
5400 Trinity R			WEINRICH	, BRIAN E
Suite 303 Raleigh, NC 27	7607		ART UNIT	PAPER NUMBER
Raicign, IVC 2			2169	
	·		MAIL DATE	DELIVERY MODE
	•		12/15/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



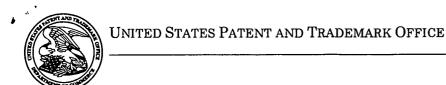
### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
11/366,792	03/02/2006	Robert P. Morris	I386/US	6141
49278 7	590 12/15/2010		EXAM	INER
SCENERA R	ESEARCH, LLC		WEINRICH	, BRIAN E
5400 Trinity Re Suite 303	oad		ART UNIT	PAPER NUMBER
Raleigh, NC	27607		2169	
			DATE MAILED: 12/15/2010	0

Please find below and/or attached an Office communication concerning this application or proceeding.

The request for deferral/suspension of action under 37 CFR 1.103 has been approved.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Kevin L. Wingate SCENERA RESEARCH, LLC 5400 Trinity Road Suite 303 Raleigh, North Carolina 27607

In re Application of: Robert P. MORRIS

Appl. No.: 11/366,792
Filed: March 2, 2006
For: METHODS AND SYSTEMS FOR DELIVERING
PUBLISHED INFORMATION ASSOCIATED WITH A
TUPLE USING A PUB/SUB PROTOCOL

**DECISION ON PETITION** UNDER 37 CFR § 1.103(a)

This is a decision on the petition for suspension of prosecutions under 37 CFR § 1.103(a) filed on 10 December 2010.

### The petition is **GRANTED**.

Pursuant to applicant's requests filed on 10 December 2010, action by the Office is suspended on this application under 37 CFR § 1.103(a) for a period of three (3) months from the mailing date of this letter. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3613.

/Vincent N. Trans/ Vincent N. Trans, SPRE/QAS Technology Center 2100 Computer Architecture and Software



### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/366,792	03/02/2006	Robert P. Morris	. I386/US	6141
49278 SCENERA RE	7590 03/28/2011 ESEARCH, LLC	4	EXAM	INER
5400 Trinity R		•	WEINRICH	, BRIAN E
Suite 303 Raleigh, NC 2	7607		ART UNIT	PAPER NUMBER
Raieigii, NC 2	7007		2169	
			MAIL DATE	DELIVERY MODE
			03/28/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Kevin L. Wingate SCENERA RESEARCH, LLC 5400 Trinity Road Suite 303 Raleigh, North Carolina 27607

In re Application of: Robert P. MORRIS Appl. No.: 11/366,792

Filed: March 2, 2006
For: METHOD AND SYSTEM FOR DELIVERING
PUBLISHED INFORMATION ASSOCIATED WITH A

TUPLE USING A PUB/SUB PROTOCOL

DECISION ON PETITION UNDER 37 CFR § 1.103(a)

This is a decision on the petition for suspension of prosecutions under 37 CFR § 1.103(a) filed on 22 March 2011.

### The petition is **GRANTED**.

Pursuant to applicant's requests filed on 22 March 2011, action by the Office is suspended on this application under 37 CFR § 1.103(a) for a period of three (3) months from the mailing date of this letter. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3613.

/Vincent N. Trans/ Vincent N. Trans, SPRE/QAS Technology Center 2100 Computer Architecture and Software



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/366,792	03/02/2006	Robert P. Morris	1386/US	6141
49278 SCENERA RE	7590 07/06/2011 SEARCH, LLC		EXAM	INER
5400 Trinity R	•		WEINRICH	, BRIAN E
Suite 303 Raleigh, NC 27	7607		ART UNIT	PAPER NUMBER
,			2169	··
			MAIL DATE	DELIVERY MODE
			07/06/2011	PAPER

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The time period for reply, if any, is set in the attached communication.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Kevin L. Wingate SCENERA RESEARCH, LLC 5400 Trinity Road Suite 303 Raleigh, North Carolina 27607

In re Application of:
Robert P. MORRIS
Appl. No.: 11/366,792
Filed: March 2, 2006
For: METHOD AND SYSTEM FOR DELIVERING
PUBLISHED INFORMATION ASSOCIATED WITH A
TUPLE USING A PUB/SUB PROTOCOL

**DECISION ON PETITION** UNDER 37 CFR § 1.103(a)

This is a decision on the petition for suspension of prosecutions under 37 CFR § 1.103(a) filed on 28 June 2011.

### The petition is **GRANTED**.

Pursuant to applicant's requests filed on 28 June 2011, action by the Office is suspended on this application under 37 CFR § 1.103(a) for a period of three (3) months from the mailing date of this letter. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3613.

/Vincent N. Trans/ Vincent N. Trans, SPRE/QAS Technology Center 2100 Computer Architecture and Software



### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.usplo.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/366,792	03/02/2006	Robert P. Morris	1386/US	6141
49278 SCENERA RE	7590 10/14/2011 ESEARCH, LLC		EXAM	INER
5400 Trinity R			WEINRICH	, BRIAN E
Suite 303 Raleigh, NC 27	760 <b>7</b>		ART UNIT	PAPER NUMBER
Kaleigii, Ne 2	7007		2169	
			MAIL DATE	DELIVERY MODE
			10/14/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Kevin L. Wingate SCENERA RESEARCH, LLC 5400 Trinity Road Suite 303 Raleigh, North Carolina 27607

In re Application of: Robert P. MORRIS Appl. No.: 11/366,792

Filed: March 2, 2006
For: METHOD AND SYSTEM FOR DELIVERING
PUBLISHED INFORMATION ASSOCIATED WITH A
TUPLE USING A PUB/SUB PROTOCOL

DECISION ON PETITION UNDER 37 CFR § 1.103(a)

This is a decision on the petition for suspension of prosecutions under 37 CFR § 1.103(a) filed on 10 October 2011.

### The petition is **GRANTED**.

Pursuant to applicant's requests filed on 10 October 2011, action by the Office is suspended on this application under 37 CFR § 1.103(a) for a period of three (3) months from the mailing date of this letter. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3613.

/Vincent N. Trans/ Vincent N. Trans, SPRE/QAS Technology Center 2100 Computer Architecture and Software



### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.usplo.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/366,792	03/02/2006	Robert P. Morris	I386/US	6141
49278 SCENERA RES	7590 01/26/2012 SEARCH, LLC		EXAM	INER
5400 Trinity Ro			WEINRICH	, BRIAN E
Suite 303 Raleigh, NC 27	607		ART UNIT	PAPER NUMBER
			2169	
			MAIL DATE	DELIVERY MODE
			01/26/2012	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Kevin L. Wingate SCENERA RESEARCH, LLC 5400 Trinity Road Suite 303 Raleigh, North Carolina 27607

In re Application of:
Robert P. MORRIS
Appl. No.: 11/366,792
Filed: March 2, 2006
For: METHOD AND SYSTEM FOR DELIVERING
PUBLISHED INFORMATION ASSOCIATED WITH A

TUPLE USING A PUB/SUB PROTOCOL

**DECISION ON PETITION** UNDER 37 CFR § 1.103(a)

This is a decision on the petition for suspension of prosecutions under 37 CFR § 1.103(a) filed on 23 January 2012.

### The petition is **GRANTED**.

Pursuant to applicant's requests filed on 23 January 2012, action by the Office is suspended on this application under 37 CFR § 1.103(a) for a period of three (3) months from the mailing date of this letter. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Suspension of action under 37 CFR § 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR § 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR § 1.704(c)(1).

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3613.

/Vincent N. Trans/ Vincent N. Trans, QAS Technology Center 2100 Computer Architecture and Software



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

HOVEY WILLIAMS LLP 10801 MASTIN BLVD., SUITE 1000 **OVERLAND PARK KS 66210** 

MAILED

AUG 08 2011

OFFICE OF PETITIONS

In re Application of

Studholme, et al.

Application No. 11/366,799

Filed/Deposited: 3 March, 2006

Attorney Docket No. 66055-053

**DECISION** 

This is a decision on the papers filed on 28 June, 2011, for revival of an application abandoned due to unintentional delay pursuant to 37 C.F.R. §1.137(b).

### **NOTE:**

There was a power of attorney in favor of the practitioners associated with the Customer Number 23589 (Hovey Williams LLP) submitted contemporaneously with the petition on 28 June, 2011.

However, rather than having a registered practitioner sign the petition and submit an accompanying statement by the authorized agent of the assignee, the firm of Hovey Williams LLP and the practitioner Eric D. Middlemas (Reg. No. 53,325)—who signed the amendment—had a non-practitioner, non-authorized signor (Jeffrey Johnson) of the petition, which constituted an improper signing.

The petition pursuant to 37 C.F.R. §1.137(b) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(b)."

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

Application No. 11/366,799

## As to the Allegations of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee

### Petitioner does not appear to have satisfied the requirements under the Rule.

Petitioners' attentions always are directed to the guidance in the Commentary at MPEP §711.03(c)(II).

### **BACKGROUND**

The record reflects as follows:

Petitioner failed to reply timely and properly to the non-final Office action mailed on 22 December, 2008, with reply due absent an extension of time on or before 22 March 2009.

The application went abandoned by operation of law after midnight 22 March 2009.

The Office mailed the Notice of Abandonment on 30 July, 2009.

On 28 June, 2011, more than:

- twenty-seven (27) months after abandonment, and
- twenty-two (22) months after Notice thereof,

Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.137(b), with fee, and a statement of unintentional delay, and a reply in the form of an amendment—however, as noted above, the person signing the petition was neither the inventor/ nor a registered practitioner and was not authorized to sign—thus, the signing therefore appeared to be defective, and the petition considered unsigned.

Petitioners' attentions always are directed to the guidance in the Commentary at MPEP  $\S711.03(c)$  as to the showing regarding unintentional delay and a petition pursuant to 37 C.F.R.  $\S1.137(b)$ .

Petitioner has failed to satisfy the requirements under the Rule and discussed above.

Application No. 11/366,799

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice <u>and</u> all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.<sup>1</sup>

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup> The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>3</sup>))

Again, Petitioner's attentions are directed to the guidance in the Commentary at MPEP  $\S711.03(c)$ .

# As to the Allegations of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee

Petitioner failed to satisfy the requirements under the Rule.

<sup>&</sup>lt;sup>1</sup> See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

<sup>&</sup>lt;sup>2</sup> 35 U.S.C. §133 provides:

<sup>35</sup> U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

Therefore, by example, an <u>unintentional</u> delay in the reply might occur if the reply and transmittal form are <u>to be</u> prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

#### **CONCLUSION**

Accordingly, the petition under 37 C.F.R. §1.137(b) is dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

Mail Stop PETITION

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

By hand:

U. S. Patent and Trademark Office

Customer Service Window, Mail Stop Petitions

Randolph Building 401 Dulany Street Alexandria, VA 22314

By facsimile:

(571) 273-8300

Attn: Office of Petitions

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2<sup>4</sup>) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./ John J. Gillon, Jr. Senior Attorney Office of Petitions

The regulations at 37 C.F.R. §1.2 provide:

<sup>§1.2</sup> Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

**HOVEY WILLIAMS LLP** 10801 MASTIN BLVD., SUITE 1000 **OVERLAND PARK KS 66210** 

MAILED

OCT 03 2011

In re Application of

Studholme, et al.

Application No. 11/366,799

Filed/Deposited: 3 March, 2006

Attorney Docket No. 66055-053

OFFICE OF PETITIONS

**DECISION** 

This is a decision on the papers filed on 25 August, 2011, for revival of an application abandoned due to unintentional delay pursuant to 37 C.F.R. §1.137(b).

### **NOTE:**

Originally the firm of Hovey Williams LLP and the practitioner Eric D. Middlemas (Reg. No. 53,325) (Mr. Middlemas)—who signed the amendment submitted with the petition of 28 June, 2011—had a non-practitioner, non-authorized signor (Jeffrey Johnson) of the petition, which constituted an improper signing—and the petition was dismissed on 20 August, 2011.

The submission of 25 August, 2011, raises a question as to the unintentional nature of the abandonment, but fails to provide first person statements from the prior Counsel and the director of the assignee (and co-inventor) who was providing instruction to prior Counsel. Statements from these persons are required.

The petition pursuant to 37 C.F.R. §1.137(b) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(b)."

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

Application No. 11/366,799

# As to the Allegations of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee

### Petitioner does not appear to have satisfied the requirements under the Rule.

Petitioners' attentions always are directed to the guidance in the Commentary at MPEP \$711.03(c)(II).

### **BACKGROUND**

The record reflects as follows:

Petitioner failed to reply timely and properly to the non-final Office action mailed on 22 December, 2008, with reply due absent an extension of time on or before 22 March 2009.

The application went abandoned by operation of law after midnight 22 March 2009.

The Office mailed the Notice of Abandonment on 30 July, 2009.

On 28 June, 2011, more than:

- twenty-seven (27) months after abandonment, and
- twenty-two (22) months after Notice thereof,

Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.137(b), with fee, and a statement of unintentional delay, and a reply in the form of an amendment—however, as noted above, the person signing the petition was neither the inventor/ nor a registered practitioner and was not authorized to sign—thus, the signing therefore appeared to be defective, and the petition considered unsigned. The petition was dismissed on 8 August, 2011.

On 25 August, 2011, Petitioner/Mr. Middlemas re-advanced his petition, and set forth facts that raised a question as to the unintentional nature of the abandonment, but Petitioner failed to provide first person statements from the prior Counsel and the director of the assignee (and coinventor) who was providing instruction to prior Counsel. Statements from these persons are required.

Application No. 11/366,799

Petitioners' attentions always are directed to the guidance in the Commentary at MPEP §711.03(c) as to the showing regarding unintentional delay and a petition pursuant to 37 C.F.R. §1.137(b).

Petitioner has failed to satisfy the requirements under the Rule and discussed above.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.<sup>1</sup>

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup> The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>3</sup>))

Again, Petitioner's attentions are directed to the guidance in the Commentary at MPEP \$711.03(c).

<sup>&</sup>lt;sup>1</sup> See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

<sup>&</sup>lt;sup>2</sup> 35 U.S.C. §133 provides:

<sup>35</sup> U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

Therefore, by example, an <u>unintentional</u> delay in the reply might occur if the reply and transmittal form are <u>to be</u> prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Application No. 11/366,799

# As to the Allegations of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee

Petitioner failed to satisfy the requirements under the Rule.

#### **CONCLUSION**

Accordingly, the petition under 37 C.F.R. §1.137(b) is dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

Mail Stop PETITION

**Commissioner for Patents** 

P. O. Box 1450

Alexandria, VA 22313-1450

By hand:

U. S. Patent and Trademark Office

Customer Service Window, Mail Stop Petitions

Randolph Building 401 Dulany Street Alexandria, VA 22314

By facsimile:

(571) 273-8300

Attn: Office of Petitions

#### Application No. 11/366,799

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2<sup>4</sup>) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./ John J. Gillon, Jr. Senior Attorney Office of Petitions

The regulations at 37 C.F.R. §1.2 provide: §1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MAILED OCT 152010

**BLACK LOWE & GRAHAM, PLLC** 701 FIFTH AVENUE **SUITE 4800 SEATTLE WA 98104** 

OFFICE OF PETITIONS

In re Application of

Sievers et al.

Application No. 11/366,832

Filed: March 1, 2006

Attorney Docket No. MFDY-1-1002

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed September 13, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and an Amendment, (2) the petition fee of \$1620.00, and (3) a proper statement of unintentional delay.

The Revocation of Power of Attorney submitted with the instant petition is hereby not accepted, as stated in the September 21, 2010 Office communication. As the Revocation of Power of Attorney was signed by the assignee, it did not comply with 37 CFR 3.73(b). As such, it is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

A courtesy copy of the petition decision will be mailed to the address on the petition; however, all future correspondence will continued to be directed to the above-listed address until properly notified.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206.

This matter is being referred to Technology Center AU 2617 for processing of the RCE filed concurrently with the instant petition.

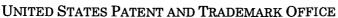
**Petitions Examiner** Office of Petitions

cc:

AMIR A. TABARROK 2 NORTH MARKET STREET, FLOOR 3

SAN JOSE, CA 95113

DATE	:11/26/10	Paper No.:
TO SPE OF	: ART UNIT	
SUBJECT		ction for Appl. No.: <u>11366867</u> Patent No.: <u>7593069</u>
		rtificate of correction within 7 days.
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FOR PAPE	R FILES:	
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		Certificates of Correction Branch
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Thank You	For Your Assistance	
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The request	Approved	All changes apply.
The request	Approved in Part Denied	All changes apply.  Specify below which changes do not apply.
The request Note your decision	Approved in Part Denied	All changes apply.  Specify below which changes do not apply.
The request Note your decision	Approved in Part Denied	All changes apply.  Specify below which changes do not apply.
The request Note your decision	Approved in Part Denied	All changes apply.  Specify below which changes do not apply.
The request Note your decision	Approved in Part Denied	All changes apply.  Specify below which changes do not apply.
The request Note your decision	Approved in Part Denied	All changes apply.  Specify below which changes do not apply.





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

FOLEY & LARDNER LLP 150 EAST GILMAN STREET P.O. BOX 1497 MADISON WI 53701-1497

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OFFICE OF PETITIONS

In re Application of

Amine, et al.

Application No. 11/366,891

Filed: March 1, 2006

Atty Docket No. 051583-0331

ON APPLICATION FOR

PATENT TERM ADJUSTMENT

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FOR PATENT APPLICATION UNDER 37 C.F.R. § 1.705(b), filed September 21, 2010. Applicants submit that the correct patent term adjustment to be indicated on the patent is one thousand three hundred seventy-two (1372) days, not eight hundred eighty-nine (889) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee1.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b). This fee is required and will not be refunded.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

For example, if an applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the \$1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley Senior Petitions Attorney

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

DOUGLAS T. JOHNSON MILLER & MARTIN 1000 VOLUNTEER BUILDING 832 GEORGIA AVENUE CHATTANOOGA TN 37402-2289

MAILED

JUL 13:2011

OFFICE OF PETITIONS

In re Application of

Orange et al.

Application No. 11/366,938

Filed: March 2, 2006

Attorney Docket No. 10577-0004

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 20, 2011, to revive the above-identified application.

#### The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the final Office action mailed, May 14, 2010, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 15, 2010. A Notice of Abandonment was mailed November 29, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal and fee of \$270.00; (2) the petition fee of \$810.00; and (3) a proper statement of unintentional delay.

The two-month period for filing an appeal brief under 37 CFR 41.37 (accompanied by the fee required by 37 CFR 41.20(b)(2)), runs from the date of this decision.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

This matter is being referred to Technology Center AU 3677 to await the filing of an appeal brief or for such other appropriate reply as may be submitted to continue prosecution of the application.

/Joan Olszewski/ Joan Olszewski Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

FINCH & CAMPBELL LLP 1220 WASHINGTON STREET SUITE 202 KANSAS CITY MO 64105

In re Application of

Alexei V. Nikitin

Application No. 11/366,949

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Filed: March 2, 2006

Attorney Docket No. 1525-0012

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 14, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, May 28, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 29, 2008. A Notice of Abandonment was mailed December 18, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Amendment, (2) the petition fee of \$810.00, and (3) a proper statement of unintentional delay.

Further, it is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

This application is being referred to Technology Center AU 2851 for further appropriate action by the Examiner in the normal course of business on the reply received.

/Joan Olszewski/ Joan Olszewski Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

www.uspto.gov

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C. P.O. BOX 398 **AUSTIN TX 78767-0398** 

MAILED APR 19 2011

OFFICE OF PETITIONS

In re Patent No. RE 41,031

Issue Date: December 1, 2009

Application No. 11/367,051 : DECISION ON PETITION

Filed: March 2, 2006

Inventor: Jacques Majos

This is a decision on the petition for expungement of information, filed September 23, 2010, which is being treated as petitions under 37 CFR 1.182 to invalidate an assignment previously recorded against the above-identified application.

The petition is **dismissed**. This is not a final agency action.

Petitioner indicates an assignment recorded on August 26, 2009 was erroneously filed for the above identified application and requests this assignment record be expunged from the file.

As discussed in section 323.01(d) of the Manual of Patent Examining Procedure (MPEP), petitions to correct, modify or "expunge" assignment records are granted only if the petitioner can prove that:

- (A) the normal corrective procedures outlined in MPEP § 323.01(a) through §323.01(c) will not provide the petitioner with adequate relief; and
- (B) the integrity of the assignment records will not be affected by granting the petition.

Petitioner seeks an extraordinary remedy, properly addressed under 37 CFR 1.182. The USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, (Comm'r Pats. 1982).

As background, the USPTO simply acts in a ministerial capacity in recording documents that have been submitted for recordation. See 35 USC 261 and 37 CFR 3.11. However, the recording of a document pursuant to 37 CFR 3.11 is not a determination by the USPTO of the validity of the document per se or the effect that document has on the title to a patent or application. See 37 CFR 3.54. Moreover, it is USPTO policy to maintain a complete history of claimed interests in a given property, and, as such, a recorded assignment document will be

retained, even if it is subsequently found to be invalid. <u>In re Raney</u>, 24 USPQ2d 1713 (Comm'r Pat. 1992).

As set forth in MPEP 323, an error in a recorded assignment is not corrected by invalidating the previous document, but by simply submitting a "corrective document". The "corrective document" must include 1) a copy of the original assignment document with the corrections made therein. The corrections must be initialed and dated by the party conveying the interest; and 2) a new Recordation Form Cover Sheet (form PTO-1595). The new recordation form cover sheet must identify the submission as a "corrective document" submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The person signing the new recordation form cover sheet must state that the information provided on the new cover sheet is true and correct and that any copy submitted is a true copy of the original document. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is required for each patent application and patent against which the corrective document is being recorded. See MPEP § 302.06. Petitioner should note that the "assignment documents" and "corrective documents" are not limited to assignments, but include any documents affecting title to a patent or application. See MPEP § 313.

Therefore, the rules of practice and the procedures before the USPTO provide an avenue for the requested relief without relying upon extraordinary measures. That is, the chain of title can be clarified in the assignment records through the recording of a corrective document. As a request for the Office to invalidate an assignment is both extraordinary and contrary to USPTO policy, this petition must be dismissed.

In regard to B, petitioner has not sufficiently explained how the removal of a document in its entirety will not affect the assignment records. The removal of a document in its entirety will affect the assignment records. Deleting the links in the USPTO database from an assignment document to an application or related patent would prevent the records from being searchable in the Assignment Historical Database or otherwise available to the public, which may be necessary for a competent authority to determine the proper chain of title. Such an action cannot be performed absent an extraordinary circumstance and the lack of an available remedy. The integrity of the records is recognized as separate from the chain of title, and the USPTO endeavors to maintain a complete history of claimed interests in a given property to permit, among other things, the review of matters like chain of title by a competent authority.

Telephone inquiries concerning this communication should be directed to Carl Friedman at (571)272-6842.

Christopher Bottorff

Supervisor

Office of Petitions

Ut Bolf



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

## MAILED FFB 2 2 2 U11

OFFICE OF PETITIONS

SNR DENTON US LLP P.O. BOX 061080 CHICAGO IL 60606-1080

In re Application of

**Bomze** 

: DECISION ON PETITION

Application No. 11/367,083

Filed: March 3, 2006

Atty. Dkt. No.: 40024720-0002-002

This decision is in response to the petition under 37 CFR 1.137(b), filed December 23, 2010.

The petition is **GRANTED**.

The application became abandoned January 27, 2010 for failure to timely submit a proper reply to the non-final Office action mailed October 26, 2009. The non-final Office action set a three month shortened statutory period of time for reply. No petition for extension of time under 37 CFR 1.136(a) was timely filed. Notice of Abandonment was mailed July 19, 2010.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The instant petition has been carefully reviewed and found in compliance with the requirements set forth above.

This application is being forwarded to Group Art Unit 3746 for further processing.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, practitioner's signature appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. If practitioner desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to practitioner, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3205.

#### /ALESIA M. BROWN/

Alesia M. Brown Attorney Advisor Office of Petitions

CC: Oren Reches
211 North Union Street, Suite 100
Alexandria, VA 22314

Doc Code: PET.PTA.RCAL

**Document Description:** Request for Recalculation in view of Wyeth

Approved for use through 02/28/2011. OMB 0651-0020

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

Attorney Docket Number: Liu 49-15 (X)-US-NP

Patent Number: 7,668,463

Filing Date (or 371(b) or (f) Date): March 3, 2006

Issue Date: February 23, 2010

First Named Inventor:

or: Xiang Liu

Title: Method and apparatus for generating and transmitting WDM MWOF signals

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-WYETH INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

Signature /Gregory J. Murgia/	Date August 10, 2010
Name (Print/Typed) Gregory J. Murgia	Registration Number 41,209

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.

*Total of forms are submitte
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The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.** 



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/19/2010

WALL & TONG, LLP/ ALCATEL-LUCENT USA INC. 25 James Way Eatontown, NJ 07724

Applicant: Xiang Liu: DECISION ON REQUEST FORPatent Number: 7668463: RECALCULATION of PATENTIssue Date: 02/23/2010: TERM ADJUSTMENT IN VIEW

Application No: 11/367,119 : OF WYETH AND NOTICE OF INTENT TO Filed : 03/03/2006 : ISSUE CERTIFICATE OF CORRECTION

:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be  $\bf 866$  days. The USPTO will  $\it suasponte$  issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

Doc Code: PET.PTA.RCAL

**Document Description:** Request for Recalculation in view of Wyeth

Approved for use through 02/28/2011. OMB 0651-0020

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

Attorney Docket Number: Fishman 22-48 (DA)-US-NP

Filing Date (or 371(b) or (f) Date): March 3, 2006

Patent Number: 7,660,537

Issue Date: February 9, 2010

First Named Inventor:

or: Daniel A. Fishman

Title: Simultaneous electrical pre-compensation of self-phase modulation and chromatic dispersion

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-WYETH INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

Signature /Gregory J. Murgia/	Date August 9, 2010
Name (Print/Typed) Gregory J. Murgia	Registration Number 41,209

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*

~	*Total of1	forms are submitted
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The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.** 



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/16/2010

WALL & TONG, LLP/ ALCATEL-LUCENT USA INC. 25 James Way Eatontown, NJ 07724

Applicant : Daniel A. Fishman

Patent Number : 7660537

Issue Date : 02/09/2010

Application No. 11/267 141

**Application No:** 11/367,141 **Filed** : 03/03/2006

: DECISION ON REQUEST FOR : RECALCULATION of PATENT

: TERM ADJUSTMENT IN VIEW
: OF WYETH AND NOTICE OF INTENT TO

: ISSUE CERTIFICATE OF CORRECTION

:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 913 days. The USPTO will suasponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

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AUG 03 2010

FISH & RICHARDSON P.C. / ST. JUDE ST. JUDE CHILDREN"S RESEARCH HOSPITAL P.O. BOX 1022 MINNEAPOLIS MN 55440-1022

OFFICE OF PETITIONS

In re Application of

HOUGHTON, Peter J. et al.

Application No. 11/367,161

Filed: March 3, 2006

Attorney Docket No. 02427/1201450-US1

NOTICE UNDER 37 CFR. 1.28(c)

This is a notice regarding your renewed request for acceptance of a fee deficiency submission under 37 CFR 1.28.

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to Michelle R. Eason at (571) 272-4231.

Thurman K. Page Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES CA 90013-1024

MAILED

DEC 202011

OFFICE OF PETITIONS

In re Application of

Sato et al.

Application No. 11/367,179

Filed: March 2, 2006

Attorney Docket No. 285032006500

DECISION ON PETITION
TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 23, 2011.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office will require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, which the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any replies that may be due and the time frame within which the client must respond, pursuant to 37 CFR 10.40 (c).

The request was signed by Mehran Arjomand, on behalf of all attorneys/agents of record who are associated with Customer Number 25224.

All attorneys/agents associated with the Customer Number 25224 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the assignee at the address indicated below.

Currently, there is no outstanding Office action that requires a reply.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751. All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

/Joan Olszewski/ Joan Olszewski Petitions Examiner Office of Petitions

cc: Cataler Corporation 7800, Chihama

Kakegawa-Shi, Shizuoka Japan 437-1492



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

STATTLER-SUH PC / NETLOGIC 60 SOUTH MARKET STREET SUITE 480 SAN JOSE CA 95113

MAILED

NOV 1 6 2010

OFFICE OF PETITIONS

In re Application of Stefanos Sidiropoulos et al.

Application No. 11/367,253

Filed: March 02, 2006

NOTICE

Attorney Docket No. NTLG.P0011

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquirie's related to this communication should be directed to the undersigned at (571) 272-2783.

/Tredelle D. Jackson/ Paralegal Specialist Office of Petitions



### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

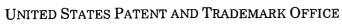
APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/367,304	03/06/2006	Detlef Becker	32860-000861/US/01	4510
30596	7590 08/04/2010		EXAM	INER
HARNESS, DICKEY & PIERCE, P.L.C. P.O.BOX 8910		TERCE, T.E.C.	YUN, CARINA	
RESTON, VA	20195		ART UNIT	PAPER NUMBER
			2194 .	
		,		
			NOTIFICATION DATE	DELIVERY MODE
			08/04/2010	ELECTRONIC

## Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dcmailroom@hdp.com siemensgroup@hdp.com pshaddin@hdp.com





Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Donald J. Daley	IAILED	August 3, 2010
P.O.Box 8910. Reston, Virginia 20195	UG 0-2 2010	-
Techn	ology Center 2100	
In re Application of:	)	
Detlef Becker et al.	)	
Application No. 11/367,304	)	<b>DECISION ON PETITION</b>
Filed: March 6, 2006.	)	<b>UNDER 37 CFR § 1.181(a)</b>
For: SYSTEM ARRANGEMENT AND MET	( THOD	
FOR AUTOMATED APPLICATION	)	
DEVELOPMENT WITH USER GUIDANCE	)	

This is a decision on the petition filed March 22, 2010 requesting a restart of a Statutory Period for Response due to failure to receive an Office Action.

#### The petition is **GRANTED**.

On March 22, 2010, Petitioner filed a request to re-mail an Office Action originally mailed October 16, 2009 and to restart the statutory period for response.

In an Office Action mailed October 16, 2009, the Examiner issued an Office Acton finally rejecting claims 1-23.

In the petition filed on January 22, 2010, Petitioner alleges that Action mailed October 16, 2009 was never received. The petition states that a routine check for the status of the application on PAIR revealed that a Final Rejection had been mailed. A check of docket records at the firm failed to disclose any indication that the Action had been received.

#### I. As noted in MPEP 711.03(c)(I),

{A]n allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and re-mail the Office action...To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish non-receipt of an Office action. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is

Serial No.: 11/367,304 Decision on Petition

sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the non-received Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the non-received Office action must be submitted as documentary proof of non-receipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The petition appears to meet the above requirements. Therefore, the petition is **GRANTED**. The Office Action will be re-mailed and the period of response restarted.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3591.

/Gail O. Hayes/

Gail O. Hayes Special Program Examiner/Quality Assurance Specialist Technology Center 2100 Computer Architecture, Software, and Information Security



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.usplo.gov

RAM VAIRAVAN 1647, ANDORRE GLEN, ESCONDIDO. SAN DIEGO CA 92029

MAILED

SEP 13 2010

In re Application of : OFFICE OF PETITIONS

Vinayagamurthy et al.

Application No. 11/367,344 : ON PETITION

Filed: March 6, 2006

Title: MULTIMODULAR MULTISTAGE :

HIGH IMPACT COLLISION ENERGY

**ABSORBER** 

This is a decision on the renewed petition under the unavoidable provisions of 37 CFR 1.137(a), filed May 10, 2010, to revive the above-identified application.

#### The petition is **DISMISSED**.

Any further petition to revive must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C.§ 704.

This application became abandoned for failure to timely reply to the Notice of Non-Compliant Amendment under 37 CFR 1.121, mailed July 23, 2008, which set a one (1) month period for reply. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on August 24, 2008. A Notice of Abandonment was mailed February 9, 2009.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). The instant petition lacks items (1) and (3).

As to item (1), petitioner has not yet provided a response to the Notice of Non-Compliant Amendment. A reply is necessary for revival of the instant application. A copy of the Notice is enclosed for petitioners' convenience.

As to item (3), a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v, Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). A delay caused by an applicant's lack of knowledge or improper application of the patent statute,

rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994).

If petitioner cannot provide the evidence necessary to establish unavoidable delay, or simply does not wish to, petitioner may wish to consider filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the \$810.00 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

Mail Stop PETITION Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

By hand:

U. S. Patent and Trademark Office

Customer Service Window, Mail Stop Petitions

Randolph Building 401 Dulany Street Alexandria, VA 22314

By facsimile:

(571) 273-8300 Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to Petitions Examiner Liana Walsh at (571) 272-3206.

/dab/ David Bucci **Petitions Examiner** Office of Petitions

Enclosure:

Notice of Non-Compliant Amendment

Notice of Non-Compliant Amendment	<b>Application No.</b> 11/367,344	Applicant(s) VINAYAGAMURT	HY ET AL.
(37 CFR 1.121)		Art Unit 3998	
The MAILING DATE of this communication app	pears on the cover sheet w	vith the correspondence addr	ess
The amendment document filed on <u>27 June</u> , <u>2008</u> is correquirements of 37 CFR 1.121 or 1.4. In order for the an item(s) is required.	nsidered non-compliant b nendment document to b	ecause it has failed to meet e compliant, correction of the	the e following
THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE  1. Amendments to the specification:  A. Amended paragraph(s) do not include  B. New paragraph(s) should not be under  C. Other	markings.	:NT TO BE NON-COMPLIAI	NT:
<ul><li>2. Abstract:</li><li>A. Not presented on a separate sheet. 37</li><li>B. Other</li></ul>	7 CFR 1.72.		
<ul> <li>3. Amendments to the drawings:</li> <li>A. The drawings are not properly identifie</li> <li>"Annotated Sheet" as required by 37 C</li> <li>B. The practice of submitting proposed dr showing amended figures, without ma</li> <li>C. Other</li> </ul>	CFR 1.121(d). rawing correction has be	en eliminated. Replacement	t drawings
<ul> <li>✓ 4. Amendments to the claims:</li> <li>☐ A. A complete listing of all of the claims is</li> <li>☐ B. The listing of claims does not include the</li> <li>✓ C. Each claim has not been provided with of each claim cannot be identified. No number by using one of the following some of the following some of the following some of the following some of the claims of this amendment paper here.</li> <li>☐ D. The claims of this amendment paper here.</li> </ul>	he text of all pending clain the proper status identifute: the status of every clatatus identifiers: (Originantered), (Withdrawn) and	ier, and as such, the individu aim must be indicated after i il), (Currently amended), (Ca (Withdrawn-currently amend	ual status its claim anceled), ded).
5. Other (e.g., the amendment is unsigned or no of the amendment format required by 37 CFR 1.121	ot signed in accordance v	vith 37 CFR 1.4): For further	explanation
TIME PERIODS FOR FILING A REPLY TO THIS NOTION  1. Applicant is given no new time period if the non-corfiled after allowance, or a drawing submission (only) amendment with corrections, the entire corrected and the corrected and	mpliant amendment is an If applicant wishes to re	submit the non-compliant aft	ı amendmen er-final
2. Applicant is given one month, or thirty (30) days, wh correction, if the non-compliant amendment is one of (including a submission for a request for continued examendment filed within a suspension period under 3 Quayle action. If any of above boxes 1 to 4 are check non-compliant amendment in compliance with 37 CF	the following: a preliming xamination (RCE) under 7 CFR 1.103(a) or (c), an ked, the correction requir	ary amendment, a non-final a 37 CFR 1.114), a supplemen d an amendment filed in res	amendment ntal ponse to a
Extensions of time are available under 37 CFR 1 amendment or an amendment filed in response to Failure to timely respond to this notice will result	a Quayle action.	ompliant amendment is a no	n-final

amendment.

filed in response to a Quayle action; or

Legal Instruments Examiner (LIE), if applicable /DEBORAH NASH/

Telephone No: (571)272-6614

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

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SEP 1 4 2010

**OFFICE OF PETITIONS** 

**COOLEY LLP** 

**ATTN: PATENT GROUP** 

Suite 1100, 777 - 6th Street, NW

Washington DC 20001

In re Patent No. 7,544,772

: DECISION ON REQUEST FOR

TAKASHI et al.

: RECONSIDERATION OF

Issue Date: June 9, 2009

: PATENT TERM ADJUSTMENT

Application No. 11/367,449

: AND

Filed: March 6, 2006

: NOTICE OF INTENT TO ISSUE

Docket No. BMRK-003/03US 305167-2030: CERTIFICATE OF CORRECTION

This is a decision on the renewed petition under 37 CFR 1.705(d) filed August 6, 2010, requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by three hundred ninety (390) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by three hundred ninety (390) days is GRANTED.

The Office acknowledges the previous submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by three hundred ninety (390) days.

Inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina lartera Donnell Christina Tartera Donnell

Senior Petitions Attorney

Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

## UNITED STATES PATENT AND TRADEMARK OFFICE **CERTIFICATE OF CORRECTION**

PATENT

: 7,544,772 B2

DATED

: Jun. 9, 2009

**DRAFT** 

INVENTOR(S): TAKASHI et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

Subject to any disclaimer, the term of this patent is extended or adjusted [\*] Notice: under 35 USC 154(b) by 265 days.

Delete the phrase "by 265 days" and insert - by 390 days--



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COOLEY LLP

ATTN: PATENT GROUP

Suite 1100

777 - 6th Street, NW

**WASHINGTON DC 20001** 

MAILED

SEP 1 6 2010

OFFICE OF PETITIONS

In re Patent No. 7544772

Issue Date: 06/09/2009

Application Number: 11/367449

Filing or 371(c) Date: 03/06/2006

Attorney Docket Number: BMRK-003/03US

305167-2030

ON PETITION

This is a decision on the "REQUEST FOR CERTIFICATE OF CORRECTION," filed December 17, 2009, which is being treated as a request under 37 CFR 3.81(b)<sup>1</sup> to correct the assignee data on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

The processing fee of \$130.00 required by § 1.17(h) will be charged to counsel's deposit account.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3231. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Douglas I. Wood Senior Petitions Attorney

Office of Petitions

<sup>&</sup>lt;sup>1</sup> See MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

Commissioner for Patents MAILE Dates Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

AUG 16 2010 OFFICE OF PETITIONS

ROSENBERG, KLEIN & LEE 3458 ELLICOTT CENTER DRIVE-SUITE 101 ELLICOTT CITY, MD 21043

In re Application of

Chih-Shen Lin et al

Application No. 11/367,477

Filed: March 6, 2006

Attorney Docket No. MR2349-1286

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

Telephone inquiries related to this communication should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle

Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 ww.uspto.gov

MAILED

Douglas B. Jacoby 34 Cloverly Road Wellesley MA 02481

DEC 062010 OFFICE OF PETITIONS

In re Application of Douglas B. Jacoby et al. Application No. 11/367,628

Filed: March 3, 2006

**DECISION ON PETITION** 

Attorney Docket No. 2006866-0049

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 2, 2010, to revive the above-identified application.

#### The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Restriction Requirement mailed April 9, 2008, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on May 10, 2008. A Notice of Abandonment was mailed on November 3, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an election and amendment, (2) the petition fee of \$810, and (3) a proper statement of unintentional delay. Accordingly the election and amendment is accepted as being unintentionally delayed.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272 -4618.

This application is being referred to Technology Center AU 1651 for appropriate action by the Examiner in the normal course of business on the reply received November 2, 2010.

/Kimberly Inabinet/

Kimberly Inabinet Petitions Examiner Office of Petitions

cc: Kevin M. Farrell
Pierce Atwood LLP
One New Hampshire Avenue
Suite 350
Portsmouth, NH 03801



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

Elan Drug Delivery, Inc. c/o Foley & Lardner 3000 K Street, N.W. Suite 500 Washington DC 20007-5109

MAILED

AUG 05 2010

In re Application of Cooper, et al.

OFFICE OF PETITIONS

Application No. 11/367,716

ON PETITION

Filed: March 6, 2006

Attorney Docket No. 029318-1183

This is a decision on the petitions, both filed September 6, 2007, under 37 CFR 1.48(a) for correction of inventorship and under 37 CFR 1.183, requesting waiver of 37 CFR 1.48(a)(3), which requires submission of an oath or declaration signed by the actual inventors.

The petition under 37 CFR 1.48(a) is dismissed.

The petition under 37 CFR 1.183 to waive 37 CFR 1.48(a)(3) is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. FAILURE TO TIMELY RENEW THE PETITION WILL RESULT IN ABANDONMENT. The reconsideration request should include a cover letter entitled "Renewed Petitions under 37 CFR §§ 1.48 and 1.183.

A review of the petitions reveals that they are copies of petitions that were filed in Application No. 09/337,675. It is noted that Application No. 11/367,716 is a continuation of Application No. 09/337,675. However, neither petition has been properly filed in Application No. 11/367,716. There is no similar procedure to utilize a petition under Rule 1.48 originally filed in a parent application in a child application as there is for utilizing a petition under Rule 1.47 originally filed in a parent application in a child application. See 37 CFR 1.63(d)(3).

Even if the petitions were properly filed in Application No. 11/367,716, it is noted that the petition under 1.183 does not state any facts to that show an extraordinary situation exists which justice would require waiver of the rules.

It is noted that Gary G. Liversidge has been named as a joint inventor in the present application from the date the application was filed. Gary Liversidge was added as an inventor in Application No. 09/337,675 on March 29, 2010. While Application No. 09/337,675 lists the inventor as

"Gary Liversidge" and the present application lists him as "Gary G. Liversidge", they appear to be the same person. The applications share a common inventor and it seems that applicants' priority issue as discussed in the March 7, 2007 non-final Office action has been resolved.

For consideration of the present petitions, deposit account no. 19-0741 will be charged the Rule 183 \$400.00 petition fee set forth in 37 CFR 1. 17(f) and the Rule 48 \$130.00 processing fee set forth in 37 CFR 1.17 (i).

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

Mail Stop PETITION

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

By hand:

U. S. Patent and Trademark Office

Customer Service Window, Mail Stop Petitions

Randolph Building 401 Dulany Street Alexandria, VA 22314

By facsimile:

(571) 273-8300

Attn: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (571) 272-3230.

Shure Mully Brawlly Shirene Willis Brantley Senior Petitions Attorney

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Elan Drug Delivery, Inc. c/o Foley & Lardner 3000 K Street, N.W. Suite 500 Washington DC 20007-5109

MAILED

OCT 08 2010

In re Application of

OFFICE OF PETITIONS

Cooper, et al.

Application No. 11/367,716

ON PETITION

Filed: March 6, 2006

Attorney Docket No. 029318-1183

This is a decision on the renewed petitions, both filed August 26, 2010, under 37 CFR 1.48(a) for correction of inventorship and under 37 CFR 1.183, requesting waiver of 37 CFR 1.48(a)(3), which requires submission of an oath or declaration signed by the actual inventors.

The petition under 37 CFR 1.48(a) is dismissed as moot.

The petition under 37 CFR 1.183 to waive 37 CFR 1.48(a)(3) is dismissed as moot.

As noted by applicants, Gary G. Liversidge has been named as a joint inventor in the present application from the date the application was filed. Gary Liversidge was added as an inventor in Application No. 09/337,675 on March 29, 2010. The applications share a common inventor. Applicants and the Office agree that applicants' priority issue as discussed in the March 7, 2007 non-final Office action has been resolved.

In view of the above discussion, both petitions are dismissed as moot.

The application is being referred to Technology Center G.A.U. 1615.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley
Senior Petitions Attorney

Office of Petitions



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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C One Financial Center BOSTON MA 02111

MAILED

MAY 23-2011

OFFICE OF PETITIONS

In re Application of

SOITO, Angela et al.

Application No. 11/367,719

Filed: March 06, 2006

Attorney Docket No. 34668-501013US

DECISION ON PETITION TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 28, 2011.

The request is **NOT APPROVED**.

The Office will no longer accept address changes to a new practitioner or law firm filed with a Request, absent the filing of a power of attorney to the new representative. The Office will either change the correspondence address of record to the most current address information provided for the assignee of the entire interest who properly became of record under 37 C.F.R 3.71 or, if no assignee of the entire interest has properly been made of record under 37 CFR 3.71, the most current address information provided for the first named inventor.

Accordingly, the request to withdraw from record cannot be approved because the change of address is not that of: (1) the first named inventor; or (2) an assignee of the entire interest under C.F.R 3.71, who has properly intervened.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4231.

Michelle R. Eason Paralegal Specialist Office of Petitions





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.usplo.gov

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C ONE FINANCIAL CENTER BOSTON MA 02111

MAILED

JUL 29 2011

In re Application of

SOITO, Angela et al.

Application No. 11/367,719

Filed: March 06,1 2006

Attorney Docket No. 34668-501013US

**OFFICE OF PETITIONS** 

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 12, 2011.

#### The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by Fred C. Hernandez on behalf of all attorneys of record who are associated with customer No. 23980. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the first named inventor Angela Soito at the address indicated below.

There is an outstanding Office action mailed December 07, 2010 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4231.

Myhelle a Sieson Michelle R. Eason Paralegal Specialist Office of Petitions

cc:

ANGELA SOITO 3033 CAMPUS DRIVE PLYMOUTH, MINNESOTA 55441



COMMISSIONER FOR PATENTS

UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No.

NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON VA 22203 MAILED NOV 0.8 2010

OFFICE OF PETITIONS

In re Application of

Norio Sugiura, Satoshi Murata,

Kengo Kanii, Shota Makimoto,

and Katsufumi Ohmuro

Application No. 11/367,774 Filed: March 6, 2006

Attorney Docket No. 4825-9

Title: LIQUID CRYSTAL DISPLAY
AND METHOD OF MANUFACTURING THE

SAME

DECISION ON SIXTH RENEWED

PETITION PURSUANT TO

37 C.F.R. § 1.47(A)

This is in response to the sixth renewed petition submitted on August 23, 2010, pursuant to 37 C.F.R.  $\S$  1.47(a).

This sixth renewed petition pursuant to 37 C.F.R. § 1.47(a) is **GRANTED.** 

On March 6, 2006, the application was deposited, identifying Norio Sugiura, Satoshi Murata, Kengo Kanii, Shota Makimoto, and Katsufumi Ohmuro as joint inventors. On March 31, 2006, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (Notice), requiring an executed oath or declaration in compliance with 37 C.F.R. § 1.63, the surcharge associated with the late submission of the same, the basic filing fee, the search fee, and the examination fee. The notice set a two-month period for response.

A grantable petition pursuant to 37 C.F.R. § 1.47(a) requires:

- (1) the petition fee of \$200;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 C.F.R. § 1.16(e);
- (3) a statement of the last known address of the non-signing inventor;

#### (4) either

- a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
- b) proof that the non-signing inventor cannot be found or reached after diligent effort, and;
- (5) a declaration which complies with 37 C.F.R. § 1.63.

An original petition was filed on October 27, 2006 along with a declaration that had been executed by each of the joint inventors save Messrs. Sugiura and Kanii. The original petition was dismissed via the mailing of a decision on January 23, 2007.

A renewed petition was filed July 23, 2007 (along with a declaration that had been executed by Mr. Kanii), and was dismissed via the mailing of a decision on August 6, 2007, for failure to establish that a diligent search had been performed for non-the signing inventor, and for failure to provide an acceptable declaration.

A second renewed petition was filed on March 5, 2008, along with a properly executed declaration and a four-month extension of time. The second renewed petition was dismissed via the mailing of a decision on March 17, 2008.

A third renewed petition was submitted on June 5, 2008, and was dismissed via the mailing of a decision on August 11, 2008, which indicated that requirements (1) - (3) of Rule 1.47(a) had been met, and noted that the Assignee has actual knowledge that the non-signing inventor does not live at the address that has been asserted to be his last known address.

A fourth renewed petition was submitted on March 11, 2009, and was dismissed via the mailing of a decision on June 15, 2009.

A fifth renewed petition was submitted on January 15, 2010, and was dismissed via the mailing of a decision on February 1, 2010.

With this sixth renewed petition, Petitioner has included, *interalia*, a five-month extension of time so as to make timely this submission and a statement from Makoto Ohashi. The fourth and fifth requirements of Rule 1.47(a) have been satisfied.

Application No. 11/367,774

Decision on Sixth Renewed Petition pursuant to 37 C.F.R. § 1.47(a)

Consequently, each requirement of 37 C.F.R. § 1.47(a) has been met.

The above-identified application and papers have been reviewed and found in compliance with 37 C.F.R. § 1.47(a). This application is hereby accorded Rule § 1.47(a) status.

As provided in Rule 1.47, this Office will forward notice of this application's filing to the non-signing inventor at the address that appears on the Supplemental Application Data Sheet that was submitted on July 23, 2007. Notice of the filing of this application will also be published in the Official Gazette.

The Technology Center will be notified of this decision, and jurisdiction over this application is transferred to the Technology Center, so that the application may receive further processing. The Technology Center's support staff will notify the Examiner of this decision, so that the present application can receive further processing in due course.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

<sup>1</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R.  $\S$  1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Norio Sugiura 2-15-6, Tomizawa, Taihaku-ku, Sendai-shi, Miyagi 982-0032 JAPAN

**MAILED** 

NOV 082010

OFFICE OF PETITIONS

In re Application of :
Norio Sugiura, Satoshi :
Murata, Kengo Kanii, Shota :
Makimoto, and Katsufumi :

Ohmuro
Application No. 11/367,774

LETTER

Filed: March 6, 2006 :
Attorney Docket No. 4825-9 :
Title: LIQUID CRYSTAL DISPLAY :
AND METHOD OF MANUFACTURING :
THE SAME :

Dear Mr. Sugiura:

You are named a joint inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. § 116 (United States Code) and 37 C.F.R. § 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application, you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 C.F.R. § 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, the attorney of record below would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. § 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3225. Requests

Application No. 11/367,774 Letter

for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

CC: NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON VA 22203



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

	·			
APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/367,992	03/03/2006	Gregory T.A. Kovacs	PHY-101	6454
23574 7590 12/15/2010 LAW OFFICE OF ANDREI D POPOVICI, P.C.			EXAM	INER
4020 MOORPARK AVE.			BERTRAM, ERIC D	
SUITE101 SAN JOSE, C.	A 95117		ART UNIT	PAPER NUMBER
•			. 3766	
•				
			NOTIFICATION DATE	DELIVERY MODE
			12/15/2010	ELECTRONIC

# Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ANDREI@APATENT.COM adpopovici@gmail.com



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

LAW OFFICE OF ANDREI D POPOVICI, P.C. 4020 MOORPARK AVE. SUITE101 SAN JOSE CA 95117

In re Application of:

KOVACS, GREGORY T.A.

Serial No.: 11/367,992 Filed: March 3, 2006

Docket: PHY-101

Title: INTEGRATED PHYSIOLOGIC

MONITORING SYSTEMS AND

METHODS

DECISION ON PETITION TO ENTER AMENDMENT AFTER

**FINAL** 

This is a decision on the petition filed on November 30, 2010 to enter the Affidavit under 37 CFR § 1.132 and a dictionary definition of the term "integrated circuit" filed on September 30, 2010 after the final Office action issued on June 22, 2010. The petition is filed under 37 CFR § 1.181. No fee is required.

The petition is dismissed.

In the petition, the applicant requests a review of the examiner's refusal to enter the 37 CFR § 1.132 Declaration (Rule 132 Affidavit) and the dictionary definition filed on September 30, 2010 after the final rejection which was mailed on June 22, 2010. In the advisory action of October 20, 2010, the examiner refused to enter the Rule 132 Affidavit and the dictionary definition filed after final Office action because the applicant failed to provide a showing of good and sufficient reasons why the Rule 132 Affidavit and the dictionary definition were necessary and not presented prior to the final Office action of June 22, 2010.

### The record shows that:

On each of the Office actions, namely, the non-final action December 12, 2008 and the recent final refection of June 22, 2010, the examiner has rejected claims with the term "application-specific integrated circuit" under 35 U.S.C. § 102 and § 103. The examiner has properly applied plain meaning rule when interpret claim language. The issues regarding 35 USC § 102 and 103, *inter alia*, remain unchanged since the first non-final Office action of December 12, 2008. After the final rejection mailed of June 22, 2010, on September 30, 2010, the applicant submitted a

Rule 132 Affidavit under 37 CFR 1.116 with a dictionary definition of the term "integrated circuit" from dictionary com website, in an attempt to overcome the rejections of claims under 35 USC § 103 and § 103. In particular, the affiant attempted to show the examiner's claim interpretation was wrong. In the Advisory Action of October 20, 2010 the examiner refused to enter the Rule 132 Affidavit and the dictionary definition because the applicant did not "provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented." On November 30, 2010, the present petition to request entry of the 37 CFR § 1.132 Affidavit and the dictionary definition of September 30, 2010 after final Office action was filed. In the petition, petitioner argues that the Rule 132 Affidavit and the dictionary definition were submitted in an attempt to overcome the rejections of claims under 35 USC § 102 and § 103. In the petition, petitioner argues that the examiner's previous Office action December 12, 2008 was unclear in the claim interpretation. Therefore, petitioner opines the Rule 132 Affidavit and dictionary definition filed under 37 CFR § 1.116 simply cannot be presented any earlier. Thus, the Rule 132 Affidavit and the dictionary definition should be entered as evidence for appeal purpose.

# Discussion and Analysis

In the petition, petitioner contends that the information contained in the 37 CFR §1.132 Affidavit and the dictionary definition could not have been presented prior to or earlier than the final Office action because the examiner's claim interpretation was unclear until the final Office action issued on June 22, 2010. Therefore, the Rule 132 affidavit and the dictionary definition filed under 37 CFR § 1.116 cannot be presented any earlier. This line of the arguments regarding the examiner's unclear claim interpretation is not convincing. In the non-final Office action of December 12, 2008, the examiner has correctly applied the plain meaning claim interpretation when rejecting the claims in accordance with MPEP § 2111.01. If the applicant disagrees with the examiner's claim interpretation or finds the examiner's claim interpretation was wrong, the applicant should have traversed the examiner's rejection. The disagreement in claim interpretation in the rejection of the claims will become an appealable issue and will not be decided by petition (see 37 CFR 1.181(a)). If the examiner's claim interpretation was unclear, the applicant should have requested a clear Office action prior to the final rejection of June 22, 2010. The applicant should not have waited until after the final rejection, then, submit additional evidence via a Rule 312 affidavit and the dictionary definition to rebut the examiner's claim interpretation and overcome the final rejection of the claims. Under the circumstances, the requested relief can not be granted.

After a complete review of the file history, it appears that the applicant had ample opportunity to present information relevant to the issue of the term "application-specific integrated circuit" prior to the final rejection. The Rule 132 Affidavit and the dictionary definition could have filed to rebut the examiner's position and overcome the rejections of claims under 35 USC § 102 and 103 prior to the final rejection of June 22, 2010. Only after the most recent Office action of June 22, 2010, did the applicant decide to file a Rule 132 Affidavit and the dictionary definition. At this late stage of the prosecution, the examiner must conduct a detail review of the Rule 132 Affidavit and the dictionary definition of September 30, 2010 filed under 37 CFR § 1.116. Therefore, the examiner concluded that Rule 132 Affidavit and the dictionary definition of September 30, 2010 should not be entered on the ground that the applicant failed to provide a

showing of good and sufficient reasons why the Rule 132 Affidavit and the dictionary definition were necessary and not presented prior to the final Office action of June 22, 2010. The requested relief can not be granted.

### Conclusion

For the foregoing reasons, the relief requested by petitioners will not be granted. Specifically, the examiner's refusal admitting the Rule 132 Affidavit and the dictionary definition of September 30, 2010 after final is proper.

The application is being forwarded to Examiner Eric Bertram of Art Unit 3766 awaiting applicant's appeal brief. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136 (a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." Any inquiry regarding this decision should be directed to Henry Yuen, Special Program Examiner, at (571) 272-4856.

PETITION DISMISSED.

Angela D/Sykes, Director Technology Center 3700



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/367,992	03/03/2006	Gregory T.A. Kovacs	PHY-101	6454
23574 7590 04/22/2011 LAW OFFICE OF ANDREI D POPOVICI, P.C.			EXAM	INER
4020 MOORPARK AVE.			BERTRAM, ERIC D	
SUITE101 SAN JOSE, CA	A 95117		ART UNIT	PAPER NUMBER
, ·		•	3766	
	•		NOTIFICATION DATE	DELIVERY MODE
			04/22/2011	ELECTRONIC

# Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ANDREI@APATENT.COM adpopovici@gmail.com



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

LAW OFFICE OF ANDREI D POPOVICI, P.C. 4020 MOORPARK AVE. SUITE101 SAN JOSE CA 95117

*In re* Application of:

KOVACS, GREGORY T.A.

Serial No.: 11/367,992

Filed: March 3, 2006 Docket: PHY-101

Title:

INTEGRATED PHYSIOLOGIC

MONITORING SYSTEMS AND

**METHODS** 

DECISION ON PETITION TO ENTER AMENDMENT

AFTER FINAL

This is a decision on the renewed petition filed on February 14, 2011 to enter the Affidavit under 37 CFR § 1.132 and a dictionary definition of the term "integrated circuit" filed on September 30, 2010 after the final Office action issued on June 22, 2010. The petition is being considered pursuant to 37 CFR 1.181 and no fee therefore is required.

#### The petition is DENIED.

In the renewed petition, petitioner requests entry of the Affidavit and a dictionary definition under 37 CFR § 1.312 filed on September 30, 2010. In the renewed petition, petitioner also requests a review of the examiner's refusal to enter the 37 CFR § 1.132 Declaration (Rule 132 Affidavit) and the dictionary definition filed on September 30, 2010 after the final rejection which was mailed on June 22, 2010. In the advisory action of October 20, 2010, the examiner refused to enter the Rule 132 Affidavit and the dictionary definition filed after final Office action because the applicant failed to provide a showing of good and sufficient reasons why the Rule 132 Affidavit and the dictionary definition were necessary and not presented prior to the final Office action of June 22, 2010.

### The record shows that:

On each of the Office actions, namely, the non-final action December 12, 2008 and the recent final refection of June 22, 2010, the examiner has rejected claims with the term "application-specific integrated circuit" under 35 U.S.C. § 102 and § 103 as unpatentable over Farringdon (U.S. Pat. Pub. 2005/0113703). The examiner has properly applied plain meaning rule when interpret claim language in accordance with MPEP § 2111.01. In particular, the examiner

interpreted the phrase "application-specific integrated circuit" with individual words by giving each word it's plain and ordinary meaning. While "an application-specific integrated circuit" is a specific way to interpret the phrase, giving the broadest reasonable interpretation to the individual words merely results in a grouping of electrical components for a specific application. This is a normal approach for claim interpretation. The examiner's interpretation of claim language is not unreasonable. The parts of the reference (Fig.4 of Farringdon) the examiner referred to clearly disclose a plurality of electrical components integrated together to perform a specific application. In the response filed on June 11, 2009, the applicant did not make any claim amendment. If the applicant wants the examiner to consider an "application specific integrated circuit" as single and combined term, the applicant could have amended the claims in a way to do so. However, the applicant did traverse the examiner's rejection and presented substantive rebuttal arguments regarding the term "application-specific integrated circuit". It appears to be the applicant's interpretation that an "application specific integrated circuit" in its totality as a single term. Instead, the examiner interpreted it as an "applicationspecific" "integrated" "circuit" where the examiner gave plain and ordinary meaning to the individual words and then combined these meaning to interpret the claim. In the Office action of June 22, 2010, the examiner apparently clarified his position in response to the applicant's traversal of the rejection and the rebuttal arguments. At this point, the applicant and the examiner have reached an issue for appeal purpose. The issues regarding 35 USC § 102 and 103, inter alia, remain unchanged since the first non-final Office action of December 12, 2008. After the final rejection of June 22, 2010, on September 30, 2010, the applicant submitted a Rule 132 Affidavit under 37 CFR 1.116 with a dictionary definition of the term "integrated circuit" from dictionary.com website, in an attempt to overcome the rejections of claims under 35 USC § 103 and § 103. In particular, the affiant attempted to show the examiner's claim interpretation was wrong. In the Advisory Action of October 20, 2010 the examiner refused to enter the Rule 132 Affidavit and the dictionary definition because the applicant did not "provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented."

### Discussion and Analysis

In the renewed petition, petitioner contends that the information contained in the 37 CFR §1.132 Affidavit and the dictionary definition could not have been presented prior to or earlier than the final Office action because the examiner's claim interpretation was unclear until the final Office action issued on June 22, 2010. Therefore, the Rule 132 affidavit and the dictionary definition filed under 37 CFR § 1.116 cannot be presented any earlier. This line of the arguments is not convincing. In the non-final Office action of December 12, 2008, the examiner has correctly applied the plain meaning claim interpretation when rejecting the claims. If the applicant disagrees with the examiner's claim interpretation or finds the examiner's claim interpretation was wrong, the disagreement in claim interpretation in the rejection of the claims will become an appealable issue and will not be decided by petition (see 37 CFR 1.181(a)). Under the circumstances, the requested relief can not be granted.

After a complete review of the file history, it appears that the applicant had ample opportunity to present information relevant to the issue of the term "application-specific integrated circuit" prior to the final rejection. The Rule 132 Affidavit and the dictionary definition could have filed to

rebut the examiner's position and overcome the rejections of claims under 35 USC § 102 and 103 prior to the final rejection of June 22, 2010. Only after the most recent Office action of June 22, 2010, did the applicant decide to file a Rule 132 Affidavit and the dictionary definition. At this late stage of the prosecution, the examiner must conduct a detail review of the Rule 132 Affidavit and the dictionary definition of September 30, 2010 filed under 37 CFR § 1.116. Therefore, the examiner properly concluded that Rule 132 Affidavit and the dictionary definition of September 30, 2010 should not be entered on the ground that the applicant failed to provide a showing of good and sufficient reasons why the Rule 132 Affidavit and the dictionary definition were necessary and not presented prior to the final Office action of June 22, 2010. The requested relief can not be granted.

### Conclusion

Since the renewed petition fails to add anything new that is persuasive to cause reversal of the earlier decision. For the foregoing reasons, the relief requested by petitioner will not be granted. The decision is maintained. Specifically, the examiner's refusal admitting the Rule 132 Affidavit and the dictionary definition of September 30, 2010 after final is proper.

The application is being forwarded to Examiner Eric Bertram of Art Unit 3766 awaiting applicant's appeal brief. Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner at (571) 272-4856.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181" and directed to the Office of the Deputy Commissioner for Patent Examination Policy at Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. See MPEP 1002.02(b).

Accordingly, the petition is denied.

Angela D. Sykes, Director

Technology Center 3700



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

LAW OFFICE OF ANDREI D. POPOVICI, P.C. 4020 MOORPARK AVE. SUITE 101 SAN JOSE, CA 95117

MAILED

JUN 29 2011

OFFICE OF PETITIONS

In re Application of

Gregory T.A. KOVACS

Application No. 11/367,992

Filed: March 3, 2006

Attorney Docket No. PHY-101

DECISION ON PETITION

This is a decision on the petition filed May 24, 2011, requesting under 37 CFR 1.182 for expedited handling.

The petition is **GRANTED**.

Petitioners assert that a renewed petition has been filed in response to the petition decision mailed April 22, 2011. A renewed petition under 37 CFR 1.181 requesting reconsideration of the decision mailed April 22, 2011. Petitioner request that the fees required under 37 CFR 1.17(f) be applied from the payment made on February 14, 2011 based on the previous request for expedited handling.

A review of the file indicates that on February 14, 2011 a 37 CFR 1.182 petition was filed and included with that petition was a request for expedited handling of the petition and a fee of \$400.00 as required under 37 CFR 1.17(f). USPTO records indicated that the petition filed February 14, 2011 to expedite was granted for the above-identified application. Any request for reconsideration of a petition under 37 CFR 1.182 that is filed with the additional request to expedite a decision on the petition must be accompanied by the fee required under 37 CFR 1.17(f). Accordingly, the petition is granted, and as authorized, the petition fee of \$400.00 has been charged to petitioner's Deposit Account 50-2888.

Telephone inquiries related to this decision should be addressed to Thurman K. Page at (571) - 272-0602.

This application will be forwarded to the Office of Petitions for expedited decision on the 37 CFR 1.181 petition filed.

Thurman K. Page Petitions Examiner

Office of Petitions



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/367,992	03/03/2006	Gregory T.A. Kovacs	PHY-101	6454
23574 7590 09/27/2011 LAW OFFICE OF ANDREI D POPOVICI, P.C.		EXAM	INER	
4020 MOORPARK AVE. SUITE101 SAN JOSE, CA 95117		BERTRAM, ERIC D		
		ART UNIT	PAPER NUMBER	
			3766	
			NOTIFICATION DATE	DELIVERY MODE
			09/27/2011	ELECTRONIC

# Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ANDREI@APATENT.COM adpopovici@gmail.com

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

LAW OFFICE OF ANDREI D POPOVICI, P.C. 4020 MOORPARK AVE. SUITE101 SAN JOSE CA 95117

In re Application of:

KOVACS, GREGORY T.A.

Serial No. 11/367,992 Filed: March 3, 2006

Docket: phy-101

Title:

INTEGRATED PHYSIOLOGIC

MONITORING SYSTEMS AND

**METHODS** 

DECISION ON PETITION UNDER 37 CFR § 1.181

This is a decision on the renewed petition filed May 24, 2011 under 37 CFR 1.181 requesting entry of Rule 116 Amendment, Rule 132 Affidavits with Exhibits filed on September 30, 2010, October 20, 2010 and November 30, 2010. In the petition, petitioner requests the examiner to enter and consider responses and Affidavits with Exhibits filed under Rule 116. The renewed petition is being considered under 37 CFR 1.181. No fee is required.

The petition is granted.

In view of the decision mailed by the Petitioner Examiner on June 29, 2011 and the completion of an appeal conference on the Appeal Brief filed on July 10, 2011, the requested relief is granted. The examiner is requested to consider all Affidavits and Exhibits submitted under Rule 116 and issue an Office action in due course.

Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION GRANTED.

Angela D. Sykes, Director Technology Center 3700



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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

AGENSYS C/O MORRISON & FOERSTER LLP 12531 HIGH BLUFF DRIVE SUITE 100 SAN DIEGO CA 92130-2040 MAILED
FEB 1 5 2011
OFFICE OF PETITIONS

In re Patent No. 7,592,149 Issued: September 22, 2009 Application No. 11/368,284

Filed: March 2, 2006 Dkt. No.: 511582006701 : DECISION ON APPLICATION FOR : PATENT TERM ADJUSTMENT and : NOTICE OF INTENT TO ISSUE : CERTIFICATE OF CORRECTION

This is a decision on the petition filed on September 23, 2009 requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by 268 days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by 268 days is **GRANTED**.

The Office acknowledges receipt of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **268** days.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown Attorney Advisor Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

# **CERTIFICATE OF CORRECTION**

PATENT : 7,592,149

DATED : September 22, 2009

DRAFT

INVENTOR(S): Challita-Eid, et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 246 days

Delete the phrase "by 246 days" and insert - by 268 days--

	02/20/44	Paper No.:
DATE	: 03/30/11	
TO SPE OF	: ART UNIT: 1644 Attn: S	HUKLA RAM R (SPE)
SUBJECT	: Request for Certificate of Corre	ection for Appl. No.: 11/368296_Patent No.: <u>76121</u>
	(	C of C Mailroom date: 03/21/11
Please resp	ond to this request for a cert	ificate of correction within 7 days.
FOR IFW F	ILES:	
the IFW app		orrections as shown in the <b>COCIN</b> document(s) in ter should be introduced, nor should the scope or
	nplete the response (see beloment code <b>COCX</b> .	ow) and forward the completed response to scanning
FOR PAPE	R FILES:	
		orrections as shown in the attached certificate of see below) and forward it with the file to:
Rand	ificates of Correction Brand dolph Square – 9D10-A n Location 7580	ch (CofC)
		Tasneem Siddiqui
	·'	Certificates of Correction Branch 703-756-1593 or 703-756-18
Thank You	For Your Assistance	
-	st for issuing the above-ide on on the appropriate box.	entified correction(s) is hereby:
Note your decisit	Approved	All changes apply.
•		Specify below which changes do not apply.
X	Approved in Part	
X		State the reasons for denial below.
X	• •	

PTOL-306 (REV. 7/03)



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

# KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK NY 10022-2585

MAILED

FEB 10 Zuli

OFFICE OF PETITIONS

In re Patent No. 7,653,346 Application No. 11/368,373

Filed: March 3, 2006 Issued: January 26, 2010

Attorney Docket No. SCEP 22.432 (100809-

00315

**ON PETITION** 

This is a decision on the petition filed April 22, 2010 and June 3, 2010, which is being treated as a request under 37 CFR 3.81(b)<sup>1</sup> to add the name of the second assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

This matter is being referred to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-7751. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

Joan Olszewski Petitions Examiner Office of Petitions

<sup>&</sup>lt;sup>1</sup> See MPEP 1309, subsection II; and Official Gazette of June 22, 2004.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

MAILED

SEP 0 9 2010

OFFICE OF PETITIONS

BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314-1176

In re Application of Roy C. Haught, et al.

Application No. 11/368,414

Filed: March 7, 2006

Attorney Docket No.: HAUG3002

**ON PETITION** 

This is a decision on the petition, filed July 19, 2010, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before April 12, 2010, as required by the Notice of Allowance and Fee(s) Due, mailed January 11, 2010. A Notice of Abandonment was mailed on April 26, 2010. In response, on July 19, 2010, the present petition was filed.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. However, in accordance with 37 CFR 1.34(a), the signature of Laura Scalise appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that she is authorized to represent the particular party on whose behalf she acts. If Ms Scalise desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to the petitioner; however, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of \$1,510 and publication fee of \$300, (2) the petition fee of \$1,620; and (3) an adequate statement of unintentional delay.

The application is being referred to the Office of Data Management to be processed into a patent.

<sup>&</sup>lt;sup>1</sup> 37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. While the statement is not made by an attorney of record, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. Telephone inquiries related to processing as a patent should be directed to (571) 272-4200.

Petitions Examiner Office of Petitions

cc:

LAURA SCALISE U.S. ENVIRONMENTAL PROTECTION AGENCY 1200 PENNSYLVANIA AVE., N.W. WASHINGTON, DC 20460





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER

901 NEW YORK AVENUE, NW **WASHINGTON DC 20001-4413** 

MAILED

JUN 27 2011

In re Application of: OGINO ET AL.

OFFICE OF PETITIONS

Serial No.: 11/368,426

**DECISION ON PETITION** 

Filed: March 7, 2006

Attorney Docket No.: 09812.0632-01

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 1, 2011, to revive the above-identified application.

### The petition is **GRANTED**.

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed August 4, 2010, which set a shortened statutory period for reply of three (3) months. A three month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on February 4, 2011.

The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that prima facie places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2).

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of \$810.00, and the submission required by 37 CFR 1.114; (2) the petition fee of \$1620.00; and (3) a proper statement of unintentional delay.

This application is being referred to Technology Center AU 3685 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Any questions concerning this matter may be directed to Jose' G Dees at (571) 272-1569.

Christopher Bottorff Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.usplo.gov

MEDTRONIC VASCULAR, INC. IP LEGAL DEPARTMENT 3576 UNOCAL PLACE SANTA ROSA, CA 95403

MAILED

NOV 0 2 2011

OFFICE OF PETITIONS

In re Application of

Denise Demarais, et al.

Application No.: 11368,553

Filed: March 6. 2006

Attorney Docket No.: P40973.00

ON PETITION

This is a decision on the petition, filed November 1, 2011, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on October 14, 2011, cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 3766 for further processing of the request for continued examination and for consideration of the concurrently filed Information Disclosure Statement.

/SDB/ Sherry D. Brinkley Petitions Examiner Office of Petitions

cc: AARON J. POLEDNA PERKINS COIE LLP P.O. BOX 1247

SEATTLE, WA 98111-1247

<sup>&</sup>lt;sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s)
Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.

Doc Code: PET.AUTO Document Description: Petition	n automatically granted by EFS-Web	PTO/SB/83 U.S. Patent and Trademark Office Department of Commerce	
Electronic Petition Request REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS			
Application Number	11368803		
Filing Date	06-Mar-2006		
First Named Inventor	Philippe Villers		
Art Unit	1617		
Examiner Name AUDREA BUCKLEY			
Attorney Docket Number	029534.0102PTUS		
Title  Flexible ultra-low permeability transport system and method			
	torney or agent for the above identified pater I associated with Customer Number:	nt application and 32042 ———————————————————————————————————	
The reason(s) for this request are	e those described in 37 CFR:		
10.40(b)(4)			
10.40(c)(5)			
Certifications			
I/We have given reasonable intend to withdraw from en	e notice to the client, prior to the expiration of the nployment	e response period, that the practitioner(s)	
I/We have delivered to the to which the client is entitle	client or a duly authorized representative of the ced	lient all papers and property (including funds)	
	nt of any responses that may be due and the time	frame within which the client must respond	
Change the correspondence addi properly made itself of record pui	ress and direct all future correspondence to the fires and to 37 CFR 3.71:	rst named inventor or assignee that has	
Name	GRAINPRO, INC.		
Address	200 BAKER AVENUE SUITE 309		
City	Concord		
State	MA	MA	
Postal Code	01742		

Country	US	
I am authorized to sign on behalf of myself and all withdrawing practitioners.		
Signature	/Scott A. Chambers/	
Name	Scott Chambers	
Registration Number	37573	



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Decision Date: February 13, 2012

In re Application of : DECISION ON REQUEST TO WITHDRAW AS

Philippe Villers ATTORNEY/AGENTOF RECORD

Application No: 11368803

Filed: 06-Mar-2006

Attorney Docket No: 029534.0102PTUS

This is an electronic decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed February 13, 2012

The request is **APPROVED.** 

The request was signed by Scott Chambers (registration no. 37573 ) on behalf of all attorneys/agents associated with Customer Number 32042 . All attorneys/agents associated with Cusotmer Number 32042 have been withdrawn.

Since there are no remaining attorneys of record, all future communications from the Office will be directed to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71, with correspondence address:

Name GRAINPRO, INC.

Name2

Address 1 200 BAKER AVENUE

Address 2 SUITE 309
City Concord

State MA
Postal Code 01742
Country US

As a reminder, requester is required to inform the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 of the electronically processed petition.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

Office of Petitions

. Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

SHEPPARD MULLIN RICHTER & HAMPTON, LLP 390 LYTTON AVENUE PALO ALTO, CA 94301

MAILED

MAR 21 2011

OFFICE OF PETITIONS

In re Application of

David GOULDEN, et al.

Application No. 11/368,858

Filed: March 6, 2006

Attorney Docket No. 4001-0003

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 7, 2011.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to **SHEPPARD MULLIN RICHTER & HAMPTON**, **LLP** has been revoked by the assignee of the patent application on February 8, 2011. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-7253.

/Monica A. Graves/ Petitions Examiner, Office of Petitions

CC: DAVIDSON BERQUIST JACKSON & GOWDEY, LLP ATTN: CLARIA/DR. BRIAN SIRITZKY, ESQ. 4300 WILSON BOULEVARD, 7<sup>TH</sup> FLOOR ARLINGTON, VA 22203

D C J., DET AUTO		PTO/SB/83 U.S. Patent and Trademark Office	
Doc Code: PET.AUTO Document Description: Petitio	n automatically granted by EFS-Web	Department of Commerce	
Electronic Petition Request	REQUEST FOR WITHDRAWAL AS ATTOR CORRESPONDENCE ADDRESS	REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS	
Application Number	11368858	11368858	
Filing Date	06-Mar-2006		
First Named Inventor	David Goulden	David Goulden	
Art Unit	2197		
Examiner Name	ERIKA KRETZMER		
Attorney Docket Number	4001-0003		
Title	Method for attributing and allocating revenue related to embedded software		
The reason(s) for this request an 10.40(b)(4)	d associated with Customer Number: re those described in 37 CFR:		
Certifications			
I/We have given reasonab intend to withdraw from e	le notice to the client, prior to the expiration of the mployment	ne response period, that the practitioner(s)	
I/We have delivered to the to which the client is entitl	e client or a duly authorized representative of the ed	client all papers and property (including funds)	
☑ I/We have notified the clie	ent of any responses that may be due and the time	e frame within which the client must respond	
	Iress and direct all future correspondence to: ed inventor or assignee that has properly made it tomer Number:	tself of record pursuant to 86636	
l am authorized to sign on behal	f of myself and all withdrawing practitioners.		
Signature	/Brian Siritzky/		
3	,		
Name	Brian Siritzky		



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Decision Date : December 1, 2011

In re Application of : DECISION ON REQUEST TO WITHDRAW AS

David Goulden ATTORNEY/AGENTOF RECORD

Application No: 11368858 Filed: 06-Mar-2006

Attorney Docket No: 4001-0003

This is an electronic decision on the Request to Withdraw as attorney or agent of record under 37 CFR§ 1.36(b), filed December 1, 2011

#### The request is **APPROVED**

The request was signed by Brian Siritzky (registration no. 37497 ) on behalf of all attorneys/agents associated with Customer Number 91944 have been withdrawn.

Since there are no remaining attorneys of record, all future communications from the Office will be directed to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71, with Customer number 86636

As a reminder, requester is required to inform the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 of the electronically processed petition.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

Office of Petitions

# SPE RESPONSE FOR CERTIFICATE OF CORRECTION

		Paper No.:3		
DATE	: September 24, 201	0		
TO SPE	OF : ART UNIT 2476			
SUBJEC	UBJECT: Request for Certificate of Correction on Patent No.: 7787462			
A respons	e is requested with respec	to the accompanying request for a certificate of correction.		
Certificat	•	urn with file, within 7 days to: h - ST (South Tower) 9A22 ) 305-8309		
read as sh	• • • • • • • • • • • • • • • • • • • •	ted, correcting Office and/or Applicant's errors, should the patent rection? No new matter should be introduced, nor should the scope or		
Thank Yo	ou For Your Assistance	Certificates of Correction Branch		
•	est for issuing the about ision on the appropriated box.  Approved	ve-identified correction(s) is hereby:  All changes apply.		
	Approved in Part	Specify below which changes do not apply.		
	Denied	State the reasons for denial below.		
Commen	ts:			
	•			
		·		
	·	/Avoz D. Choikh/		
		/Ayaz R. Sheikh/ Supervisory Patent Examiner, Art Unit 2476		

Approved  Approved in Part  Denied  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.	<del></del>
TO SPE OF : ART UNIT	No.:
SUBJECT Request for Certificate of Correction for Appl. No.:	
Please respond to this request for a certificate of correction within 7 days.  FOR IFW FILES:  Please review the requested changes/corrections as shown in the COCIN document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.  Please complete the response (see below) and forward the completed response to scanniusing document code COCX.  FOR PAPER FILES:  Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:  Certificates of Correction Branch (CofC) Randolph Square – 9D10-A Palm Location 7580  Ourginia Tolbert Certificates of Correction Branch 571-272-0460  Thank You For Your Assist  The request for issuing the above-identified correction(s) is hereby:  Note your decision on the appropriate box.  Approved Approved All changes apply.  Approved in Part Specify below which changes do not apply.  Denied  Comments:	787462
Please review the requested changes/corrections as shown in the COCIN document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.  Please complete the response (see below) and forward the completed response to scanniusing document code COCX.  FOR PAPER FILES:  Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:  Certificates of Correction Branch (CofC) Randolph Square – 9D10-A Palm Location 7580   Ourginia Tolbert Certificates of Correction Branch 571-272-0460  Thank You For Your Assist  The request for issuing the above-identified correction(s) is hereby:    Approved	
the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.  Please complete the response (see below) and forward the completed response to scanniusing document code COCX.  FOR PAPER FILES:  Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:  Certificates of Correction Branch (CofC) Randolph Square – 9D10-A Palm Location 7580  Overginia Tolbert Certificates of Correction Branch (571-272-0460  Thank You For Your Assist  The request for issuing the above-identified correction(s) is hereby:  Approved  All changes apply.  Approved in Part  Specify below which changes do not apply.  Denied  Comments:	
using document code COCX.  FOR PAPER FILES:  Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:  Certificates of Correction Branch (CofC) Randolph Square – 9D10-A Palm Location 7580   Overginia Tolbert Certificates of Correction Branch 571-272-0460  Thank You For Your Assist  The request for issuing the above-identified correction(s) is hereby:  Note your decision on the appropriate box.  Approved All changes apply.  Approved in Part Specify below which changes do not apply.  Denied  Comments:	t(s) in ope or
Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:  Certificates of Correction Branch (CofC) Randolph Square – 9D10-A Palm Location 7580   Oirginia Tolbert Certificates of Correction Branch 571-272-0460  Thank You For Your Assist  The request for issuing the above-identified correction(s) is hereby:  Note your decision on the appropriate box.  Approved All changes apply.  Approved in Part Specify below which changes do not apply.  Denied  Comments:  Comments:	scanning
correction. Please complete this form (see below) and forward it with the file to:  Certificates of Correction Branch (CofC) Randolph Square – 9D10-A Palm Location 7580   Ourginia Tolbert Certificates of Correction Branch 571-272-0460  Thank You For Your Assist  The request for issuing the above-identified correction(s) is hereby: Note your decision on the appropriate box.  Approved Approved All changes apply.  Approved in Part Specify below which changes do not apply.  Denied State the reasons for denial below.  Comments:	•
Certificates of Correction Branch (CofC) Randolph Square – 9D10-A Palm Location 7580   Oirginia Tolbert Certificates of Correction Branch 571-272-0460  Thank You For Your Assist  The request for issuing the above-identified correction(s) is hereby: Note your decision on the appropriate box.  Approved Approved Approved in Part Specify below which changes do not apply.  Denied  Comments:	te of
Certificates of Correction Branch  571-272-0460  Thank You For Your Assist  The request for issuing the above-identified correction(s) is hereby:  Note your decision on the appropriate box.  Approved All changes apply.  Approved in Part Specify below which changes do not apply.  Denied  Comments:  Comments:	•
Certificates of Correction Branch  571-272-0460  Thank You For Your Assist  The request for issuing the above-identified correction(s) is hereby:  Note your decision on the appropriate box.  Approved Approved Approved in Part Specify below which changes do not apply.  Denied  Comments:  Comments:	ert.
Thank You For Your Assist  The request for issuing the above-identified correction(s) is hereby:  Note your decision on the appropriate box.  Approved Approved Approved in Part Specify below which changes do not apply.  Denied State the reasons for denial below.  Comments:	<del></del>
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Comments:	
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U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

PTOL-306 (REV. 7/03)



PORTER, WRIGHT, MORRIS & ARTHUR LLP ATTN: INTELLECTUAL PROPERTY DEPARTMENT 28TH FLOOR 41 SOUTH HIGH STREET COLUMBUS OH 43215-6194

**MAILED**MAR 282011

**OFFICE OF PETITIONS** 

In re Application of Doug PARTUSCH

Application No. 11/369,110

Filed: March 06, 2006

Attorney Docket No. 4003502-159734

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 04, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, October 01, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on January 02, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of \$810.00, and (3) a proper statement of unintentional delay. Accordingly, the reply to the non-final Office action of October 01, 2009 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4231.

This application is being referred to Technology Center AU 3782 for appropriate action by the Examiner in the normal course of business on the reply received.

Michelle R. Eason Paralegal Specialist Office of Petitions



FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 FIFTH AVENUE 16<sup>TH</sup> FLOOR NEW YORK, NY 10001-7708

MAILED

AUG 13 2010

OFFICE OF PETITIONS

In re Application of

Hiroki Sato, et al.

Application No. 11/369, 155

Filed: March 6, 2006

Attorney Docket No. 061399/LH

**DECISION GRANTING PETITION** 

UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed August 12, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on July 14, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.\(^1\)

Telephone inquiries regarding this decision should be directed to undersigned at (571) 272-1642. All other inquiries regarding the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 2871 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/AMW
April M. Wise
Petitions Examiner
Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.





Paper No.

LARSON NEWMAN & ABEL, LLP 5914 WEST COURTYARD DRIVE SUITE 200 AUSTIN TX 78730

MAILED
FEB 2 2 2011
OFFICE OF PETITIONS

In re Application of

Weir et al.

255

:

:

:

DECISION

Application No. 11/369,255

ON APPLICATION FOR

Filed: March 7, 2006

PATENT TERM ADJUSTMENT

Atty Docket No. 1123-EE001-

CIP

ARING :

Title: METHOD OF PREPARING CERAMIC POWDERS USING CHELATE

PRECURSORS

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705," filed January 19, 2011. Applicant submits that the correct patent term adjustment to be indicated on the patent is six hundred and fifty-three (653)<sup>1</sup> days, not five hundred and thirty-seven (537) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED** as **PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for

 $<sup>^1</sup>$  On the first page of this petition, Applicant requests 653 days. 654 days is requested in the text of pages 2 and 3, as well as in the chart which appears on page 2. The number 654 appears to be a typographical error, since 571 examination delay + 116 over three-years delay - (1 + 31 + 2) applicant delay = 653, not 654.

continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, Applicant is advised that he may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, Applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.<sup>2</sup>

For example, if Applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then Applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.usplo.gov

WILSON, SONSINI, GOODRICH & ROSATI 650 PAGE MILL ROAD PALO ALTO CA 94304-1050

MAILED

APR 162012

OFFICE OF PETITIONS

In re Patent No. 7,872,050 Issue Date: January 18, 2011

Application No. 11/369,305

Filed: March 7, 2006 Attorney Docket No. **37892-701,201**  ON PETITION

This is a decision on the petition filed March 9, 2012, to waive the rules and accept the correction of the assignee on the front page of the above-identified patent.

The petition is dismissed.

Petitioner requests issuance of a certificate of correction to reflect the name of the assignee for the above-cited patent as "Ceptaris Therapeutics, Inc." 37 CFR 3.81(a) permits the patent to issue to the assignee, provided that, at the time the issue fee is paid, the name of an assignee is provided. 37 CFR 3.81(b) permits the patent to issue in the name of an assignee if the assignment was submitted after payment of the issue fee but *prior to issuance of a patent*. Patent and Trademark Office assignment records disclose that an assignment to Yaupon Therapeutics, Inc. from Al-Ghananeem, Abeer M., Ph.D. was recorded on August 27, 2008. The patent issued January 18, 2011. A document changing the name of the assignee from Yaupon Therapeutics, Inc. to "Ceptaris Therapeutics, Inc." was recorded on February 24, 2012—after the patent issued. Accordingly, since the document changing the name of the assignee was not submitted for recordation until after issuance of this patent, issuance of a certificate of correction would not be proper. See MPEP Section 307.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petitions

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

By FAX:

(571) 273-8300

Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222,

/Kenya A. McLaughlin/

Kenya A. McLaughlin Petitions Attorney Office of Petitions



SHEPPARD, MULLIN, RICHTER & HAMPTON LLP 390 LYTTON AVENUE PALO ALTO, CA 94301

MAILED

APR 07 2011

OFFICE OF PETITIONS

In re Application of

BENNETT, Dominic V. et al.

Application No. 11/369,334

Filed: March 07, 2006

Attorney Docket No. 4001-0004

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 15, 2011.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to Sheppard, Mullin, Richter & Hampton LLP has been revoked by the assignee of the patent application on February 08, 2011. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-4231.

Michelle R. Eason Paralegal Specialist

Office of Petitions

cc:

DAVIDSON BERQUIST JACKSON & GOWDEY, LLP ATTN: CLARIA/DR. BRIAN SIRITZKY, ESQ. 4300 WILSON BLVD., 7TH FLOOR ARLINGTON VA 22203

		PTO/SB/83
Doc Code: PET.AUTO Document Description: Petition	n automatically granted by EFS-Web	U.S. Patent and Trademark Office Department of Commerce
Electronic Petition Request	REQUEST FOR WITHDRAWAL AS ATTOR CORRESPONDENCE ADDRESS	NEY OR AGENT AND CHANGE OF
Application Number	11369334	
Filing Date	07-Mar-2006	
First Named Inventor	Dominic Bennett	
Art Unit	2426	
Examiner Name	KYU CHAE	
Attorney Docket Number	4001-0004	
Title	Method for quantifying the propensity to	o respond to an advertisement
the practitioners of record The reason(s) for this request ar 10.40(b)(4)	d associated with Customer Number: e those described in 37 CFR:	
Certifications		
I/We have given reasonabl intend to withdraw from er	e notice to the client, prior to the expiration of the application of the properties of the properties of the contract of the properties o	ne response period, that the practitioner(s)
I/We have delivered to the to which the client is entitle	client or a duly authorized representative of the ed	client all papers and property (including funds)
☑ I/We have notified the clie	nt of any responses that may be due and the tim	e frame within which the client must respond
	ress and direct all future correspondence to: ed inventor or assignee that has properly made it	traff of vacard pursuant to
		tself of record pursuant to 86636
37 CFR 3.71, associated with Cust		
37 CFR 3.71, associated with Cust	tomer Number:	
37 CFR 3.71, associated with Cust  I am authorized to sign on behalf	f of myself and all withdrawing practitioners.	



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Decision Date : December 1, 2011

In re Application of : DECISION ON REQUEST TO WITHDRAW AS

Dominic Bennett ATTORNEY/AGENTOF RECORD

Application No : 11369334 Filed : 07-Mar-2006

Attorney Docket No: 4001-0004

This is an electronic decision on the Request to Withdraw as attorney or agent of record under 37 CFR§ 1.36(b), filed December 1, 2011

#### The request is **APPROVED**

The request was signed by Brian Siritzky (registration no. 37497 ) on behalf of all attorneys/agents associated with Customer Number 91944 have been withdrawn.

Since there are no remaining attorneys of record, all future communications from the Office will be directed to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71, with Customer number 86636

As a reminder, requester is required to inform the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 of the electronically processed petition.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
OCT 03 2011

Commissioner for Patents
P.O. Box 1450
Www.uspto.gov

## OFFICE OF PETITIONS

MANUEL F. DE LA CERRA 6885 CATAMARAN DRIVE CARLSBAD, CA 92011

In re Patent No. 7,355,422

Issue Date: April 8, 2006

Application No. 11/369,343 : NOTICE

Filed: March 6, 2006

Attorney Docket No. TSTECH-01

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-1642.

/AMW/ April M. Wise Petitions Examiner Office of Petitions



3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL MN 55133-3427

MAILED

OCT 1 5 2010

OFFICE OF PETITIONS

In re Application of

John S. Huizinga et al

Application No. 11/369,372 Filed: March 6, 2006

Attorney Docket No. 60534US003

**DECISION ON PETITION** 

UNDER 37 CFR 1.313(c)

This is a decision on the petition under 37 CFR 1.313(c), filed October 13, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on October 4, 2010, cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.\(^1\)

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 1741 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

/Karen Creasy/ Karen Creasy Petitions Examiner Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.

	Paper No.:
DATE :04/01/11	-
<b>TO SPE OF</b> : ART UNIT	
<b>SUBJECT</b> : Request for Certificate of	f Correction for Appl. No.: <u>11369414</u> Patent No.: <u>7875062</u>
	CofC mailroom date: 03/25/11
Please respond to this request for	r a certificate of correction within 7 days.
FOR IFW FILES:	
	nges/corrections as shown in the <b>COCIN</b> document(s) in ew matter should be introduced, nor should the scope or d.
Please complete the response (se using document code <b>COCX</b> .	ee below) and forward the completed response to scanning
FOR PAPER FILES:	
	nges/corrections as shown in the attached certificate of form (see below) and forward it with the file to:
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Manager of the the state of the	
Property of the the second	
	Lamonte Newsome
Thank You For Your Assistance	Certificates of Correction Branch 571-272-3421
Thank You For Your Assistance The request for issuing the abo	<u>Lamonte Newsome</u> Certificates of Correction Branch 571-272-3421
Thank You For Your Assistance	Certificates of Correction Branch 571-272-3421
Thank You For Your Assistance The request for issuing the abo Note your decision on the appropriate box.	Certificates of Correction Branch 571-272-3421  ve-identified correction(s) is hereby:
Thank You For Your Assistance The request for issuing the abo Note your decision on the appropriate box.  x Approved	Certificates of Correction Branch 571-272-3421  ve-identified correction(s) is hereby:  All changes apply.
Thank You For Your Assistance The request for issuing the abo Note your decision on the appropriate box.  x Approved  Approved in Part	Certificates of Correction Branch 571-272-3421  ve-identified correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.
Thank You For Your Assistance The request for issuing the aboom Note your decision on the appropriate box.  x Approved  Approved in Part  Denied	Certificates of Correction Branch 571-272-3421  ve-identified correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.

PTOL-306 (REV. 7/03)



COLGATE-PALMOLIVE COMPANY 909 RIVER ROAD PISCATAWAY NJ 08855

MAILED

DEC 132011

OFFICE OF PETITIONS

In re Application of

**SUBRAMANYAM** 

Application No. 11/369,430

ON PETITION

Filed: March 7, 2006

Attorney Docket No. 7164-01

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 11, 2011.

## The petition is **DISMISSED**.

The record shows that a Decision by the Board of Patent Appeals and Interferences was mailed on March 27, 2010, which set a two (2) month shortened statutory period for reply. Accordingly, a reply was due on or before March 27, 2010. The application became abandoned on May 28, 2010. A Notice of Abandonment was mailed July 2, 2010.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item(s) (1).

With respect to item (1): The reply filed with the petition dated October 11, 2011, does not properly respond to the Office action mailed on March 27, 2010. A proper response to a Decision by the Board of Patent Appeals and Interferences is a Continuation under 37 CFR 1.53(b) or a Request for Continued Examination (RCE). Since the required reply has not been submitted, the petition cannot be granted.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted.

The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

Mail Stop PETITION

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

By hand:

U. S. Patent and Trademark Office

Customer Service Window, Mail Stop Petitions

Randolph Building 401 Dulany Street Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Inquiries concerning this decision may be directed to the undersigned at (571) 272-6735.

/Diane Goodwyn/
Diane Goodwyn
Petitions Examiner
Office of Petitions



COLGATE-PALMOLIVE COMPANY 909 RIVER ROAD PISCATAWAY NJ 08855

MAILED

APR 0 2 2012

OFFICE OF PETITIONS

In re Application of

**SUBRAMANYAM** 

Application No. 11/369,430

Filed: March 7, 2006

Attorney Docket No. 7164-01

ON PETITION

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed February 6, 2012.

## The petition is **GRANTED**.

The record shows that a Decision by the Board was mailed on March 27, 2010, which set a two (2) month shortened statutory period for reply. Accordingly, a reply was due on or before March 27, 2010. The application became abandoned on May 28, 2010. A Notice of Abandonment was mailed July 2, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of \$930, (2) the petition fee of \$1860; and (3) the required statement of unintentional delay.

Petitioner has not filed the submission required by 37 CFR 1.114, however, petitioner has requested that the Office consider the Request for Clarification previously submitted on January 20, 2011. The petition appears to be a bona fide attempt to provide a complete reply. After revival of the application, the examiner may, upon a more detailed review, determine that the reply is lacking in some respect. In this event, the examiner should send out a letter advising petitioner of the omission or correction needed and a period for a reply should be given.

Inquiries concerning this decision may be directed to the undersigned at (571) 272-6735.

All other inquiries should be directed to the Technology Center at (571) 272-1600.

This application is being referred to Technology Center AU 1612 for further action as the nature of the case may require.

/Diane Goodwyn/
Diane Goodwyn
Petitions Examiner
Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

BAKER BOTTS LLP 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980

MAILED

NOV 23 2011

OFFICE OF PETITIONS

In re Application of

Albert V. SMITH, JR., et al.

Application No. 11/369,564 :

Filed: March 7, 2006

Attorney Docket No. 064731.0561

**DECISION ON PETITION** 

This is in response to the petition under 37 CFR 1.59(b), filed August 27, 2009, to expunge information submitted under MPEP 724.05(II).

The petition is **DISMISSED**.

Petitioner asserts that the Information Disclosure Statement and Form PTO 1449 filed on August 5, 2009 were erroneously filed by the attorneys of Smith et al. The Information Disclosure Statement and form PTO 1449 do not pertain to the instant application.

A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

- (A) the Office can effect such return prior to the issuance of any patent on the application in issue;
- (B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;
- (C) the information has not otherwise been made public;
- (D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
- (E) it is established to the satisfaction of the Director that the information to be returned is not material information under 37 CFR 1.56; and
- (F) the petition fee as set forth in 37 CFR 1.17(g) is included.

The instant petition fails to comply with item (B), (C), and (D) above.

For the reasons given above, the petition under 37 CFR 1.59 to expunge the Information Disclosure Statement and Form PTO 1449 filed on August 5, 2009, is dismissed.

Telephone inquiries regarding this decision should be directed to Joanne Hama at (571) 272-2911 or in her absence, the undersigned, at (571) 272-7099.

The application file is being referred to Technology Center AU 2475 for further processing

Petitions Examiner
Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

ERIC K. PETERSON EQUILIBRIO 470 THIRD STREET SUITE 212 SAN FRANCISCO, CA 94107

MAILED NOV 0 4 2010

**OFFICE OF PETITIONS** 

In re Application of

Eric K. Peterson

Application No. 11/369,570

Filed: March 6, 2006

Attorney Docket No. 317.1001.01

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 13, 2010, to revive the above-identified application.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. In accordance with 37 CFR 1.34(a), the signature appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts. However, if petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted.

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must so notify the Office.

The application became abandoned for failure to reply in a timely manner to the Notice of Non-compliant Amendment (Notice), mailed August 17, 2009, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under

the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on September 18, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of \$810, and (3) an adequate statement of unintentional delay.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is not a correct reading of the statement appearing in the petition.

In view of the above, the petition is **GRANTED**.

It is noted that there is a pending request to change of correspondence address to the address filed September 13, 2010 concurrently with this petition. Since there is, no indication that the person signing the request was ever given a power of attorney to prosecute the application, the request is unable to be processed at the present time. If the person signing the request desires to receive future correspondence regarding this application, the appropriate power of attorney documents must be submitted. While a courtesy copy of this decision is being mailed to the person signing the request all future correspondence will be directed to the address currently of record until appropriate instructions are received. Upon further review, it is also noted that the changed of address filed with the petition has been accepted in error. The request has been VACATED until a proper power of attorney has been filed.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 3769 for appropriate action by the Examiner in the normal course of business on the reply received May 7, 2010.

Retitions Examiner

Office of Petitions

Cc: DANE C. BUTZER

THE SWERNOFSKY LAW GROUP

PO BOX 390711

MOUNTAIN VIEW, CA 94039-0013



HOWARD & HOWARD ATTORNEYS PLLC 450 West Fourth Street Royal Oak MI 48067

MAILED

OCT 06 2011

In re Patent No. 8,031,227 : OFFICE OF PETITIONS

Issue Date: October 4, 2011

Application No. 11/369,572 : NOTICE

Filed: March 7, 2006

Attorney Docket No. 100,295-015 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed September 20, 2011. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby accepted. The petition is **GRANTED**.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

This file is being forwarded to Files Repository.

Telephone inquiries related to this decision should be directed to the Kimberly Inabinet at (571) 272-4618.

/Kimberly Inabinet/ Kimberly Inabinet Petitions Examiner Office of Petitions



C. JAMES BUSHMAN 5851 San Felipe SUITE 975 HOUSTON TX 77057 MAILED APR 08 2011

OFFICE OF PETITIONS

In re Application of

Richard D. HAVINGA

Application No. 11/369,634

Filed: March 07, 2006

Attorney Docket No. Xtreme-25

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 17, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, March 22, 2010, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on June 23, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of \$1620, and (3) an adequate statement of unintentional delay. Accordingly, the reply to the non-final Office action of March 22, 2010 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at (571)272-2783.

This application is being referred to Technology Center AU 3676 for appropriate action on the concurrently filed amendment.

Ramesh Krishnamurthy Petitions Examiner

Office of Petitions



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

	APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
_	11/369,660	03/06/2006	John N. Gross	JNG2004-21C	8886
	52447 PATENTBEST	7590 08/19/20	1	EXAM	INER
	4600 ADELIN	E ST., #101		RUHL, DENN	IIS WILLIAM
	EMERYVILLI	E, CA 94608		ART UNIT	PAPER NUMBER
				3689	
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	2			MAIL DATE	DELIVERY MODE
			· · ·	08/19/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



MIG 1 8 2011

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

J. Nicholas Gross Law Office of J. Nicholas Gross, P.C. Post Office Box 9489 Berkeley, California 94704

In re Application of J. Nicholas Gross

Appl. No.: 11/369,660

Filed: March 6, 2006

For: Method of Processing Rental Requests and

Returns

DECISION ON PETITION

UNDER 37 CFR 1.181

This is a decision on the petition filed October 8, 2010 under 37 CFR 1.181 requesting the Office action mailed on August 11, 2010 be vacated and another Office action issued to carry into effect a Board of Patent Appeals and Interference (the Board) decision dated April 9, 2010. There is no fee required for this petition.

### The petition is **DISMISSED**.

At the onset, applicant should note that in the absence of an express statement, a remark by the Board that a rejection of a particular claim is reversed is not to be taken as a statement that such claim may be allowed.

After a careful review of the above file history, it is noted that an appeal brief was filed on March 7, 2008 with a supplemental brief filed on April 16, 2008. An examiner's answer to the appeal brief was mailed on July 9, 2008. Applicant filed a reply brief on September 9, 2008. On April 9, 2010, the Board rendered a decision that affirmed-in-part the examiner's final rejection mailed on September 19, 2007 and entered a new ground of rejection pursuant to 37 C.F.R. 41.50(b) under 35 U.S.C. Section 101. The Board decision is as follows:

The decision of the Examiner to reject claims 1, 2, 4, 5, and 7 is affirmed and we designate our decision as a new ground of rejection.

The decision of the Examiner to reject claims 3, 6, and 8-20 under 35 U.S.C. § 103(a) is reversed.

We also add a new ground of rejection to claims 1-20 under 35 U.S.C. 101.

In response, the applicant submitted on June 7, 2010 an amendment and a request to reopen prosecution under 37 C.F.R. 41.50(b).

Responsive to the applicant's request to reopen prosecution and the accompanying amendments, the examiner issued a non-final Office action on August 11, 2010.

On October 8, 2010, applicant filed this petition under 37 CFR § 1.181 requesting that the Office action dated August 11, 2010 be vacated and a new action issued to rectify the following errors:

The failure of the Office Action to comply with 37 C.F.R. § 41.54 requiring the Examiner to carry into effect the decision of the Board of Appeals;

The failure of the Office Action to comply with, MPEP §704.01, [sic] §707(g) and other relevant case law authority requiring that the Examiner give deference to the prior Examiner's determinations;

The inclusion in the Office Action of rejections that were waived and not raised in the prior appeal proceedings associated with the Application.

## 37 CFR § 41.54 regarding action following decision states that:

After decision by the Board, the proceeding will be returned to the examiner, subject to appellant's right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the proceeding may require, to carry into effect the decision.

MPEP § 1213.02 entitled "New Grounds of Rejection by Board" sets forth rule 37 CFR § 41.50 regarding "Decisions and other actions by the Board" as follows:

- (b) Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:
- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or

overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

MPEP§ 1213.01 entitled "Statement by Board of How an Appealed Claim May Be Amended To Overcome a Specific Rejection" states that:

If the Board's decision includes an explicit statement on how a claim on appeal may be amended to overcome a specific rejection, appellant may amend the claim in conformity with the statement.

A review of the prosecution history reveals that the Board's decision of April 09, 2010 set forth a new grounds of rejection to claims 1, 2, 4, 5 and 7 under 35 USC 103(a), and a new grounds of rejection to claims 1-20 under 35 USC 101. With respect to claim 3, it was stated on page 13 in the Board's decision that "[t] he examiner has not supplied any explanation of how a description requiring a customer to return a new release movie the day after renting, in column 1, lines 12-29 of Hastings teaches the step of imposing a delay in delivering a movie". The reason for the reversal of the previous rejection of claim 3 appears to be a lack of sufficient explanation such that it was not clear how the Hastings reference taught the claimed invention. As indicated at the beginning of the decision, a reversal by the Board does not mean that claim 3 is allowable; it only means that the Board found the rejection of claim 3 using the combination of prior art Hastings in view of Matsushima improper.

A review of the amendment submitted on June 7, 2010 in the request to reopen prosecution following the Board's decision indicated that claim 1 was cancelled, claims 3 and 6 were rewritten into independent form, claim 2 was amended to depend on claim 3, claim 4 was amended to depend on claim 6, claim 5 was cancelled. And claim 7 was amended to depend on claim 3. Claims 3, 6, 8, 11, and 15-17 were amended to include the phrase "with a computing system".

The phrase "with a computing system" was added to overcome the new ground of rejection under 35 USC § 101. However, this added claim language also raises new issue since it was not previously of record, and therefore, renders moot the binding requirement of the Board's new grounds of rejection as stated in MPEP § 1213.02 and 37 CFR § 41.50 cited above. Similarly, by changing the dependency of claims 2, and 7 such that claims 2 and 7 now include the language "wherein said first delay is imposed for a group of machine readable media items which are high demand items determined by the computing system" which is a new issue since it was not of record for claims 2 and 7 at the time of appeal, the amendment of June 7, 2010 renders moot the binding requirement of the Board's new grounds of rejection in accordance to MPEP § 1213.02 and 37 CFR § 41.50. For the same reason, by amending claim 4 such that it now includes the language "(d) measuring a number of titles out for said subscriber relative to Nmax over a predetermined period with the computing system; (e) adjusting said first delay with the computing system based on results of step (d)." a new issue which was not of record for claim 4 at the time of appeal, the amendment of June 7, 2010 renders moot the binding requirement of the Board's new grounds of rejection in accordance to MPEP § 1213.02 and 37 CFR § 41.50.

Absence an express statement in the Board's decision that claims 3, 6, 8 and 15 are allowed, applicant's comment on page 11 of the petition that the Board deemed claims 3, 6, 8 and 15

patentable is inaccurate. Moreover, in the absence of an express statement by the Board on how the claims on appeal may be amended to overcome the new grounds of rejection, in changing the dependency of claims 2, 4 and 7 the amendment of June 7, 2010 does not place claims 2, 4 and 7 in condition for allowance. Note MPEP § 1213.01 cited above. Instead, the June 7, 2010 amendment raises new issues that would require further consideration and search.

Furthermore, since there is nothing in the Board's decision that remotely suggested adding new claims to overcome the new grounds of rejection, the addition of new claims 21-29 in the amendment of June 7, 2010 that includes new features such as "said first delay is at least one day" in claims 22 and 29, "delivering an additional media item without a surcharge after a second delay..." in claim 23, "said additional media item is determined by the computing system to be a low demand item" in claim 24, "said additional media item is determined by the computing system to be a promotional item" in claim 25, "said additional media item is determined by the computing system to be desired by said first subscriber" in claim 26, "said first delay is imposed only on profit sharing items" in claim 27, and "said first delay is imposed only high demand items determined by the computing system" in claim 28 are new issues, which were not previously presented and would require further consideration and search. The June 7, 2010 amendment does not provide any explanation on why adding new claims 21-29 is necessary post-appeal; how the new claims 21-29 address the new 35 USC 101 rejection of claims 1-20 or the new 103 (a) rejection of claims 1, 2, 4, 5 and 7 raised by the Board; and how the new claims 21-29 help carry into effects the Board's decision. The new issues in the amended claims and new claims 21-29 are evidence that applicant does not seek to carry into effect the Board's decision, but instead chooses to extend the examination in a new direction.

For the foregoing reasons, the examiner's action in the non-final Office action of August 11, 2010 is considered proper in response to the June 7, 2010 amendment to reopen prosecution. Applicant's request that the examiner to comply with 37 C.F.R. § 41.54 to carry into effects the decision of the Board is dismissed as moot.

With respect to the 112 written description rejection of claims 15-20 and the 112 indefiniteness of claims 2-4, 6 and 7 made in the August 11, 2010 Office action, applicant argues in item 17 on page 6 of the petition that "In no part of the BPAI decision did they ever raise or even suggest that there was anything vague or indefinite about the claim limitations they were reviewing, let alone issue a new and spontaneous 112 rejection. As can be seen in pages 13-16 of the opinion, they has no difficulty understanding the scope of the language presented, nor did they find that any part of the claim was not adequately supported by the specification." Applicant also argues in items 32-35, 38, and 42 of the petition that "the 112 rejections are both improper and violate MPEP § 704.01 and § 707.07, and 37 CFR § 41.54." It is noted that the rejections set forth in the August 11, 2010 Office action are responsive to applicant's request to reopen prosecution and amendment of June 7, 2010. Since applicant's questions on the 112 rejections relate to the merits, then the appeal process has long been provided by statute. The MPEP clearly states under 37 CFR 1.191(a) that an applicant for a patent dissatisfied with the primary examiner's decision in the second or final rejection of his or her claims may appeal to the Board for review of the examiner's rejection. Thus, the 112 rejections of the claims by the examiner in the August 11, 2010 Office action is a matter appealable to the Board and will not be addressed in this decision.

Applicant argues in items 21-22, and 47-50 of the petition regarding the obviousness rejection of claim 3 that the examiner ignored the Board's analysis which found claim 3 to be allowable. Applicant also argues the obviousness rejection of claims 6, 8 and 15 in items 25-28, 43-46, and 51-56 of the petition that the examiner unilaterally reject the Board's findings that these claims are patentable. Again, absence an express statement in the Board's decision that claims 3, 6, 8 and 15 are allowable, applicant's comment regarding the allowability of claims 3, 6, 8 and 15 is inaccurate. A reversal by the Board on the rejections of claims 3, 6, 8 and 15 does not mean that these claims are allowable; it only means that the Board found the rejections of these claims using the combination of prior art Hastings in view of Matsushima improper. Furthermore, where differences of opinion concern the denial of patent claims because of prior art, and the questions thereby raised relate to the merits, then the appeal process has long been provided by statute. The MPEP clearly states under 37 CFR 1.191(a) that an applicant for a patent dissatisfied with the primary examiner's decision in the second or final rejection of his or her claims may appeal to the Board for review of the examiner's rejection. Thus, the obviousness rejection of claims 3, 6, 8 and 16 by the examiner in the August 11, 2010 Office action is a matter appealable to the Board and not petitionable.

Applicant argues that the current examiner failed to give full faith and credit to the action of the previous examiner as specified in MPEP § 704.01 in making 112 written description and indefiniteness rejections, and new prior art rejections of the claims. In view of the facts that applicant requested to reopen prosecution, and submitted the June 7, 2010 amendment to substantially change the scope of the appealed claims 1-4, 6-20 and adding new claims 21-29, the current examiner is not obligated to give the previous examiner's action/search full faith and credit when the claims have been amended, he has knowledge of other prior art – the NPL references on Netflix, and he is required to provide the new issues/new limitations in the pending claims further consideration and search. There was no new prior art since the structure/operation of the Netflix system, which is pertinent to the invention, has been discussed in the Background of the present disclosure, and said NPL references on Netflix were already in the record. Contrary to applicant's arguments, it is quite reasonable for the current examiner to apply the NPL references on Netflix on the pending claims -- said NPL references on Netflix qualified as the current examiner's "knowledge of other prior art", and their application in the August 11, 2010 Office action meets the guideline set forth in MPEP § 704.01.

MPEP 904 states that "The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first reply, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search."

In response to applicant's argument that the current examiner conducted new search in the mere hope of finding something, it is worth pointing out that pertinent information concerning the claimed invention were already in the record -- the structure/operation of the Netflix system is pertinent to the invention as discussed in the Background of the present disclosure, and the Wired article and the NPL article "An analysis of Netflix's DVD allocation system" were cited in the IDS submitted on May 12, 2006, and made of record. The current examiner complies with the examining practice set forth in MPEP § 904 cited above in performing an update search

necessitated by applicant's submission of an amendment that changes the scope of the claims. Applicant violates MPEP § 904 in arguing that the current examiner should not update the search in response to an amendment or provide amended claims and new claims that raise new issues further consideration and search, and that said NPL references on Netflix or other prior art of record are not available for the new examiner's consideration. Even if they are new prior art and not of record, an update search and further consideration of said NPL references on Netflix are absolutely within the current examiner's purview in response to applicant's request to reopen prosecution, amendment to the appealed claims and addition of new claims that require further consideration and search as dictated by MPEP § 904.

In response to applicant's allegation that the current examiner is engaging in piecemeal prosecution and violated MPEP § 707.07, a review of the file indicates that the current examiner rejected the claims on all valid grounds using prior art of record, and has examined the claims with respect to all relevant regulations and statutes. All major issues falling under 35 USC §101, 112, 102, 103, etc., have been considered and addressed by the examiner in the August 11, 2010 Office action and, thus, is not considered to be piecemeal examination.

Therefore, applicant's arguments that the new prior art rejections are improper for violating MPEP § 704.01 and § 707.07, and 37 CFR § 41.54 are not persuasive. For the foregoing reasons, applicant's request to vacate the Office action mailed on August 11, 2010 and the issuance of a new Office action is dismissed. The Office action mailed on August 11, 2010 is proper and hereby maintained.

Any questions regarding this decision should be directed to Quality Assurance Specialist Lanna Mai at 571-272-6867.

Wynn Coggins, Difector

Patent Technology Center 3600

571-272-5350

lm: 8/15/11

M



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.usplo.gov

CALFEE, HALTER & GRISWOLD LLP THE CALFEE BUILDING 1405 EAST SIXTH STREET CLEVELAND, OH 44114-1607 MAILED

JAN 2 5 2012

OFFICE OF PETITIONS

In re Application of

Scott H. Miller, et al.

Application No. 11/369,662

Filed: March 6, 2006

Attorney Docket No. 34656/04064

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 13, 2011, to revive the above-identified application.

This application became abandoned for failure to timely submit corrected formal drawings on or before November 9, 2011, as required by the Notice to File Corrected Application Papers, mailed September 9, 2011. Accordingly, the date of abandonment of this application is November 10, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the corrected formal drawings, (2) the petition fee of \$1860; and (3) a proper statement of unintentional delay.

The drawings have been approved by the USPTO draftsperson.

In view of the above, the petition is GRANTED.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning this application should be directed to the Office of Data Management at their hotline 571-272-4200.

This application is being referred to the Office of Data Management for processing into a patent.

Petitions Examiner Office of Petitions

cc: RAYMOND N. RUSSELL 1400 KEYBANK CENTER 800 SUPERIOR AVENUE CLEVELAND, OH 44114



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.usplo.gov

LAW OFFICE OF ANDREW P. LAHSER, PLC 16824 E. Avenue of the Fountains Suite 14 FOUNTAIN HILLS AZ 85268

MAILED

APR 2 5 2011
OFFICE OF PETITIONS

In re Application of

Taun Eric Willis

Application No. 11/369,668

Filed: March 6, 2006

Attorney Docket No. 06-030

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 21, 2011, to revive the above-identified application.

### The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of May 19, 2010. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that prima facie places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is September 20, 2010. The Notice of Abandonment was mailed December 21, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of \$405, and the submission required by 37 CFR 1.114; (2) the petition fee of \$810; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-2991.

This application is being referred to Technology Center AU 2431 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

/Terri Johnson/ Terri Johnson Petitions Examiner Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

	JEL NESFONSE	TOR CENTIFICATE OF CONNECTION
		<b>Paper No</b> .:20110504
DATE	: April 04, 2011	
TO SPE C	OF: ART UNIT 2857	
SUBJECT	Γ : Request for Certificate of C	Correction on Patent No.: 11/369,746
A response	e is requested with respect to the ac	ecompanying request for a certificate of correction.
Certificat	mplete this form and return with es of Correction Branch - ST (stion 7590 - Tel. No. (703) 305-83	South Tower) 9A22
read as sh		ecting Office and/or Applicant's errors, should the patent No new matter should be introduced, nor should the scope or
Thank Yo	ou For Your Assistance	Certificates of Correction Branch
•	est for issuing the above-ident sion on the appropriated box.	tified correction(s) is hereby:
$\boxtimes$	Approved	All changes apply.
	Approved in Part	Specify below which changes do not apply.
	Denied	State the reasons for denial below.
Commen	ts:	
		/Andrew Schechter/ Supervisory Patent Examiner, Art Unit 2857

DATE 8/2/10	Paper No.:
TO SPE OF : ART UNIT 260	26
SUBJECT : Request for Certifical	te of Correction for Appl. No.: <u>///369936</u> Patent No.: <u>772990</u>
	for a certificate of correction within 7 days.
FOR IFW FILES:	's
Please review the requested cleaning of the claims be chan	hanges/corrections as shown in the <b>COCIN</b> document(s) in new matter should be introduced, nor should the scope or ged.
Please complete the response using document code COCX.	(see below) and forward the completed response to scanning
FOR PAPER FILES:	
Please review the requested characteristic correction. Please complete the	nanges/corrections as shown in the attached certificate of is form (see below) and forward it with the file to:
Cartificator of Correcti	on Branch (CofC)
Certificates of Correcti Randolph Square – 9D Palm Location 7580	10-A
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Randolph Square – 9D Palm Location 7580  The request for issuing the a Note your decision on the appropriate box.  Approved	Overginia Tolbert  Certificates of Correction Branch  571-272-0460  Thank You For Your Assistant bove-identified correction(s) is hereby:  All changes apply.
Randolph Square – 9D Palm Location 7580  The request for issuing the all Note your decision on the appropriate box.  Approved  Approved in Part  Denied  Comments: The Bibliographic Data Sinventorship after deletion	Oirginia Tolbert  Certificates of Correction Branch  571-272-0460  Thank You For Your Assistant  bove-identified correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.  heet prepared by the Examiner on 04 February 2010 correctly lists the nof Jean-Claude Junqua consistent with the approval of the correction ce Action mailed 11 September 2009. The Bibliographic Data Sheet

Martin Lerner, Examiner

DATE	8/2/10	Paper No.:
	UNIT <u>2626</u>	•
SUBJECT : Requ	lest for Certificate of Correcti	ion for Appl. No.: <u>///369936</u> Patent No.: <u>772990</u>
		ificate of correction within 7 days.
FOR IFW FILES:		's
Please review the the IFW application meaning of the cla	n image. No new matt	errections as shown in the <b>COCIN</b> document(s) in ter should be introduced, nor should the scope or
Please complete the using document co	he response (see belo ode COCX.	w) and forward the completed response to scanning
FOR PAPER FILE	<u>'S</u> :	
Please review the	requested changes/co complete this form (se	errections as shown in the attached certificate of ee below) and forward it with the file to:
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Martin Lerner, Examiner

	SPE RESP			
	8/2/10			Paper No.:
DATE :_	2/2			
	RT UNIT 262	<u>6</u>		219321
			•	369936 Patent No.: 772990
	to this request f	for a certificate	of correction	n within 7 days.
OR IFW FILES	<u>:</u> :			
the IFW applicat	ie requested cha tion image. No i claims be chang	new matter sho	ons as show ould be intro	n in the COCIN document(s) in duced, nor should the scope or
Please complete using document	e the response ( code COCX.	(see below) and	d forward the	e completed response to scanning
FOR PAPER FI	<u>_ES</u> :			
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/David R. Hudspeth/ SPE AU 2626



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/370,007	03/06/2006	James M. Reuter	200506356-1 9665	
22879 HEWLETT D	7590 11/04/2010 ACKARD COMPANY		EXAM	INER
Intellectual Pro	operty Administration		VO, TRU	ONG V
3404 E. Harmo Mail Stop 35	ony Road		ART UNIT	PAPER NUMBER
	NS, CO 80528		2156	
			NOTIFICATION DATE	DELIVERY MODE
			11/04/2010	ELECTRONIC

# Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM ipa.mail@hp.com laura.m.clark@hp.com



COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Robert W. Bergstrom Hewlett-Packard Company Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 Fort Collins, CO 80528

In re Application of: James M. REUTER et al. Application No. 11/370,007 Filed: March 06, 2006

For: DATA-STATE-DESCRIBING DATA

**STRUCTURES** 

DECISION ON PETITION UNDER 37 C.F.R. § 1.181

This is a decision on the petition, filed on 24 June 2010, under 37 CFR § 1.181 to review the Examiner's objection to claims 2-13, 15-17, 19-26, 28-30 and 32-37.

## The petition is **GRANTED**.

A review of claims 2-13, 15-17, 19-26, 28-30 and 32-37 indicates that the insertion of a comma "," at the end of line 1 in these claims is not needed and should not be required by the examiner. The examiner should consider each of these claims as one full paragraph; thus, does not require such a comma ",".

Accordingly, the petition is **GRANTED.** The examiner's objection to claims 2-13, 15-17, 19-26, 28-30 and 32-37 is hereby withdrawn and vacated.

It is noted that an Appeal Brief was filed on 17 June 2010. The application has been forwarded to the Board of Patent Appeal and Interference to review and process the Appeal Brief of 17 June 2010; from there, the application will be forwarded to the Examiner of record to consider this Appeal Brief.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3613.

/Vincent N. Trans/
Vincent N. Trans, SPRE/QAS
Technology Center 2100
Computer Architecture and Software



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

LYON & HARR, LLP 300 ESPLANADE DRIVE SUITE 800 OXNARD, CA 93036

**MAILED** 

AUG 2 7 2010

**OFFICE OF PETITIONS** 

In re Application of

Gary M. Schein

Application No. 11/370,134

Filed: March 6, 2006

Attorney Docket No. IAE-005-06

DECISION ON PETITION
TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 8, 2010.

The request is **NOT APPROVED**.

The Office strongly encourages practitioner(s) requesting withdrawal from representation as practitioner of record in an application to review the record to determine whether he or she is, in fact, of record and how he or she was made of record. For example, the practitioner(s) should determine whether he or she was appointed by naming each practitioner individually or through the use of a Customer Number.

In the instant application, the practitioner(s) were appointed via Registration Number however the request does not indicate a Registration Number. In view of the above, practitioners must withdraw as attorney of record in the same manner as appointed; therefore current request cannot be approved. Any subsequent request must withdraw all associated practitioner(s) in the same manner as appointed.

All future communications from the Office will continue to be directed to the above-listed address until properly notified.

There is an outstanding Office action mailed June 18, 2010, that requires a reply.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-6059.

Alicia Kelley Petitions Examiner

Office of Petitions





Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

MAILED

OCT 2 8 2010

LYON & HARR, LLP 300 ESPLANADE DRIVE SUITE 800 OXNARD, CA 93036

OFFICE OF PETITIONS

In re Application of Gary M. Schein Application No. 11/370,134 Filed: March 6, 2006 Attorney Docket No. IAE-005-06

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 20, 2010.

The request is APPROVED.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office will require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, which the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any replies that may be due and the time frame within which the client must respond, pursuant to 37 CFR 10.40 (c).

The request was signed by Richard T. Lyon, on behalf of all the practitioners of record.

All of the practitioners have been withdrawn from record. Applicant is reminded that there is no attorney of record at this time.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

There is an outstanding Office action mailed June 18, 2010 that requires a reply from the applicant.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-6059. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Alicia Kelley Petitions Examiner Office of Petitions

cc: GARY M. SCHEIN 355 N. LANTANA #784 CAMARILLO, CA 93010



49744

SUITE 800

## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NUMBER

LYON & HARR, LLP 300 ESPLANADE DRIVE

**OXNARD, CA 93036** 

FILING OR 371(C) DATE

FIRST NAMED APPLICANT

ATTY. DOCKET NO./TITLE

11/370,134

03/06/2006

Gary M. Schein

IAE-005-06

**CONFIRMATION NO. 1288 POWER OF ATTORNEY NOTICE** 

Date Mailed: 10/28/2010

### **NOTICE REGARDING CHANGE OF POWER OF ATTORNEY**

This is in response to the Power of Attorney filed 09/20/2010.

• The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

	/atkelley/								
				<del> </del>					
Office of Data	Management,	Application	Assistance (	Unit (571)	272-4000,	or (571)	272-4200,	or 1-888	-786-010 <sup>-</sup>



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.usplo.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.			
11/370,400	03/07/2006	Jeff Doering	81136900	1579			
36865	ALLEMAN HALL MCCOY RUSSELL & TUTTLE, LLP 806 S.W. BROADWAY, SUITE 600			EXAMINER			
806 S.W. BRC				AMIN, BHAVESH V			
PORTLAND,	OR 97205		ART UNIT	PAPER NUMBER			
			3664				
			MAIL DATE	DELIVERY MODE			
			09/20/2010	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



SEP 2 0 2010

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

ALLEMAN HALL MCCOY RUSSELL & TUTTLE LLP 806 S.W. Broadway, Suite 600 Portland, Oregon 97205

In re Application of: Jeff Doering et al.

Application No. 11/370,400

Filed: March 07, 2006

For: SYSTEM AND METHOD FOR

IMPROVED VEHICLE RESPONSE DURING VEHICLE ACCELERATION

**CONDITIONS** 

PETITION TO WITHDRAW

RESTRICTION REQUIREMENT

UNDER 37 C.F.R. 1.181

This is in response to applicant's petition filed on January 22, 2010 to request that the October 14, 2009 restriction requirement under 37 C.F.R. 1.144 be withdrawn.

The petition is **Denied** to the extent indicated below.

A review of the record reveals that the Office action mailed on October 14, 2009 set forth a Restriction Requirement among three groupings I, II, and III. Group I included claims 1 to 9. Group II included claims 10 to 15. Group III included claims 16 to 20.

- Group I and Group II were restricted under combination and subcombination.
- Group I and Group III were restricted under subcombination usable together in a single combination.
- Group II and Group III were restricted under subcombinations usable together in a single combination.

The applicant alleges that the requirement for restriction is improper because the Office has not properly followed restriction practice under MPEP § 803. According to MPEP § 803. I, there are two criteria for a proper requirement for restriction: "(A) The inventions must be independent or distinct as claimed; and (B) There would be a serious burden on the examiner if restriction were not required." And according to MPEP § 806.04 (f): Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. This may also be expressed by saying that to require restriction between claims limited to species; the claims must not overlap in scope.

The applicant went on to explain that since claims 1 and 10 each have the overlapping condition of "in response to a driver tip-out during at least some conditions, decreasing powertrain output so that positive torque is not transmitted to the wheels." Further, claims 1 and 10 have additional elements that are common. Therefore, there is at least some overlap in scope between claims 1 and 10, thereby rendering the requirement for restriction improper.

This argument is not persuasive since it is not germane to the standard of combination and subcombination restriction requirement. As indicated in the restriction requirement on January 22, 2010, and made final thereafter on December 30, 2009, claims 1 and 10 were restricted under combination and subcombination requirement. Per MPEP § 806.05(c), combination and subcombination relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require further increasing engine airflow while performing ignition timing more advanced than said first ignition timing to provide a torque output increase. The subcombination has separate utility such as control of the torque output without the use of spark angle advancement. In other words, claim 1 contains AB<sub>broad</sub> and claim 10 contains B<sub>specific</sub>. The broad recitation of "adjusting the engine airflow" within claim 1 is considered to be the B<sub>broad</sub>. The more narrow recitation of "Increasing engine airflow...to provide a torque output increase" is considered to be the B<sub>specific</sub> within claim 10. Hence, the restriction is proper per MPEP § 806.05(c).

Applicant further alleges that the rationales for restriction cited in the Office action of December 30, 2009 is inadequate and appears to misinterpret the definition of mutual exclusivity. Applicant asserts that "mutual exclusivity", as defined in MPEP § 806.04(f), requires that "one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first." Thus, applicant asserts that mutual exclusivity does not require restriction simply because invention II recites a condition to driver tip in that is not found in invention I. Mutual exclusivity requires no overlap in the claims. Since claims 1 and 10 recite similar elements, applicant argues that restriction should not be required as indicated in the Office action of October 14, 2009, as the Office has provided an inadequate and improper reason for maintaining the restriction. Consequently, applicant concludes that the requirement for restriction is improper and should be withdrawn.

These arguments are not persuasive because the restriction requirement for Group I and Group III, Group II and Group III were made per MPEP § 806.05(d) subcombinations usable together in a single combination, and not per MPEP § 806.04(f). The restriction requirement between group I and III, Group II and III are proper since the requirement has shown that "driver tip-out" in Groups I and II do not overlap in scope when compared to "drive tip-in" per Group III; and the subcombinations are separately usable. For example, subcombination III has separate utility such as modifying torque based on Tip- in only.

The Restriction Requirement indicated in October 14, 2009 is proper because all three inventions are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter:
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph

For the reasons indicated above, applicant's request for the withdrawal of the restriction requirement mailed on October 14, 2009 is hereby denied.

Any question regarding this decision should be directed to Supervisory Patent Examiner Khoi Tran at (571) 272-6919.

Katherine Matecki, Director Technology Center 3600

(571) 272 - 5250

kt/lm: 08/23/10

M/



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

FOX ROTHSCHILD LLP 997 LENOX DRIVE, BLDG. #3 LAWRENCEVILLE NJ 08648

MAILED

MAR 16 2011

OFFICE OF PETITIONS

In re Application of

Filed: March 7, 2006

William A. Hayday : Application No. 11/370,446 :

Attorney Docket No. P22,655-E USA

DECISION ON PETITION

TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 9, 2010.

The request is **NOT APPROVED**.

The Office strongly encourages practitioner(s) requesting withdrawal from representation as practitioner of record in an application to review the record to determine whether he or she is, in fact, of record and how he or she was made of record. For example, the practitioner(s) should determine whether he or she was appointed by naming each practitioner individually or through the use of a Customer Number.

In the instant application, the practitioner(s) were appointed power of attorney via Customer Number however the request does not designate a Customer Number to be withdrawn by. Therefore, the request cannot be approved at this time. Any subsequent request must withdraw all associated practitioner(s) in the same manner as appointed.

All future communications from the Office will continue to be directed to the above-listed address until properly notified.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-6059.

Alicia Kelley Petitions Examiner

Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FOX ROTHSCHILD LLP 997 LENOX DRIVE, BLDG. #3 LAWRENCEVILLE NJ 08648

MAILED
JAN 1 8 2012
OFFICE OF PETITIONS

In re Application of

William A. Hayday

Application No. 11/370,446

Filed: March 7, 2006

Attorney Docket No. P22,655-E USA

DECISION ON PETITION
TO WITHDRAW

FROM RECORD

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 5, 2012.

The request is **NOT APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others.

The request was signed by Peter J. Butch III on behalf of all attorneys of record, but does not include a Customer Number. Accordingly, since the practitioners were appointed by a Customer Number, the Request must reflect withdrawal of practitioners associated with the same Customer Number.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Currently, there is no outstanding Office action that requires a reply.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751. All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

/Joan Olszewski/ Joan Olszewski Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

# FOX ROTHSCHILD LLP 997 LENOX DRIVE, BLDG. #3 LAWRENCEVILLE NJ 08648

MAILED

JAN 2 7 2012

OFFICE OF PETITIONS

In re Application of

William A. Hayday

Application No. 11/370,446

Filed: March 7, 2006

Attorney Docket No. P22,655-E USA

DECISION ON PETITION TO WITHDRAW

FROM RECORD

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 23, 2012.

The request is **NOT APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others.

The request was signed by Peter J. Butch III on behalf of all attorneys of record, but reflects an incorrect Customer Number. Accordingly, since the practitioners were appointed by a Customer Number, the Request must reflect withdrawal of practitioners associated with the same Customer Number.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

/Joan Olszewski/ Joan Olszewski Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

FOX ROTHSCHILD LLP 997 LENOX DRIVE, BLDG. #3 LAWRENCEVILLE NJ 08648

MAILED FEB 1 0 2012

OFFICE OF PETITIONS

In re Application of William A. Hayday Application No. 11/370,446 Filed: March 7, 2006 Attorney Docket No. P22.655-E USA

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 1, 2012.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office will require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, which the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any replies that may be due and the time frame within which the client must respond, pursuant to 37 CFR 10.40 (c).

The request was signed by Peter J. Butch III on behalf of all attorneys of record who are associated with Customer Number 20802.

All attorneys/agents associated with the Customer Number 20802 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the applicant at the address indicated below.

Currently, there is no outstanding Office action that requires a reply.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751. All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

/Joan Olszewski/ Joan Olszewski Petitions Examiner Office of Petitions

cc:

William A. Hayday 7600 Jericho Turnpike Woodbury, NY 11797



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO CA 92121

MAILED

JUL 1 5 2011

OFFICE OF PETITIONS

In re Application of

Agrawal et al.

Application No. 11/370,639

Filed: March 7, 2006

Attorney Docket No. 050425B1

: DECISION ON PETITION

: UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 20, 2011, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application as set forth in the Amendment filed February 28, 2008.

### The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted:

the surcharge set forth in § 1.17(t); and
a statement that the entire delay between the date the claim
was due under 37 CFR 1.78(a)(2)(ii) and the date the claim
was filed was unintentional. The Commissioner may require
additional information where there is a question whether the
delay was unintentional.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after expiration of the period specified by 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application, accompanies this decision on petition.

It is noted that in the body of the petition, petitioner asks the USPTO to accept an unintentionally delayed claims to priority for both Application Nos. 11/142,121 and 60/659,971. The amendment submitted in February 2008 only references the Application No. 11/142,121, which is the only application being accepted in this decision. Should petitioner wish to include priority back to the provisional application, petitioner should notify the Office and provide an appropriate amendment to the specification.

Any inquiries concerning this decision may be directed to Joan Olszewski at (571) 272-7751.

This matter is being referred to Technology Center Art Unit 2617 for appropriate action on the Amendment filed February 28, 2008, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application.

/Liana Walsh/ Liana Walsh Petitions Examiner Office of Petitions

**ATTACHMENT**: Corrected Filing Receipt



#### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS PO. Box 1450 Alexandria, Vuginia 22313-1450 www.uspto.gov

 APPLICATION NUMBER
 FILING or 371(c) DATE
 GRP ART UNIT
 FIL FEE REC'D
 ATTY.DOCKET.NO
 TOT CLAIMS IND CLAIMS

 11/370,639
 03/07/2006
 2617
 2330
 050425B1
 32
 6

23696 QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121 CONFIRMATION NO. 3689
CORRECTED FILING RECEIPT

Date Mailed: 07/14/2011

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

#### Applicant(s)

Avneesh Agrawal, San Diego, CA; Aamod Khandekar, San Diego, CA; Alexei Gorokhov, San Diego, CA; Edward Harrison Toogus, San Diego

Edward Harrison Teague, San Diego, CA; **Power of Attorney:** The patent practitioners associated with Customer Number 23696

Domestic Priority data as claimed by applicant

This application is a CIP of 11/142,121 05/31/2005

**Foreign Applications** (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see <a href="http://www.uspto.gov">http://www.uspto.gov</a> for more information.)

If Required, Foreign Filing License Granted: 03/31/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/370,639** 

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

Use of supplemental assignments to decrement resources

**Preliminary Class** 

455

### PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

#### LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

#### **GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

#### **NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

LAW OFFICE OF BRETT N. DORNY 386 WEST MAIN STREET SUITE 12A NORTHBOROUGH, MA 01532

MAILED

MAR 09 2011

OFFICE OF PETITIONS

In re Application of Jonathan Fischer

Application No. 11/370,651

Filed: March 8, 2006

Attorney Docket No. F006-101

: DECISION ON PETITION

This is a decision on the petition under the unavoidable provisions of 37 CFR 1.137(a), filed October 26, 2010, to revive the above-identified application.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, May 19, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 20, 2009.

### The petition is **DISMISSED**.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). The instant petition lacks item (3).

Petition attests that the response to the non-final Office action mailed May 19, 2009 was unavoidable due to the actions or inactions of his appointed representative.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

In support of his petition, applicant has filed a copy of the suspension of his attorney, Brett Dorny. The suspension of Brett Dorny did not take place until February of 2010, which is over eight (8) months after the mailing of the Office action and over one (1) month after the mailing of the Notice of Abandonment. Petitioner must show evidence to establish due diligence by the applicant with regard to his application.

As the record indicates that Brett Dorny was responsible for prosecution of the above-identified application when the reply necessary to avoid abandonment was due, petitioner must provide a statement from Mr. Dorny explaining why action was not timely taken to prevent the above-identified application from becoming abandoned.

Petitioner is advised to send a letter (accompanied by a copy of this decision) to Mr. Dorny, by certified or registered mail (return receipt requested) indicating that the Patent and Trademark office is requesting assistance in ascertaining the cause of abandonment of the above-identified application, and that the Patent and Trademark Office is requesting that Mr. Brett Dorny provide within a specified period (e.g., one month) a statement setting forth why appropriate action was not timely taken to prevent abandonment of the above-identified application from becoming abandoned. Petitioner is advised that in the event that Mr. Dorny does not provide such a statement, petitioner should submit a copy of such letter and the return receipt.

The USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and petitioner is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987); California, supra. Specifically, petitioner's delay caused by the mistakes or omissions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133. See Haines v. Quigg, supra; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Exparte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891).

Petitioner is reminded that the Patent and Trademark Office is not the proper forum for resolving disputes between applicants and their representatives. See Ray v. Lehman, 55 F.3d 606,34 USPQ2d 1786 (Fed. Cir. 1995).

While the showing of the record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, petitioner is not precluded from obtaining relief by filing a petition pursuant to 37 CFR 1.137(b) on the basis of the unintentional delay.

If petitioner cannot provide the evidence necessary to establish unavoidable delay, or simply does not wish to, petitioner may wish to consider filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the \$810 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Any further petition to revive must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C.§ 704.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

Mail Stop PETITION

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

By hand:

U. S. Patent and Trademark Office

Customer Service Window, Mail Stop Petitions

Randolph Building

401 Dulany Street Alexandria, VA 22314

By facsimile:

(571) 273-8300

Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to April M. Wise at (571) 272-1642.

/dab/ David Bucci Petitions Examiner Office of Petitions

Attachment: copy of Office action mailed May 19, 2009.

cc: CHRISTOPHER J. LITZ, ESQ.
WESTBOROUGH OFFICE PARK
1700 WEST PARK DRIVE
SUITE 280
WESTBOROUGH, MA 01581



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.usplo.dev

LAW OFFICE OF BRETT N. DORNY 386 WEST MAIN STREET SUITE 12A NORTHBOROUGH, MA 01532

MAILED JUN 27 2011

OFFICE OF PETITIONS

In re Application of Jonathan Fischer Application No. 11/370,651 Filed: March 8, 2006 Attorney Docket No. F006-101

tion No. 11/370,651 : DECISION ON PETITION

This is a decision on the renewed petition under the unavoidable provisions of 37 CFR 1.137(a), filed May 5, 2011, to revive the above-identified application.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, May 19, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 20, 2009.

# The petition is **DISMISSED**.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). The instant petition lacks item (3).

It is noted that petitioner sent the letter as required by the decision on petition mailed March 9, 2011, however, petitioner has not stated that he forwarded a copy of the letter to former attorney Brett Dorny at the new address listed below. Petitioner must show evidence to establish due diligence by the applicant with regard to his application.

While the showing of the record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, petitioner is not precluded from obtaining relief by filing a petition pursuant to 37 CFR 1.137(b) on the basis of the unintentional delay.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

If petitioner cannot provide the evidence necessary to establish unavoidable delay, or simply does not wish to, petitioner may wish to consider filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the \$810 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Any further petition to revive must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C.§ 704.

Further correspondence with respect to this matter should be addressed as follows:

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U. S. Patent and Trademark Office

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Randolph Building 401 Dulany Street

Alexandria, VA 22314

By facsimile:

(571) 273-8300

Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to April M. Wise at (571) 272-1642.

/dab/ David Bucci Petitions Examiner Office of Petitions

Attachment: copy of Office action mailed May 19, 2009 and decision on petition mailed March 24, 2011.

cc: CHRISTOPHER J. LITZ, ESQ.
WESTBOROUGH OFFICE PARK
1700 WEST PARK DRIVE
SUITE 280
WESTBOROUGH, MA 01581

cc: LAW OFFICE OF BRETT DORNY 10955 WESTMOOR DRIVE SUITE 400 WEDTMINSTER, CO 80021-2717



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MAILED

SEP 08 2011

OFFICE OF PETITIONS

In re Application of

Jonathan Fischer

Application No. 11/370,651

Filed: March 8, 2006

Attorney Docket No. F006-101

**DECISION ON PETITION** 

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed August 25, 2011, to revive the above-identified application.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. In accordance with 37 CFR 1.34(a), the signature appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts. However, if petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. All future correspondence regarding this application file will be directed solely to the address of record until otherwise instructed.

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must so notify the Office.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, May 19, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 20, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of \$810, and (3) a proper statement of unintentional delay.

In view of the above, the petition is **GRANTED**.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 3664 for appropriate action by the Examiner in the normal course of business on the reply received August 25, 2011.

April/M. Wise Petitions Examiner Office of Petitions

cc: BARRY W. CHAPIN, ESQ.

CHAPIN INTELLECTUAL PROPERTY LAW, LLC

WESTBOROUGH OFFICE PARK 1700 WEST PARK DRIVE, SUITE 280

WESTBOROUGH, MA 01581



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

TREX ENTERPRISES CORP. **10455 PACIFIC COURT SAN DIEGO CA 92121** 

MAILED

APR 20 2011

OFFICE OF PETITIONS

In re Application of

John Lovberg et al

Application No. 11/370,680 **DECISION ON PETITION** 

Filed: March 8, 2006

Attorney Docket No. 667

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 28, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of the issue fee; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice of Allowance mailed May 21, 2010, is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This application is being referred to the Office of Data Management to be processed into a patent.

/KOC/ Karen Creasy **Petitions Examiner** Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

WILMERHALE/BOSTON 60 STATE STREET BOSTON MA 02109 **MAILED**DEC 1 5 2011

**OFFICE OF PETITIONS** 

In re Application of Baichwal, et al.

Application No. 11/370,699

Filed: March 8, 2006

Attorney Docket No. 0107223.00196US1

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 2, 2011, to revive the above-identified application.

The petition is GRANTED.

The application became abandoned March 21, 2011 for failure to timely submit an appeal brief in response to the Notice of Appeal filed January 20, 2011. This decision precedes Notice of Abandonment.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE), including fee and submission required by 37 CFR 1.114; (2) the required petition fee; and (3) a proper statement of unintentional delay.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, practitioner's signature appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. If practitioner desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to practitioner, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

This application is being referred to Technology Center AU 1657 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown Attorney Advisor Office of Petitions

CC: JOSEPH MAHONEY
Mayer Brown Rowe & Maw LLP
P.O. Box 2828
Chicago, IL 60690--282



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DOUGLAS SPRIGGS SELSAM 14045 MISSION ST. OAK HILLS CA 92344

**MAILED** 

DEC 122011

OFFICE OF PETITIONS

In re Application of

DOUGLAS SPRIGGS SELSAM

Application No. 11/370739

Filed: 03/07/2006

Title: STATIONARY CO-AXIAL MULTI-ROTOR WIND TURBINE SUPPORTED BY

CONTINUOUS CENTRAL DRIVESHAFT

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 30, 2011, to revive the above-identified application.

#### The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed February 16, 2011, which set a shortened statutory period for reply of three (3) months. No extensions of time for response were obtained under the provisions of 37 CFR 1.136(a). Accordingly, the application became abandoned on May 17, 2011. A Notice of Abandonment was mailed on October 25, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee, and (3) an acceptable statement of unintentional delay.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that an inquiry has not been made, petitioner must make such an inquiry. If the inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date

for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. Petitioner may wish to submit an appropriate power of attorney.

This application is being referred to Technology Center AU 3745 for appropriate action by the Examiner on the reply received on November 30, 2011.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-3211.

C. P. Donnell

Christina Tartera Donnell Senior Petitions Attorney Office of Petitions



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
11/371,020	03/09/2006	Kentaro Kegoya	1035.632 3850		
23117 NIXON & VA	7590 01/14/2011 NDERHYE, PC		EXAMINER		
901 NORTH C	LEBE ROAD, 11TH FLOO	BURGESS, BARBARA N			
ARLINGTON,	VA 22203		ART UNIT PAPER I		
			2457		
	•				
			MAIL DATE	DELIVERY MODE	
			01/14/2011	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450

MAILED

Alexandria, VA 22313-1450 www.uspto.gov

Frank P. Presta NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON VA 22203

JAN 13 2011

DIRECTOR OFFICE
TECHNOLOGY CENTER 2400

In re Application of: KEGOYA, Kentaro et. al. Application No. 11/371,020

Filed: March 09, 2006 Docket No. 1035.632

Title: CONTROL SERVER, CONTROL TERMINAL,

CONTROL SYSTEM, AND RECORDING

MEDIUM STORING CONTROL COMMUNICATION PROGRAM

**DECISION ON PETITION** 

This is a decision on the petition filed on November 30, 2010 requesting Information Disclosure Statement (IDS) filed November 05, 2010 allegedly erroneously placed under application serial number 10/371,020 be "transfer[red]" to instant application number, i.e. 11/371,020 along with the corresponding fees (180.00) accompanying the IDS.

#### The petition is **DISMISSED**.

Papers filed with IDS filed November 30, 2010 including IDS transmittal letter, PTO/SB/08a, and non-patent literature reference has been reviewed along with a postcard receipt copy accompanying the above-mentioned petition.

The IDS transmittal letter identified on the right-hand side top of the page application serial no. 10/371,020 as the application number this letter is directed to, in accordance with filing requirements (see 37 C.F.R. § 1.5).

Similarly, PTO/SB/08 identified left-hand side top of the page application serial number 10/371,020 as the application number this form is directed to, in accordance with filing requirements (see 37 C.F.R. §1.98(a)(1)), wherein each page must clearly identify the application number of the application in which the IDS is being submitted (see MPEP §609.04(a)).

The transmittal letter and the PTO/SB/08 has been included the Image File Wrapper in accordance with the application number clearly **identified** thereon, i.e. application serial number 10/371,020.

Postcard receipt presented with petition as evidence to support instant petition, has fully been considered. It is noted that a postcard receipt which itemizes and properly identifies the items which are being filed only serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO (emphasis added).

The application number officially assigned to an application on the filing receipt may differ from the application number identified on a postcard receipt submitted with such application, and, as between inconsistent filing receipts and postcard receipts, the application number on the filing receipt is *controlling*. (MPEP 503). Any papers received in the Patent and

Serial No.: 11/371020 Decision on Petition

Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes (37 CFR 1.53(a)).

The transmittal letter and the PTO/SB/08 has been included the Image File Wrapper in accordance with the application number **identified** thereon and not the purported application number identified on the postcard receipt which only serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

Accordingly, the petition is **dismissed**.

Petitioner is encouraged to re-file the above mentioned IDS (transmittal letter and PTO/SB/08 form) clearly identifying the **proper** application serial number to which these documents are directed to in accordance with filing requirements (see 37 C.F.R. § 1.5 and §1.98(a)(1)).

Regarding corresponding fees (180.00) accompanying the IDS filed November 30, 2010, petitioner is further encouraged to request a refund in accordance with §1.26. All questions pertaining to the return of fees are referred to the Refunds Section of the Receipts Division of the Office of Finance (see MPEP §607.02). For more information, please visit our website at: http://www.uspto.gov/about/offices/cfo/finance/receipts\_division.jsp#heading-3

Any inquiry regarding this decision should be directed the undersigned whose telephone number is (571) 272-3902. If attempts to reach the undersigned by telephone are unsuccessful, Kim Huynh, Quality Assurance Specialist, can be reached at (571) 272-4147.

/bp/

/Beatriz Prieto/

Beatriz Prieto, Quality Assurance Specialist Technology Center 2400 Network, Multiplexing, Cable and Security



#### UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

FISH & RICHARDSON P.C. (BO) P.O. BOX 1022 MINNEAPOLIS MN 55440-1022

MAILED AUG 23 2011 OFFICE OF PETITIONS

In re Patent No.7,962,463

Cava

Issue Date: June 14, 2011 Application No. 11/371,209

Filed: March 8, 2006

Attorney Docket No. 10984-763001

DECISION FOR REQUEST

FOR RECONSIDERATION

OF PATENT TERM

ADJUSTMENT

This is a decision on the "Application for Patent Term Adjustment Under 37 CFR 1.705(d)," filed August 12, 2011. Patentees request that the patent term adjustment indicated on the face of the Letters of Patent be corrected from two hundred and sixty-three (263) days, to three hundred and fifty-two (352) days.

The request for reconsideration of the patent term adjustment under 37 CFR 1.705(d) is **DISMISSED**.

On June 14, 2011, the above-identified application matured into U.S. Patent No. 7,962,209, with a revised patent term of 263 days. By the instant petition, patentees assert that the patent term should be adjusted by 352 days pursuant to 37 CFR 1.702(b) and 37 CFR 1.703(b). Patentees state:

Section 154(b)(1)(B)(i) of Title 35 excludes from the calculation of B Delay "any time consumed by continued examination of the application." In the present matter, a Requests for Continued Examination were filed on September 21, 2009, and February 18, 2011. The Director erred in the calculation of the patent term adjustment by subtracting from B Delay a period of time that was not "consumed by continued examination of the application." The PTO mailed a Notice of Allowance on March 18, 2011, thereby closing examination of the application on that Thus, no continued examination took place during 89 day period from March 18, 2011 (the mailing date of the

Notice of Allowance) until June 14, 2011 (the date the patent was issued). Accordingly, 89 days for "B Delay" should have been included in addition to the 196 days accorded by the Director for a total B Delay of 285 days.

Excerpt taken from "Application for Patent Term Adjustment Under 37 CFR 1.705(d)," filed August 12, 2011, Pgs. 3-4.

The Office's calculation of "B delay" is correct. The "B delay" is an adjustment entered if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed. However, the adjustment does not include, among other things, any time consumed by continued examination of the application at the request of the applicant under 35 U.S.C. 132(b) 1. So, with respect to calculating the "B delay" where applicant has filed a request for continued examination, the period of adjustment is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the number of days in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

Further, counting the period of time excluded from the "B delay" for the filing of a request for continued examination under 35 U.S.C. 132(b), from the date on which the request for continued

Pursuant to 35 U.S.C. 132(b), 37 CFR 1.114 provides for continued examination of an application, as follows:

<sup>(</sup>a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in  $\S 1.17(e)$  prior to the earliest of:

<sup>(1)</sup> Payment of the issue fee, unless a petition under § 1.313 is granted;

<sup>(2)</sup> Abandonment of the application; or

<sup>(3)</sup> The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

<sup>(</sup>b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

In re Patent No. 7,962,463 Application No. 11/371,209

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examination is filed to the date the patent is issued is proper. Patentee does not dispute that time consumed by continued examination of an application under 35 U.S.C. 132(b) is properly excluded and that the calculation of the excluded period begins on the date of filing of the request for continued examination. At issue is what further processing or examination beyond the date of filing of the request for continued examination is not any time consumed by continued examination of the application under 35 U.S.C. 132(b). The USPTO indicated in September of 2000 in the final rule to implement the patent term adjustment provisions of the AIPA that once a request for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114 is filed in an application, any further processing or examination of the application, including granting of a patent, is by virtue of the continued examination given to the application under 35 U.S.C. 132(b) and CFR 1.114. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56366, 56376 (Sept. 18, 2000) (response to comment 8). Thus, the excluded period begins with the filing of the request for continued examination and ends with the issuance of the patent.

Patentee's argument that the period of time after the issuance of a notice of allowance on a request for continued examination is not "any time consumed by continued examination requested by the applicant under section 132(b)" within the meaning of 35 U.S.C. 154(b)(1)(B)(i) is not availing. This limitation is not supported by the statutory language. Garcia v. United States, 469 U.S. 70, 75 (1984) ("only the most extraordinary showing of contrary intentions from [legislative history] would justify a limitation on the 'plain meaning' of the statutory language"). BP Am. Prod. Co. v. Burton, 549 U.S. 84, 91 (2006) ("Unless otherwise defined, statutory terms are generally interpreted in accordance with their ordinary meaning"). The statute provides for a guarantee of no more than 3-year application pendency, by providing for an adjustment in the patent term:

First, "Subject to the limitations of paragraph (2)," means that the limitations of paragraph 2 apply to this paragraph's adjustment of patent term. That is, the day-to-day extension of patent term for pendency beyond the 3 year period is restricted as follows: 1) "B delay" cannot accrue for days of "A delay" that overlap, 2) the patent term cannot be extended beyond disclaimed term, and 3) the period of adjustment, including accrued "B delay," will be reduced for applicant delay.

Second, "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States," meaning that the condition must first occur that the issuance of an original patent (35 U.S.C. 153), not merely the issuance of a notice of allowance, is delayed due to the Office's failure to issue a patent (sign and record a patent grant in the name of the United States), not merely mail a notice of allowance, within 3 years after the actual filing date of the application in the United States. This provision gives the Office a three-year period to issue a patent (sign and record a patent grant in the name of the United States) after the application filing date before an adjustment will accrue for "B delay."

Third, "not including- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b); (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), meaning that the three-year period does not include "any time consumed by" or "any delay in processing," as specified in clauses (i)-This language correlates to 35 U.S.C. 154(b)(1)(A) which (iii). likewise provides the basis for determining the period given the Office to take the specified actions before an adjustment will accrue for "A delay" (e.g., extended for 1 day after the day after the period specified in clauses (i)-(iv)).

Furthermore, these clauses are interpreted using their ordinary meanings. Nonetheless, the context of the legislation should be considered. As stated in <a href="Wyeth v. Dudas">Wyeth v. Dudas</a>, 580 F. Supp.2d 138 (D.D.C., September 30, 2008), because the clock for calculating the 20-year patent term begins to run on the filing date, and not on the day the patent is actually granted, some of the effective term of a patent is consumed by the time it takes to prosecute the application. To mitigate this effect, the statute, inter alia, grants adjustments of patent term whenever the patent prosecution takes more than three years, regardless of the reason. The time consumed by prosecution of the application includes every day the application is pending before the Office from the actual filing date of the application in the United States until the date of issuance of the patent. The

In re Patent No. 7,962,463 Application No. 11/371,209 5 time it takes to prosecute the application ends not with the mailing of the notice of allowance, but with the issuance of the patent.

Thus, not including "any time consumed by" means not including any days used to prosecute the application as specified in clauses (i)-(ii)<sup>2</sup>. Clause (i) specifies "any time consumed by continued examination of the application requested by the applicant under section 132(b)." Clause (ii) specifies "any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court." "Time" in the context of this legislation throughout refers to days. "Consumed by" means used by or used in the course of. Websters Collegiate Dictionary, (11th ed.). The "any" signifies that the days consumed by are "any" of the days in the pendency of the application, and not just days that occur after the application has been pending for 3 years. As such, "any time consumed by" refers to any days used in the course of 1) continued examination of the application under section 132(b) (the filing of a request for continued examination), 2) interference proceedings, 3) secrecy orders, and 4) appellate review. that 3-year period given to the Office to issue a patent before an adjustment will accrue for "B delay" does not include any days used in the course of or any time consumed by clauses (i)-(ii), including any time consumed by the filing of a request for continued examination.

Fourth, "the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued" meaning that the consequence of this failure is that after "the end of that 3-year period" an additional 1 day of patent term will accrue for each day that the application is pending until the day the patent is issued.

Clause (iii) provides for not including (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued. It is noted that paragraph (3)(C) allows with an adequate showing by applicant for reinstatement of no more than 3 months of the patent term reduced for applicant delay in taking in excess of three months to respond.

The "time consumed by" or used in the course of the continued examination of the application requested by the applicant under section 132(b) does not end until issuance of 35 U.S.C. 132(b) was enacted under the same title, the patent. the "American Inventors Protection Act of 1999," as 35 U.S.C. Section 4403 of the AIPA amended 35 U.S.C. § 132 to provide, at the request of the applicant, for continued examination of an application for a fee (request for continued examination or RCE practice), without requiring the applicant to file a continuing application under 37 CFR 1.53(b) or a continued prosecution application (CPA) under 37 CFR 1.53(d). Thus, clause (i) is different from clause (ii) in that clause (i) refers to an examination process whereas clause (ii) refers to time consumed by proceedings (interferences, secrecy orders and appeals) in an application.

By nature, the time used in the course of the examination process continues to issuance of the patent. The examination process involves examining the application to ascertain whether it appears that the applicant is entitled to a patent under the See 35 U.S.C. 131 ("[t]he Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor"). If on examination it appears that the applicant is entitled to a patent, the USPTO issues a notice of allowance. See 35 U.S.C. 151 ("[i]f it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant"). If on examination it appears that the applicant is not entitled to a patent, the USPTO issues a notice (an Office action) stating the applicable rejection, objection, or other requirement, with the reasons therefor. See 35 U.S.C. 132 ("[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application"). Neither the issuance of a notice of allowance nor the insurance of an Office action terminates the examination process. If after the issuance of an Office action under 35 U.S.C. 132 it subsequently appears that the applicant is entitled to a patent (e.g., in response to an argument or amendment by the applicant), the USPTO will issue a notice of allowance. Conversely, if after the issuance of a notice of allowance under

In re Patent No. 7,962,463 Application No. 11/371,209

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35 U.S.C. 151 it subsequently appears that the applicant is not entitled to a patent (e.g., in response to information provided by the applicant or uncovered by the USPTO), the USPTO will withdraw the application from issuance and issue an Office action under 35 U.S.C. 132 stating the applicable rejection, objection, or other requirement, with the reasons therefor.

As held in <u>Blacklight Power</u>, the USPTO's responsibility to issue a patent containing only patentable claims does not end with the issuance of a notice of allowance under 35 U.S.C. 151. See <u>BlackLight Power</u>, Inc. v. Rogan, 295 F.3d 1269, 1273 (Fed. Cir. 2002). Rather, if there is any substantial, reasonable ground within the knowledge or cognizance of the Director as to why an application should not issue, it is the USPTO's duty to refuse to issue the patent even if a notice of allowance has previously been issued for the application. See <u>In reDrawbaugh</u>, 9 App. D.C. 219, 240 (D.C. Cir 1896).

Moreover, the applicant continues to be engaged in the examination process after the mailing of the notice of allowance. 37 CFR 1.56 makes clear that the applicant has a duty to disclose information material to patentability as long as the application is pending before the USPTO (i.e., until a patent is granted or the application is abandoned). See 37 CFR 1.56(a) ("[t]he duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned"). 37 CFR 1.97 and 1.98 provide for the consideration of information submitted by the applicant after a notice of allowance has been mailed. See 37 CFR 1.97(d). In addition, 37 CFR 1.312 provides for the amendment of an application after a notice of allowance has been mailed. In fact, the request for examination procedures<sup>3</sup> permit the filing of a request for continued examination under 37 CFR 1.114 even after the issuance of a notice of allowance under 35 U.S.C. 151. See 37 CFR 1.114(a)(1).

As the examination process does not terminate with the mailing of the notice of allowance, the time consumed by continued examination requested by the applicant under section 132(b) does not terminate with the mailing of the notice of allowance. All the time the application is pending from the date of filing of the request for continued examination to the mailing of the notice of allowance through issuance of the

Thus, on occasion, even where a request for continued examination has already been filed and a notice of allowance issued pursuant to that request, applicant may file a further request for continued examination.

All of the continued examination pursuant to the filing of the request by the applicant is properly excluded from the delay attributed to the Office. 35 U.S.C. 154(b)(1)(B)'s guarantee of a total application pendency of no more than three years provides for adjustment of the patent term for delay due to the Office's failure to issue the patent within three years, but does not include "any time consumed by continued examination requested by the applicant under 35 U.S.C. 132(b)." It is not necessary to mitigate the effect on the 20-year term to the extent that applicant has requested that the Office continue to examine the application via a request for continued examination, in lieu of, the filing of a continuing application under 37 CFR 1.53(b).

In this instance, the first request for continued examination was filed on September 21, 2009, and the patent issued by virtue of that request on June 14, 2011. Pursuant to 35 U.S.C. 154(b)(1)(B)(i), the period beginning on September 21, 2009, and ending on June 14, 2011, is not included in calculating Office delay.

In view thereof, it is concluded that the patent term adjustment of 263 days indicated on the patent is correct.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Petitions Attorney Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Dr. Yitzhak Rosen M.D. 385 N. Street, Southwest Washington DC 20024

MAILED

FEB 14 2011

OFFICE OF PETITIONS

In re Application of

Yitzhak Rosen et al.

Application No. 11/371,276

Filed: March 9, 2006

Attorney Docket No.

ON PETITION

This is in response to the communication, filed July 8, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision should be submitted within two (2) months from the mail date of this decision and be entitled "Renewed Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181." See 37 CFR 1.181(f).

Any request for reconsideration of this decision should be submitted within **TWO (2) MONTHS** from the mail date of this decision and be entitled "Renewed Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181." See 37 CFR 1.181(f).

On September 29, 2009, the Office mailed a non-final Office action, which set a three month shortened statutory period to reply. The application was held to have gone abandoned for failure to submit a timely response to the non-final Office action. On May 17, 2010, the Office mailed a Notice of Abandonment.

### DISCUSSION OF PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

In the present petition, petitioners request that the Office withdraw the holding of abandonment due to a "simple oversight." Petitioners also state that a proper response was hand delivered to the USPTO mailroom on December 29,

2009, which constituted a timely response to the Office action. Petitioners acknowledge that they were unaware of the requirements for signatures to be provided by both inventors. However, a review of the file records does not show that a response was ever received by USPTO in this application on December 28, 2009. Petitioners have not provided any evidence showing acknowledgement from the USPTO of receiving the response on December 28, 2009. Therefore, since petitioner has not provided the proper evidence showing that the response was in fact filed on or before December 29, 2009, the instant petition to withdraw the holding of abandonment cannot be granted at this time. Accordingly, the instant application was properly held abandoned for failure to timely file a proper reply to the non-final Office action of September 29, 2009. The application became abandoned by law on December 30, 2009. It is also noted that a proper response still has not been filed to the present day.

Petitioner should also note that the request for a change of correspondence address filed concurrently with the instant petition will not be entered as it is only signed by one inventor. In this regard, petitioner's attention is directed to 37 CFR 1.33(b), which states.

- (b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:
- (1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);
- (2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;
- (3) An assignee as provided for under §3.71(b) of this chapter; or
- (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

An unsigned amendment (or other paper) or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where the amendment (or other paper) is signed by only one of two applicants and the one signing has not been given a power of attorney by the other applicant.

Therefore, as the request for Change of Correspondence Address is not signed by all the inventors and the record herein fails to disclose that petitioner herein (Yitzhak Rosen) was ever given a power of attorney to act on behalf of inventor Oleg Shapiro, or that he is an assignee of the entire interest and has complied with the provisions of 37 CFR 3.73(b), the change of address request is considered to be improper.

#### **ALTERNATIVE VENUE**

Petitioner is strongly encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137(a).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed. In nonprovisional utility application abandoned for failure to respond to a non-final Office action, the required reply may be met by filing either (A) an argument or amendment under 37 CFR 1.111 or (B) a continuing application under 37 CFR 1.53(b).
- (2) The petition fee as set forth in 37 CFR 1.17(m), **\$810.00 for a small entity**;
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

A form for filing a petition to revive an unintentionally abandoned application accompanies this decision for petitioner's convenience. If petitioner desires to file a petition under 37 CFR 1.137(b) instead of filing a request for reconsideration, petitioner must complete the enclosed petition form (PTO/SB/64) and pay the \$810.00 petition fee.

Petitioner may wish to consider hiring a registered patent attorney or agent to assist in the prosecution of this application. Additionally, petitioner is encouraged to contact the Inventors Assistance Center (IAC) by telephone at 800-786-9199 or 571-272-1000, Monday through Friday from 8:30 AM to 5:30 PM (EST). The IAC provides patent information and services to the public and is staffed by former Supervisory Patent Examiners and experienced Primary Examiners who answer general questions concerning patent examining policy and procedure.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

By FAX:

(571) 273-8300

Attn: Office of Petitions

By hand:

Customer Service Window

Randolph Building 401 Dulany Street Alexandria, VA 22314

Telephone inquiries related to this decision may be directed to the JoAnne Burke at (571) 272-4584.

Ramesh Krishnamurthy

Petitions Examiner Office of Petitions

cc:

David B. Johnson

1725 T St., N.W. Apt 31 Washington, D.C. 20009

Enclosures: Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b); Form PTO/SB/64, Privacy Act Statement





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.usplo.gov

Dr. Yitzhak Rosen M.D. 385 N. Street, Southwest Washington DC 20024

MAILED

JUN 02 2011

OFFICE OF PETITIONS

In re Application of Yitzhak Rosen et al.

Application No. 11/271 076

Application No. 11/371,276 :

Filed: March 9, 2006

Attorney Docket No.

ON PETITION

This is in response to the communication, filed May 13, 2011, which is being treated as a renewed petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

#### The petition is **DISMISSED**.

On September 29, 2009, the Office mailed a non-final Office action, which set a three month shortened statutory period to reply. The application was held to have gone abandoned for failure to submit a timely response to the non-final Office action. On May 17, 2010, the Office mailed a Notice of Abandonment.

A first petition requesting withdrawal of the holding of abandonment was filed on July 8, 2010. In a decision mailed February 14, 2011 dismissing that petition, it was noted "any request for reconsideration of the decision should be submitted within **TWO (2) MONTHS** from the mail date of this decision and be entitled "Renewed Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181." See 37 CFR 1.181(f)." Therefore, since the instant request was not filed within TWO (2) MONTHS of February 14, 2011, the renewed petition is deemed untimely. Furthermore, the instant submission does not include sufficient evidence that a timely response was filed to the nonfinal Office action of September 29, 2009. Accordingly, the petition cannot be granted at this time.

#### **ALTERNATIVE VENUE**

Petitioner is strongly encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a

renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137(a).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed. In nonprovisional utility application abandoned for failure to respond to a non-final Office action, the required reply may be met by filing either (A) an argument or amendment under 37 CFR 1.111 or (B) a continuing application under 37 CFR 1.53(b).
- (2) The petition fee as set forth in 37 CFR 1.17(m), \$810.00 for a small entity;
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

A form for filing a petition to revive an unintentionally abandoned application accompanies this decision for petitioner's convenience. If petitioner desires to file a petition under 37 CFR 1.137(b) instead of filing a request for reconsideration, petitioner must complete the enclosed petition form (PTO/SB/64) and pay the \$810.00 petition fee.

Petitioner may wish to consider hiring a registered patent attorney or agent to assist in the prosecution of this application. Additionally, petitioner is encouraged to contact the Inventors Assistance Center (IAC) by telephone at 800-786-9199 or 571-272-1000, Monday through Friday from 8:30 AM to 5:30 PM (EST). The IAC provides patent information and services to the public and is staffed by former Supervisory Patent Examiners and experienced Primary Examiners who answer general questions concerning patent examining policy and procedure.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

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Alexandria, VA 22313-1450

By FAX:

(571) 273-8300

Attn: Office of Petitions

By hand:

**Customer Service Window** 

Randolph Building

401 Dulany Street Alexandria, VA 22314

Telephone inquiries related to this decision may be directed to the JoAnne Burke at (571) 272-4584.

/Ramesh Krishnamurthy/ Ramesh Krishnamurthy Petitions Examiner Office of Petitions

cc: David B. Johnson 1725 T St., N.W. Apt 31 Washington, D.C. 20009

Enclosures: Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b); Form PTO/SB/64, Privacy Act Statement

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.usplo.gov

Dr. Yitzhak Rosen M.D. 385 N. Street, Southwest Washington DC 20024

MAILED

JUN 29 2011

OFFICE OF PETITIONS

In re Application of Yitzhak Rosen et al. Application No. 11/371,276

Application No. 11/371,276 Filed: March 9, 2006

Attorney Docket No.

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 16, 2011, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is not a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, September 29, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on December 30, 2009.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item(s) (3).

The statement of delay is not acceptable. In this regard, petitioner's attention is directed to 37 CFR 1.33(b), which states.

- (b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:
- (1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);
- (2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;
- (3) An assignee as provided for under §3.71(b) of this chapter; or
- (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

An unsigned amendment (or other paper) or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where the amendment (or other paper) is signed by only one of two applicants and the one signing has not been given a power of attorney by the other applicant.

Therefore, as the petition is not signed by all the inventors and the record herein fails to disclose that petitioner herein (Yitzhak Rosen) was ever given a power of attorney to act on behalf of inventor Oleg Shapiro, or that he is an assignee of the entire interest and has complied with the provisions of 37 CFR 3.73(b), the petition is considered to not contain a proper statement of unintentional delay.

Petitioner may wish to consider hiring a registered patent attorney or agent to assist in the prosecution of this application. Additionally, petitioner is encouraged to contact the Inventors Assistance Center (IAC) by telephone at 800-786-9199 or 571-272-1000, Monday through Friday from 8:30 AM to 5:30 PM (EST). The IAC provides patent information and services to the public and is staffed by former Supervisory Patent Examiners and experienced Primary Examiners who answer general questions concerning patent examining policy and procedure.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

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P. O. Box 1450

Alexandria, VA 22313-1450

By hand:

U. S. Patent and Trademark Office

Customer Service Window, Mail Stop Petitions

Randolph Building 401 Dulany Street Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4584

JoAnne Burke

Petitions Examiner
Office of Petitions

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Dr. Yitzhak Rosen M.D. 1725 T Street NW Apt. 31 Washington DC 20009

MAILED

FEB 2 1 2012

OFFICE OF PETITIONS

In re Application of

Yitzhak Rosen et al.

Application No. 11/371,276

Filed: March 9, 2006

Attorney Docket No.

ON PETITION

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed August 29, 2011 and supplemented February 5, 2012, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, September 29, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on December 30, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of \$810, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571) 272-4584.

This application is being referred to Technology Center AU 3737 for appropriate action by the Examiner in the normal course of business on the reply received.

Joaquie Burke Petitions Examiner Office of Petitions

#### UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

#### MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C ONE FINANCIAL CENTER BOSTON MA 02111

MAILED

FEB 1 1 2011

**OFFICE OF PETITIONS** 

In re Patent No. 7,239,122

Issued: July 3, 2007

Application No. 11/371,472

Filed: March 9, 2006

Attorney Docket No. 25960-614C02US

ON PETITION

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed January 5, 2011.

On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-7751.

Joan Olszewski

**Petitions Examiner** 

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

TROUTMAN SANDERS LLP 5200 BANK OF AMERICA PLAZA 600 PEACHTREE STREET NE, SUITE 5200 ATLANTA, GA 30308-2216

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DEC 03 2010

**OFFICE OF PETITIONS** 

In re Application of **Andrew CIMINI**, et *al.* Application No. 11/371,645 Filed: March 9, 2006

Attorney Docket No. **DYN037** 

DECISION ON PETITION UNDER 37 CFR 1.137(b)

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed July 22, 2010, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue fee on or before March 15, 2010, as required by the Notice of Allowance and Fee(s) Due, mailed December 15, 2009. Accordingly, the date of abandonment of this application is March 16, 2010.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of \$755, (2) the petition fee of \$810; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Monica A. Graves at (571) 272-7253.

This application is being referred to Office of Data Management for processing into a patent.

Thurman K. Page Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

TOWNSEND AND TOWNSEND AND CREW LLP/ORACLE TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO CA 94111-3834 MAILED

AUG 1 6 2010

OFFICE OF PETITIONS

In re Application of Supreet Oberoi

Application No. 11/371,649

Filed: March 9, 2006

Attorney Docket No. 021756-047700US

:DECISION ON PETITION

:UNDER 37 CFR 1.78(a)(3)

and

:UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition filed March 30, 2010, under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of a prior-filed international PCT application (Application No. PCT/US2004/029158, filed on September 7, 2004, and under 37 CFR 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional application 60/502,088, filed on September 10, 2003, which are set forth in the amendment and supplemental application data sheet (ADS) filed with the petition.

#### The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The amendment as drafted is unacceptable and, therefore, is not considered a proper reference under 37 CFR 1.78(a)(2)(i). In this regard, the priority claim is not in the proper form and must be in an amendment, not physically part of any other document as the response and, as such, does not comply with 37 CFR 1.121, 1.52, or 1.4(c). Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made. The pertinent

section of 37 CFR 1.52 states that the claim (in this case, the claim for priority), must commence on a separate physical sheet. 37 CFR 1.4(c) states that each distinct subject must be contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office.

Additionally, the reference to add the prior-filed application should not include an incorporation by reference statement. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). Note MPEP §§ 201.06(c) and 608.04(b).

Before the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition and either a Supplemental Application Data Sheet (signed in compliance with 37 CFR 1.33(b) and in compliance with 37 CFR 1.76) or a substitute amendment (complying with the provisions of 37 CFR 1.121 or 37 CFR 1.76(b)(5)) to correct the above matters are required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS

Commissioner for Patents Post Office Box 1450

Alexandria, VA 22313-1450

By hand: Customer Service Window

Mail Stop Petitions Randolph Building 40I Dulany Street Alexandria, VA 22314

By fax: (571) 273-8300

ATTN: Office of Petitions

Any questions concerning this matter may be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

Christopher Bottorff

that Both

Supervisor

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

TOWNSEND AND TOWNSEND AND CREW LLP/ORACLE TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO CA 94111-3834

MAILED

NOV 04 2010

PCT LEGAL ADMINISTRATION

In re Application of

**OBERI**, Supreet

Application No.: 11/371,649

Attorney Docket No.: 021756-047700US

For: SYSTEM AND METHOD FOR MANAGING

ITEM INTERCHANGE AND IDENTIFICATION

IN AN EXTENDED ENTERPRISE

**DECISION ON PETITIONS** 

UNDER 37 CFR 1.78(a)(3) AND

UNDER 37 CFR 1.78(a)(6)

This is a decision on the petitions under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed 20 August 2010, to accept an unintentionally delayed claim under 35 U.S.C. §§120, 365(c) and 119(e) for the benefit of the prior-filed applications set forth in the concurrently filed amendment.

#### The petitions are **GRANTED**.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3) and 1.78(a)(6).

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ **(1)** 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- **(2)** the surcharge set forth in § 1.17(t); and
- **(3)** a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

The petition complies with the requirements for a grantable petition under 37 CFR §§1.78(a)(3)

and 1.78(a)(6) in that (1) a reference to the prior-filed applications has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR §§ 1.78(a)(2)(iii) and 1.78(a)(5)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. §§ 120, 365(c) and 119(e) to the prior-filed applications satisfies the conditions of 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) should <u>not</u> be construed as meaning that this application is entitled to the benefit of the filing date of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. §§120 and 365(c) and 1.78(a)(1) and (a)(2) and under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should <u>not</u> be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed applications, accompanies this decision on petition.

Any questions concerning this matter may be directed to Daniel Stemmer at (571)-272-3301. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to Technology Center Art Unit 2887 for appropriate action on the amendment submitted 20 August 2010, including consideration by the examiner of the claim under 35 U.S.C. § §120 and 365(c) and 37 CFR 1.78(a)(2) for the benefit of the prior-filed application, and for consideration of the claim under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(5) for the benefit of the prior-filed provisional application.

/Daniel Stemmer/

/Boris Milef/

Daniel Stemmer

Boris Milef

PCT Legal Examiner

PCT Legal Examiner

Office of PCT Legal Administration

Office of PCT Legal Administration

ATTACHMENT: Corrected Filing Receipt

#### UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

LeClairRyan 290 LINDEN OAKS, SUITE 310 ROCHESTER, NY 14625

MAILED

JUL 2 7 2011

OFFICE OF PETITIONS

In re Application of

Lisa K. JENNINGS, et al.

Application No. 11/371,652 : DECISION ON PETITION Filed: March 9, 2006 : UNDER 37 CFR 1.137(b)

Attorney Docket No. 20609/331 (PD-04035)

This is a decision on the petition under 37 CFR 1.137(b), filed February 2, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the final Office action mailed, June 5, 2009, which set a shortened statutory period for reply of three (3) months. A three (3) month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on December 6, 2009.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a continuing application under 37 CFR 1.53(b); (2) the petition fee of \$810; and (3) an adequate statement of unintentional delay.

This application is being revived solely for purposes of continuity. As continuity has been established by this decision, the application is again abandoned in favor of continuing application 12/632,777 filed December 7, 2009.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, the signature of Ms. Elaine A. Kim appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that she is authorized to represent the particular party in whose behalf she acts. If, Ms. Kim desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to Ms. Kim, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

Telephone inquiries concerning this decision should be directed to Monica A. Graves at (571) 272-7253

(571) 272-7253.

Thurman K. Page Petitions Examiner Office of Petitions

CC:

ELAINE A. KIM
WILSON SONSINI GOODRICH & ROSATI
650 PAGE MILL ROAD
PALO ALTO, CA 94304

#### UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

ROCHE DIAGNOSTICS OPERATIONS INC.

9115 Hague Road

Indianapolis IN 46250-0457

MAILED

NOV 22 2010

In re Application of : OFFICE OF PETITIONS

Hess, et al.

Application No. 11/371,871

Filed: March 9, 2006

Attorney Docket No. 22674 US1-pd/c

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 14, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned September 13, 2010 for failure to submit a proper reply to the final Office action mailed March 12, 2010. The final Office action set a three month shortened statutory period of time for reply. A petition for three month extension of time was timely filed. Notice of Abandonment was mailed September 24, 2010.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE), including fee and submission required by 37 CFR 1.114; (2) the required petition fee; and (3) a proper statement of unintentional delay.

This application is being referred to Technology Center AU 1641 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown Petitions Attorney Office of Petitions



#### UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.usplo.gov

PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510

MAILED

JAN 03 2011

OFFICE OF PETITIONS

In re Application of Regina Mueller-Mach et al Application No. 11/371,883 Filed: March 8, 2006

ON PETITION

Attorney Docket No. 005333US1

This is a decision on the petition, filed December 30, 2010 under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on December 9, 2010 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 1793 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/ Irvin Dingle Petitions Examiner Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).



#### UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP 901 NEW YORK AVENUE NW WASHINGTON DC 20001-4413 MAILED

MAR 1 1 2011

OFFICE OF PETITIONS

In re Patent No. 7,825,106

: DECISION ON

Devane, et al.

: REQUEST FOR RECONSIDERATION

Application No. 11/371,958

: of PATENT TERM ADJUSTMENT

Issue Date: November 2, 2010

ite: November 2, 2010

Filed: March 10, 2006

Attorney Docket No. 09487.0004-01

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)", filed December 30, 2010, requesting that the patent term adjustment indicated on the above-identified patent be corrected from 308 days to 321 days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **DISMISSED.** 

On November 2, 2010, the instant application matured into U.S. Patent No. 7,825,106 with a patent term adjustment of 308 days. Patentees timely filed the instant application for patent term adjustment on December 30, 2010, asserting that the patent term adjustment is 321 days. The Office determined a patent term adjustment of 308 days based upon 351 days of Office delay pursuant to 37 CFR 1.703(a)(1) and 83 days of Office delay pursuant to 37 CFR 1.704(c)(8) and ninety-five (95) days of Applicant delay pursuant to 37 CFR 1.704(c)(7).

A petition under 37 CFR 1.705(d) requires:

- (1) The fee set forth in § 1.18(e); and
- (2) A statement of the facts involved, specifying:
- (i) The correct patent term adjustment and the basis or bases under § 1.702 for the adjustment;
- (ii) The relevant dates as specified in §§ 1.703(a) through (e) for which an

adjustment is sought and the adjustment as specified in § 1.703(f) to which the patent is entitled;

- (iii) Whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and (iv)
  - (A) Any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704; or
  - (B) That there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704 (emphasis added).

The instant application for patent term adjustment has not met the requirements of item (2) above.

The \$200.00 fee set forth in 37 CFR 1.18(e) has been charged to Deposit Account No. 06-0916, as authorized.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Cliff Congo, at (571) 272-3207.

Anthony Knight

Director

Office of Petitions

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

CANTOR COLBURN LLP - IBM TUSCON DIVISION 20 Church Street 22nd Floor Hartford CT 06103

MAILED

APR 05 2011

**OFFICE OF PETITIONS** 

In re Application of Garimella et al.

Application No.: 11/371986

Filing or 371(c) Date: 03/08/2006

Attorney Docket Number:

SJO920050111US1

**DECISION ON** 

PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 7, 2011, to revive the above-identified application.

This Petition is hereby granted.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due, mailed November 1, 2011. The Notice set a nonextendable three (3) month period for reply. No reply having been received, the application became abandoned February 1, 2011.

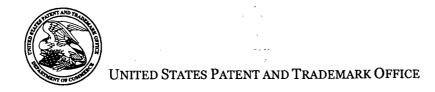
The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee and the publication fee; (2) the petition fee; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

This application is being referred to the Office of Data Management for processing into a patent.

/DLW/

Derek L. Woods Attorney Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

WYETH LLC PATENT LAW GROUP 5 GIRALDA FARMS MADISON NJ 07940

MAILED
MAR 0 5 2012
OFFICE OF PETITIONS

In re Application of

Kelley et al.

Patent Number: 8,067,182

Issue Date: 11/29/2011

Application No. 11/372054

Filing or 371(c) Date: 03/10/2006

Attorney Docket Number: PC53633A

DECISION ON REQUEST

FOR RECONSIDERATION

: OF PATENT TERM ADJUSTMENT

UNDER 37 CFR 1.705(d)

and

NOTICE OF INTENT TO ISSUE

CERTIFICATE OF CORRECTION

This is a decision on the petition filed on January 27, 2012, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by seven hundred ninety (790) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by seven hundred ninety (790) days is **GRANTED**.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by seven hundred ninety (790) days.

Page 2

Application No. 11/372054

Patent No. 8,067,182

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods Attorney Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

## UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

**PATENT** 

: 8,067,182 B2

DATED

: November 29, 2011

INVENTOR(S): Kelley et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page;

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 707 days.

Delete the phrase "by 707 days" and insert – by 790 days--

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 **WASHINGTON DC 20004** 

MAILED FEB 1 5 2012

In re Application of

Wang et al.

Application Number: 11/372,091

Filing date: March 10, 2006

Attorney Docket Number: P71159US0

OFFICE OF PETITIONS

**NOTICE** 

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28, filed on January 23, 2012.

The Office no longer investigates or rejects original or reissue patent under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

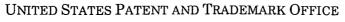
This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3230.

Show Willie Brankley Shirene Willis Brantley

**Attorney** 

Office of Petitions





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

BAKER BOTTS LLP C/O INTELLECTUAL PROPERTY DEPARTMENT THE WARNER, SUITE 1300 1299 PENNSYLVANIA AVE, NW WASHINGTON, DC 20004-2400

MAILED

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OFFICE OF PETITIONS

In re Application of

Tomohiro Kanbe

Application No.: 11/372,379 :

Filed: March 10, 2006

Attorney Docket No.: 076376.0222

ON PETITION

This is a decision on the petition, filed November 17, 2010, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on November 10, 2010, cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 2853 for further processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement (IDS).

/SDB/

Sherry D. Brinkley Petitions Examiner Office of Petitions

<sup>&</sup>lt;sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s)
Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.





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SALIWANCHIK, LLOYD & EISENSCHENK A PROFESSIONAL ASSOCIATION PO Box 142950 GAINESVILLE FL 32614

**MAILED** 

JAN 14 2011

**OFFICE OF PETITIONS** 

In re Application of

BENNER, STEVEN ALBERT

Application No. 11/372,400

Filed: 03/09/2006

Attorney Docket No. BEN.101C2XCDT

**DECISION ON PETITIONS UNDER** 

37 CFR 1.78(a)(3) AND (a)(6)

This is a decision on the petitions under 37 CFR 1.78(a)(3) and 1.78(a)(6), filed December 14, 2010, to accept an unintentionally delayed claim under 35 U.S.C. 120 and 119(e) for the benefit of the prior-filed applications set forth in the concurrently filed amendment.

#### The petitions are **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. 120 and 119(e) and 37 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in  $\S 1.17(t)$ ; and
- a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The present nonprovisional application must be pending at the time of filing of the reference to the prior-filed provisional applications as required by 37 CFR 1.78(a)(5)(ii). Further, the nonprovisional application claiming the benefit of the prior-filed provisional applications must have been filed within twelve months of the filing date of the prior-filed provisional applications.

All the above requirements having been satisfied, the late claim for benefit of priority under 35 U.S.C. 120 and 119(e) is accepted as being unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) and 1.78(a)(6) should not be construed as meaning that this application is entitled to the benefit of the filing date of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. 120 and 37 CFR 1.78(a)(1) and (a)(2) and under 35 U.S.C. 119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed applications, accompanies this decision on petition.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3211. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 1623 for consideration by the examiner of the claim under 35 U.S.C. 120 and 119(e) of the prior-filed nonprovisional and provisional applications.

Christina Lautera Donnell
Christina Tartera Donnell
Senior Petitions Attorney

Office of Petitions

**ATTACHMENT**: Corrected Filing Receipt



#### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS PO. Box 1450 Alexandria, Vuginia 22313-1450 www.uspito.gov

APPLICATION	FILING or	GRP ART			<u> </u>	
NUMBER	371(c) DATE	UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
11/372,400	03/09/2006	1623	500	BEN.101C2XCDT	14	3

23557 SALIWANCHIK, LLOYD & EISENSCHENK A PROFESSIONAL ASSOCIATION PO Box 142950 GAINESVILLE, FL 32614 CONFIRMATION NO. 5273
CORRECTED FILING RECEIPT



Date Mailed: 01/13/2011

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

Applicant(s)

Steven Albert Benner, Gainesville, FL;

Power of Attorney: The patent practitioners associated with Customer Number 23557

Domestic Priority data as claimed by applicant

This application is a CON of 11/212,230 08/27/2005 ABN which claims benefit of 60/605,061 08/28/2004 and claims benefit of 60/614,413 09/29/2004 and claims benefit of 60/617,636 10/13/2004

Foreign Applications (You may be eligible to benefit from the Patent Prosecution Highway program at the USPTO. Please see <a href="http://www.uspto.gov">http://www.uspto.gov</a> for more information.)

If Required, Foreign Filing License Granted: 01/12/2011

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/372,400** 

Projected Publication Date: Request for Non-Publication Acknowledged

Non-Publication Request: Yes

Early Publication Request: No

\*\* SMALL ENTITY \*\*

#### Title

Non-standard nucleoside analogs with reduced epimerization

#### **Preliminary Class**

514

#### PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

#### LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

#### **GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

#### **NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MCKELLAR IP LAW, PLLC 784 SOUTH POSEYVILLE ROAD MIDLAND MI 48640

MAILED

MAR 28 2011

In re Application of Larry A. Thum

Application No. 11/372,434

Filed: March 9, 2006

Attorney Docket No. MSH-373

OFFICE OF PETITIONS

**DECISION ON PETITION** 

This is a decision on the petition, filed December 20, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

#### The petition is **GRANTED**.

This application was held abandoned for failure to reply to the Notice of Non-Compliant Appeal Brief mailed January 4, 2010, which set a one (1) month period for reply. A Notice of Abandonment was mailed on July 19, 2010.

Petitioner asserts that the Notice dated January 4, 2010 was not received.

A review of the written record indicates no irregularity in the mailing of the Office action, and, in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. In this regard, the showing required to establish the failure to receive the Office action must consist of the following:

- 1. a statement from practitioner stating that the Office action was not received by the practitioner;
- 2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received;
- 3. a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable, and

4. a copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

See MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

The petition satisfies the above-stated requirements. Accordingly, the application was not abandoned in fact.

In view of the above, the Notice of Abandonment is hereby <u>vacated</u> and the holding of abandonment withdrawn.

Further, petitioner may request a refund of the petition fee submitted with the petition on December 20, 2010 by writing to the Office of Finance, Refund Section. A copy of this decision should accompany the request.

This application is being referred to the Technology Center Art Unit 3632 for consideration by the examiner of the Appeal Brief received August 23, 2010.

/KOC/ Karen Creasy Petitions Examiner Office of Petitions 571-272-3208



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Philip G. Meyers Philip G. Meyers Law Office, Suite 300 1009 Long Prairie Road Flower Mound TX 75022

MAILED

FEB 17-2011

OFFICE OF PETITIONS

In re Application of Robert E. Crane

Application No. 11/372541

Filing or 371(c) Date: 03/10/2006

Title of Invention: METHOD AND APPARATUS FOR INSTALLING AN UNDERGROUND PIPE

(ETHOD AND ADDAE

DECISION

ON PETITION

This is a decision on the "Petition for Revival of an Application for Patent Abandoned Unavoidably Under 37 CFR 1.137(a)," filed October 28, 2010.

### This Petition is hereby granted.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due, mailed June 17, 2010, and set a non-extendable three (3) month period for reply. No timely and proper reply having been received, the application became abandoned on September 18, 2010. A Notice of Abandonment was mailed October 4, 2010.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(a) in that (1) the reply in the form of the issue and publication fees; (2) the petition fee; and (3) the required showing of unavoidable delay. Accordingly, the reply is accepted as having been unavoidably delayed.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record<sup>1</sup>.

<sup>&</sup>lt;sup>1</sup> Office records reveal that petitioner filed a Power of Attorney, including a request to change the correspondence address, on October 28, 2010, along with a Statement Under 37 CFR 3.73(b); however, while the Statement Under 37 CFR 3.73(b), including the statement that the person signing the Statement under 37 CFR 3.73(b) was authorized to act on behalf of the assignee, was signed by Kimton N. Eng, the power of attorney, including a request to change the correspondence address, was signed by Robert E. Harr, in his capacity as Owner and Member of the assignee. Power of Attorney, including a request to change the correspondence address, is therefore unacceptable. See, MPEP 434(V)(A).

The application will be referred to the Office of Data Management for processing into a patent in the normal course of business.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods Attorney Office of Petitions

CC: DORSEY & WHITNEY LLP COLUMBIA CENTER, SUITE 1600 701 5<sup>TH</sup> AVENUE SEATTLE, WA 98104-7043





Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

BROOKS KUSHMAN P.C. /Oracle America/SUN/ STK 1000 TOWN CENTER, TWENTY-SECOND FLOOR SOUTHFIELD MI 48075-1238

MAILED DEC 0 8 2010

OFFICE OF PETITIONS

In re Patent No. 7,557,971

Issue Date: July 7, 2009 Application No. 11/372,689

Filed: March 10, 2006

Attorney Docket No. 2005-046-MIS

**DECISION ON PETITION** 

This is a decision on the Request For "Certificate Of Correction", filed September 27, 2010, requesting correction on the Title Page of the subject patent to identify the correct assignee's name and residence. The Request is being treated as a Petition Under 37 CFR §3.81(b). A completed Certificate of Correction Form (PTO/SB/44) was submitted with Petition.

The petition under 37 CFR §3.81(b) is GRANTED.

Petitioner requests that the present Petition was submitted to correct the assignee's name and residence on the previously submitted PTOL 85B. Accordingly, petitioner requests, in effect, that the Title Page of the above-identified patent be corrected, via issuance of Certificate of Correction, to correct the assignee's name identified thereon from:

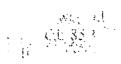
"StorageTek Technology Corporation, Louiville, CO (US)"

to:

--Storage Technology Corporation, Louisville, CO (US) --

37 CFR 3.81(b), effective June 25, 2004, reads:

After payment of the issue fee: Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a) and the processing fee set forth in § 1.17(i) of this chapter.



U.S. Patent No. 7,557,971 Application No. 11/372,689 Decision on Petition under 37 CFR 3.81

Page 2

The requisite \$100.00 fee (Fee Code 1811), as set forth under 37 CFR 1.20(a), has been submitted. However, the \$130.00 processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(i), was accompanied deposit account authorization to charge any required fees. As such, the fee has been charged as authorized. Further, Office assignment records are consistent with the requested correction. Accordingly, since the Petition complies with the provisions of 37 CFR 3.81(b), it is appropriate for the Office to issue a Certificate of Correction in accordance with the content of the Form PTO/SB/44 submitted with Petition.

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

Any questions concerning the issuance of a Certificate of Correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,557,971.

Cheryl Gibson-Baylor Petitions Examiner

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313

# MAILED SEP 2 4 2010 **OFFICE OF PETITIONS**

SIEMENS CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 170 WOOD AVENUE SOUTH ISELIN NJ 08830

In re Patent No. 7,668,354 Issue Date: February 23, 2010 Application No. 11/372,783

Filed: March 10, 2006

Attorney Docket No. 2005P05097 US01

DECISION ON PETITION

This is a decision on the "RE-SUBMITTAL OF REQUEST FOR CERTIFICATE OF CORRECTION UNDER 37 C.F.R. 1.323" filed April 27, 2010.

The petition is GRANTED.

An application may issue in the name of an assignee rather than the applicant if requested prior to issuance of a patent. However, in the event the request is not made prior to issuance, a Certificate of Correction under 37 CFR 1.323 may be requested. A request for a Certificate of Correction under 37 CFR 1.323 to correct the assignee's name will not be granted unless a petition under 37 CFR 3.81(b) is granted. Such request under 37 CFR 3.81(b) should include:

- (A) the processing fee required by 37 CFR 1.17(i);
- (B) a request for issuance of the application in the name of the assignee, or a request that a patent be corrected to state the name of the assignee;

See 37 CFR 3.81.

- (C) a statement that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent; and
- (D) a request for a certificate of correction under 37 CFR 1.323 accompanied by the fee set forth in 37 CFR 1.20(a).

The \$130 processing fee set forth in 37 CFR 1.17(i) has been charged to Deposit Account No. 19-2179, as authorized.

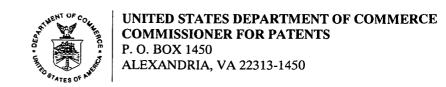
The file is being forwarded to the Certificate of Corrections Branch for issuance of the requested Certificate of Correction.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cell by

Cliff Congo Petitions Attorney Office of Petitions

MPEP 307.



Date : 8/10/2011 Patent No. : 7,793,328 B2 Serial No. : 11/372,813

Inventor(s) : Campbell Issue Date : September 9, 2010

Title : GATEWAY POWER SYNCHRONIZATION

Doc./File No. : 020366-067520US

Re: Consideration for Certificate of Correction

Consideration has been given your request for a certificate of correction, for the above-identified patent under the provisions of Rule 1.322.

Respecting the alleged error(s) in your request, inspection of the file of the application for the patent reveals that the typographical error in figure 3, box 108 is printed in accordance with the record in the Patent and Trademark Office, as passed to issued by the examiner. There being no fault on the part of the Patent and Trademark Office, it has no authority to issue a certificate of correction under the provision of 1.322.

In view of the foregoing, your request for certificate of correction is hereby denied. However, further consideration will be given these matters, upon receipt of a request for certificate of correction under the provisions of 1.323, accompanied by the appropriate fee which is presently \$100.

Future correspondence concerning this matter should be filed and directed to Decisions & Certificates of Correction Branch.

Ernest C. White, *LIE* (571) 572-3385 Mary F. Diggs, *Supervisor* (703) 756-1580 Decisions & Certificates of Correction Branch ernest.white@uspto.gov

Qwest Communications International Inc. 1801 California Street, # 900 Denver CO 80202

**ECW** 



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Quinn Law Group, PLLC 39555 Orchard Hill Place Suite 520 Novi MI 48375

MAILED

AUG 2 4 2010

OFFICE OF PETITIONS

In re Application of

Patrick B. Usoro

Application No. 11/372,909

Filed: March 10, 2006

Atty. Docket No. GP-306856-PTE-CD

**DECISION ON PETITION** 

This is a decision on the petition, filed May 14, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

#### The petition is **DISMISSED**.

The application was held to have gone abandoned for failure to reply in a timely manner to the non-final Office action mailed, August 20, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. A Notice of Abandonment was mailed May 14, 2010.

The petitioner states that a reply to the Office action of August 20, 2009 was filed on September 30, 2009 in the form of Applicant's Summary of Interview with the Examiner. This reply is not a proper reply to the Office action mailed August 20, 2009. It is further noted that the file record does not include any summary of the Interview by the Examiner. Since, no proper reply was filed the application became abandoned on November 21, 2009.

The petition requesting withdrawal of the holding of abandonment cannot be granted at this time.

If petitioner cannot supply the evidence necessary to withdraw the holding of abandonment, or simply does not wish to, petitioner should consider filing a petition under 37 CFR 1.137(b) stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has

been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the \$1,640 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

Mail Stop PETITION

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

By hand:

U. S. Patent and Trademark Office

Customer Service Window, Mail Stop Petitions

Randolph Building 401 Dulany Street Alexandria, VA 22314

By facsimile:

(571) 273-8300

Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to Terri Johnson at (571) 272-2991.

Ramesh Krishnamurthy

Petitions Examiner

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Quinn Law Group, PLLC 39555 Orchard Hill Place Suite 520 Novi MI 48375

MAILED

OCT 05 2010

OFFICE OF PETITIONS

In re Application of

Patrick B. Usoro

Application No. 11/372,909

Filed: March 10, 2006

Atty. Docket No. GP-306856-PTE-CD

**DECISION ON PETITION** 

This is a decision on the renewed petition, filed September 2, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

#### The petition is **GRANTED**.

The application was held abandoned for failure to reply in a timely manner to the non-final Office action mailed, August 20, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. A Notice of Abandonment was mailed May 14, 2010.

The petitioner states that a reply to the corrected/supplemental Office action of August 20, 2009 was filed on September 30, 2009 in the form of Applicant's Summary of Interview with the Examiner. The Applicant's summary of the Interview with the examiner is not acceptable as a response to the Office action of August 20, 2009. However, as stated by the petitioner, "[a]pplicants' response filed 8/11/09 fully addressed the rejections in the supplemental Action dated 8/20/09." It is noted that the applicant's response dated August 11, 2009 was inadvertently not considered in the in the corrected/supplemental Non-final Office action of August 20, 2009.

Accordingly, the holding of abandonment for failure to timely file a reply to the Non-Final Office action of August 20, 2009 is hereby withdrawn.

Telephone inquiries concerning this decision should be directed to Terri Johnson at (571) 272-2991.

The application is being referred to Technology Center AU 3654 for proper consideration on the reply received on August 11, 2009.

/ Ramesh Krishnamurthy/
Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

<del></del>		FOR CERTIFICATE OF CORRECTION
DATE	: <u>July 6, 2010</u>	
TO SPE OF	: ART UNIT <u>3637</u>	·
SUBJECT	: Request for Certificate of Corre	ection for Appl. No/11/0372966 /7475640
,		
Please resp 7 days.	ond to this request for a co	ertificate of correction within
FOR IFW F	ILES:	
the IFW app	ew the requested changes plication image. No new m the claims be changed.	/corrections as shown in the <b>COCIN</b> document(s) in natter should be introduced, nor should the scope or
Please comusing docum	plete the response (see be nent code <b>COCX</b> .	elow) and forward the completed response to scanning
FOR PAPE	R FILES:	
Please revie	ew the requested changes/ Please complete this form	corrections as shown in the attached certificate of (see below) and forward it with the file to:
Certii Rand	ficates of Correction Bra Jolph Square – 9D10-A Location 7580	nch (CofC)
Certii Rand	ficates of Correction Bra olph Square – 9D10-A	nch (CofC)
Certii Rand	ficates of Correction Bra olph Square – 9D10-A	nch (CofC)  Magdalene Talle
Certii Rand	ficates of Correction Bra olph Square – 9D10-A	nch (CofC)  Magdalene Talle
Certii Rand Palm	ficates of Correction Bra olph Square – 9D10-A	nch (CofC)  Magdalene Talle  Certificates of Correction Branch
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Certit Rand Palm Thank You The reques	ficates of Correction Bra lolph Square – 9D10-A Location 7580  For Your Assistance t for issuing the above-ic	nch (CofC)  Magdalene Talle  Certificates of Correction Branch  571-272-0423
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Certit Rand Palm Thank You The reques Note your decision	ficates of Correction Bra lolph Square – 9D10-A Location 7580  For Your Assistance t for issuing the above-ic	Magdalene Talle  Certificates of Correction Branch 571-272-0423  dentified correction(s) is hereby:  All changes apply
Certif Rand Palm  Thank You  The reques  Note your decision	For Your Assistance t for issuing the above-ice on the appropriate box. Approved Approved in Part Denied	Magdalene Talle  Certificates of Correction Branch 571-272-0423  dentified correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.
Certif Rand Palm  Thank You  The reques  Note your decision	For Your Assistance t for issuing the above-ice on the appropriate box. Approved Approved in Part Denied	Magdalene Talle  Certificates of Correction Branch 571-272-0423  dentified correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.
Certif Rand Palm  Thank You  The reques  Note your decision	For Your Assistance t for issuing the above-ice on the appropriate box. Approved Approved in Part Denied	Magdalene Talle  Certificates of Correction Branch 571-272-0423  dentified correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.
Certif Rand Palm  Thank You  The reques  Note your decision	For Your Assistance  t for issuing the above-ice on the appropriate box.  Approved Approved in Part  Denied  Approved. All change	Magdalene Talle  Certificates of Correction Branch 571-272-0423  dentified correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.
Certif Rand Palm  Thank You  The reques  Note your decision	For Your Assistance  t for issuing the above-ice on the appropriate box.  Approved Approved in Part  Denied  Approved. All change	Magdalene Talle  Certificates of Correction Branch 571-272-0423  dentified correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.

PTOL-306 (REV. 7/03)

SPE Art Unit
U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

#### SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Pa	per	No.:	
	ρΨ.		

DATE

: <u>10-13-10</u>

TO SPE OF

: ART UNIT **2471** 

SUBJECT

: Request for Certificate of Correction for Appl. No.: 11373422 Patent No.: 7548559

Please respond to this request for a certificate of correction within 7 days.

#### **FOR IFW FILES:**

Please review the requested changes/corrections as shown in the COCIN document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code COCX.

#### **FOR PAPER FILES:**

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

**Certificates of Correction Branch (C of C)** Randolph Square - 9D10-E Palm Location 7580

> Omega Lewis Certificates of Correction Branch

703-756-1575

-or Your Assistance	
	-identified correction(s) is hereby:
Approved	All changes apply.
Approved in Part	Specify below which changes do not apply.
Denied	State the reasons for denial below.
	0.07
	for issuing the above on the appropriate box.  Approved  Approved in Part



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

REISING ETHINGTON P.C. P O BOX 4390 TROY MI 48099-4390

MAILED

MAR 02 2011

OFFICE OF PETITIONS

In re Patent No. 7,284,528

Application No. 11/373,544

Filed: March 10, 2006

Issued: October 23, 2007

Attorney Docket No. 7534.3012.001

ON PETITION

This is a decision on the petition filed January 24, 2011, which is being treated as a request under 37 CFR 3.81(b)<sup>1</sup> to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

This matter is being referred to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-7751. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (703) 756-1814.

Joan Olszewski Petitions Examiner Office of Petitions

<sup>&</sup>lt;sup>1</sup> See MPEP 1309, subsection II; and Official Gazette of June 22, 2004.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

March 12, 2011

BAKER BOTTS L.L.P.
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN TX 78701-4039

In re Application of

Seo Hong Yoo : **DECISION ON PETITION** 

Application No. 11373554

Filed: 03/10/2006 : *ACCEPTANCE OF COLOR* 

Attorney Docket No. 072852.0150 : DRAWINGS

This is a decision on the Petition to Accept Color Drawings under 37 C.F.R 1.84 (a) (2), received in the United States Patent and Trademark Office (USPTO) March 10, 2006.

The petition is **GRANTED**.

A grantable petition under 37 C.F.R. 1.84(a) (2) must be accompanied by the following.

- 1. The fee set forth under 37 C.F.R. 1.17(h),
- 2. Three (3) sets of the color drawings in question, or (1) set if filed via EFS, and
- 3. The specification contains appropriate language referring to the color drawings as the first paragraph in that portion of the specification relating to the brief description of the drawings.

The petition was accompanied by all of the required fees and drawings. The specification contains the appropriate language. Therefore, the petition is <u>GRANTED</u>.

Telephone inquires relating to this decision may be directed to the undersigned in the Office of Data Management at 571-272-4200.

/Laura Feldman/ Quality Control Specialist Office of Data Management Publications Branch

PETITION TO	ACCEPT UNIN		LY DELAYED P ATENT (37 CFF	AYMENT OF MAINTENANCE FEE IN AN R 1.378(c))	
Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)	
7258129	2007-08-21	11/373,556	2006-03-10	4459P3044	
				ntify: (1) the patent number and (2) the application number e(s) is/are associated with the correct patent. 37 CFR	
	ims, or has previously		ity status. See 37 CI	FR 1.27.	
	EMENT TO SMALL EN no longer entitled to sm		See 37 CFR 1.27(g)		
NOT Small Entity			Small Entity		
Fee	Code		Fee  3 ½ year	Code (2551)	
○ 3½ year ○ 7½ year	(1551) (1552)		7 1/ year	(2552)	
- 4414	,		11 ½ year	(2553)	
SURCHARGE	(1000)			, ,	
		)(2) (Fee Code 1	558) must be paid as	a condition of accepting unintentionally delayed payment	
	EE (37 CFR 1.20(e)-(g aintenance fee must be		nis petition.		
STATEMENT THE UNDERSIGN UNINTENTIONAL	THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS				
PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED					
THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES					
37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."					
I certify, in accordance with 37 CFR 1.4(d)(4) that I am					
An attorney or agent registered to practice before the Patent and Trademark Office					
A sole patentee					
A joint pater	ntee; I certify that I am	authorized to sign	this submission on b	ehalf of all the other patentees.	
A joint patentee; all of whom are signing this e-petition					
The assignee of record of the entire interest					

Approved for use through 03/31/2012. OMB 0651-0016 U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner				
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature				
Signature /Jeffrey D. Moy/ Date (YYYY-MM-DD) 2011-09-19				
Name Jeffrey D. Moy Registration Number 39307				

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.

### **Privacy Act Statement**

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

- 1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.
- A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
- 3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
- 4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
- 5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
- 6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
- 7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
- 8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
- 9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

In re Patent No. 7258129

Issue Date:

August 21,2007

Application No. 11373556

Filed:

March 10,2006

Attorney Docket No. 4459P3044

:DECISION GRANTING PETITION

:UNDER 37 CFR 1.378(c)

September 19,2011 ,under 37 CFR 1.378(c) This is a decision on the electronic petition, filed to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

September 19,2011 The maintenance fee is accepted, and the above-identified patent reinstated as of This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

www.uspto.gov

McDermott Will & Emery LLP 600 13th Street, NW Washington DC 20005-3096 MAILED
MAY 25 2011

OFFICE OF PETITIONS

In re Application of

Chen et al.

Application No. 11/373,641 : RESPONSE TO PETITION

Filed: March 9, 2006

Attorney Docket No. 087124-0748

This is a response to the petition under 37 CFR 1.59(b), filed March 29, 2011, to expunge information from the above identified application.

The petition is granted.

On March 3, 2011, a Response to Notice to File Missing Parts of Nonprovisional Application (Response) was filed in the above-identified application. The Amendment was intended for U.S. Application No. 13/004,702 but was matched with the above identified application. Petitioner now requests that this amendment be removed from the file of the above identified application.

Upon a showing satisfactory to the Director, information, other than that forming part of the original disclosure, may be expunged from an application. Since the Office can determine the correct application file for which the erroneously filed papers were intended from the other identifying information on the papers, the papers will be removed as requested.

It is agreed that it would be appropriate in this instance to close the unintentionally filed Response filed March 2, 2011 in the above identified application, and also remove such from the listing of publicly available documents for this Image File Wrapper (IFW).

Telephone inquiries concerning this communication should be directed to the undersigned at (571) 272-6692.

Christopher Bottorff Petitions Examiner Office of Petitions



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
11/373,684	03/10/2006	Richard A. Friesner	17367-004001	7995	
7590 02/15/2012 FISH & RICHARDSON P.C. (BO) P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER BORIN, MICHAEL L		
			1631		
			02/15/2012	ELECTRONIC	

#### **ACKNOWLEDGEMENT OF REQUEST**

Notice of Allowance/Allowability Mailed

The request to print a color drawing reference as the first paragraph in the portion of the specification containing a brief description of the drawings as required by 37 CFR 1.84 and MPEP § 608.02 has been received by the United States Patent and Trademark Office and will be entered into the specification.

571-272-4200 or 1-888-786-0101 Application Assistance Unit Office of Data Management

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

February 15, 2012

FISH & RICHARDSON P.C. (BO) P.O. BOX 1022 MINNEAPOLIS MN 55440-1022

In re Application of

Richard A. Friesner et al. : **DECISION ON PETITION** 

Application No. 11373684 :

Filed: 3/10/2006 : ACCEPTANCE OF COLOR

Attorney Docket No. 17367-004001 : DRAWINGS

This is a decision on the Petition to Accept Color Drawings under 37 C.F.R 1.84 (a) (2), received in the United States Patent and Trademark Office (USPTO) May 9, 2006.

The petition is **GRANTED**.

A grantable petition under 37 C.F.R. 1.84(a) (2) must be accompanied by the following.

- 1. The fee set forth under 37 C.F.R. 1.17(h),
- 2. Three (3) sets of the color drawings in question, or (1) set if filed via EFS, and
- 3. The specification contains appropriate language referring to the color drawings as the first paragraph in that portion of the specification relating to the brief description of the drawings.

The petition was accompanied by all of the required fees and drawings. The specification contains the appropriate language. Therefore, the petition is <u>GRANTED</u>.

Telephone inquires relating to this decision may be directed to the undersigned in the Office of Data Management at 571-272-4200.

/Don Fairchild/
Office of Data Management
Publications Branch



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 2213-1450

Louis C. Paul & Associates, PLLC 150 East 58th Street 34th Floor New York NY 10155

**MAILED** 

MAR 14 2011

OFFICE OF PETITIONS

In re Application of

Gervasio

Application No. 11/373,731

Filed: March 10, 2006

Attorney Docket No. 563-1001-201

For: COSMETIC COMPOSITIONS AND

CONTAINER THEREFOR

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed November 15, 2010, to revive the above-identified application.

The petition under 37 CFR 1.137(b) is **GRANTED**.

This application became abandoned for failure to timely reply to the final Office action, mailed January 12, 2010, which set a three month period for reply. No proper extensions of time having been obtained pursuant to 37 CFR 1.136(a), this application became abandoned on April 13, 2010. A Notice of Abandonment was mailed on July 21, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a continuing application under 37 CFR 1.53(b); (2) the petition fee of \$810.00; and (3) a proper statement of unintentional delay.

The above-identified application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the above-identified application, the above-identified application is again abandoned in favor of continuation Application No. 12/833,208, filed July 9, 2010.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the \$555.00 extension of time fee submitted with the petition on November 15, 2010 was submitted subsequent to the expiration of the maximum extendable period for reply, this fee is unnecessary and will be refunded to petitioner's credit card.

After the mailing of this decision, the application will be returned to Files Repository.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley
Senior Petitions Attorney

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

UNISYS CORPORATION UNISYS WAY MAIL STATION: S1-108 BLUE BELL PA 19424

MAILED

OCT 2 0 2010

OFFICE OF PETITIONS

In re Application of

Mazzagatti

Application No. 11/373,733

Filed: March 10, 2006

Attorney Docket No. TN465

: DECISION ON PETITION

UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition under 37 CFR 1.78(a)(3), filed July 6, 2010, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the concurrently filed amendment.

#### The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

The amendment fails to comply with the provisions of 37 CFR 1.78(a)(2)(i) and is therefore unacceptable. There is no continuity between the instant application and Application No. 10/385,421. Application No. 10/385,421 was filed on March 10, 2003 and issued as Patent No. 6,961,733 on November 1, 2005. The instant application was filed on March 10, 2006. Therefore, there is no continuity between the two applications.

It is noted that Application No. 10/666,382 was filed September 19, 2003 and issued as Patent No. 7,158,975 on January 2, 2007 and is a continuation-in-part of Application No. 10/385,421. Application No. 10/666,382 is the missing link in the continuity chain.

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition under 37 CFR § 1.78(a)(3) an Application Data Sheet or a substitute amendment (complying with 37 CFR 1.121 and 37 CFR 1.76(b)(5)), are required.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop PETITIONS

Commissioner for Patents Post Office Box 1450

Alexandria, VA 22313-1450

By hand:

Customer Service Window

Mail Stop Petitions Randolph Building 401 Dulany Street Alexandria, VA 22314

By fax:

(571) 273-8300

ATTN: Office of Petitions

By internet:

EFS-Web

www.uspto.gov/ebc/efs\_help.html (for help using EFS-Web call the Patent Electronic Business Center

at (866) 217-9197)

Any questions concerning this matter may be directed to the undersigned at (571) 272-3230.

Shure Willis Breafles
Shirene Willis Brantley

Senior Petitions Attorney

Office of Petitions

Paper No.:

#### SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE	:	03/29/11
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TO SPE OF : ART UNIT 3726

SUBJECT: Request for Certificate of Correction for Appl. No.: 11/373.734 Patent No.: 7,827,690

CofC mailroom date: 12/23/10

Please respond to this request for a certificate of correction within 7 days.

#### **FOR IFW FILES:**

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

### **FOR PAPER FILES:**

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC) Randolph Square – 9D10-A Palm Location 7580

RoChaun Johnson
Certificates of Correction Branch

703-756-1580

#### Thank You For Your Assistance

# The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

□ Approved All changes apply.

X Approved in Part Specify below which changes do not apply.

☐ **Denied** State the reasons for denial below.

Comments: The requested change to claim 19 is approved as being a typographical error made by the Office (the original claim language read "to form said collector"). The requested change to claim 10 is DENIED, since it changes the dependency of the claim from claim 2 to claim 11. As required by 35 USC 112, 4<sup>th</sup> paragraph, "a claim in dependent form shall contain a reference to a claim previously set forth." With the requested change, claim 10 would depend from later (and thus not "previously set forth") claim 11, which is in violation of 35 USC 112. The requested change to claim 18 is DENIED, since the change would result in the patent including two duplicate claims (claim 10 and claim 18, both

/David P. Bryant/ SPE, Art Unit 3726

dependent on claim 2).

### SPE RESPONSE FOR CERTIFICATE OF CORRECTION

	SEL RESEON	NSET ON CENTILICATE OF CONNECTION
		<b>Paper No</b> .:20110314A
DATE	: March 14, 2011	
TO SPE C	OF: ART UNIT 1645	
SUBJECT	Γ : Request for Certificate of	of Correction on Patent No.: 7858589
A response	e is requested with respect to the	ne accompanying request for a certificate of correction.
Certificat	mplete this form and return vestion Branch - Station 7590 - Tel. No. (703) 30	ST (South Tower) 9A22
read as she		correcting Office and/or Applicant's errors, should the patent on? No new matter should be introduced, nor should the scope or
Thank Yo	ou For Your Assistance	Certificates of Correction Branch
-	est for issuing the above-ic sion on the appropriated box.	dentified correction(s) is hereby:
$\boxtimes$	Approved	All changes apply.
	Approved in Part	Specify below which changes do not apply.
	Denied	State the reasons for denial below.
Commen	ts:	
		/GARY NICKOL/ Supervisory Patent Examiner.Art Unit 1646



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OGILVY RENAULT LLP 1, Place Ville Marie SUITE 2500 MONTREAL QC H3B 1R1 CANADA

MAILED

MAR 032011

OFFICE OF PETITIONS

In re Application of

LEACH et al.

Application No. 11/374,177

Filed: 03/14/2006

Attorney Docket No. 17720-41US MCG/bs

Christina Partera Donnell

**NOTICE** 

This is a Notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed January 27, 2011.

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell Senior Petitions Attorney

Office of Petitions





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

MAILED JAN 20 2011 **OFFICE OF PETITIONS** 

**ROSS J OEHLER** CEPHALON, INC. 41 MOORES ROAD PO BOX 4011 FRAZER PA 19355

In re Application of Prat, et al.

Application No. 11/374,227

Filed: March 13, 2006

Attorney Docket Number: CFP369

ON REQUEST FOR

**RECONSIDERATION OF** 

PATENT TERM ADJUSTMENT

This is a decision on the petition under 37 CFR 1.705(b), filed December 6, 2010. Applicants believe that they should be accorded an additional PTA of 268 days. Applicants request this correction on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment solely as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as** PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file a request for reconsideration of patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee<sup>1</sup>.

In view thereof, the correct determination of PTA prior to issuance is three hundred fifty-seven (357) days.

The application is being forwarded to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Petitions Attorney Cliff Congo at (571) 272-3207.

Anthony Knight

Director

Office of Petitions

For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the \\$1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

Mitra Tadayoni-Rebek 2330 Calle Del Oro La Jolla CA 92037-3034

**MAILED** 

AUG 1 2 2010

**OFFICE OF PETITIONS** 

In re Application of

MITRA TADAYONI-REBEK

Application No. 11/374,294

Filed: November 5, 2004 Attorney Docket No. **ON PETITION** 

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed July 6, 2010, to revive the above-identified application.

### The petition is **DISMISSED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed October 28, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on January 29, 2010.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item(s) (1).

## As to item (1)

Petitioner has not submitted nor previously filed the required reply (Amendment) to the non-final Office action mailed on October 28, 2009. Therefore, petitioner must submit the required reply (Amendment) before the application can be revived.

Any request for reconsideration of this decision must be submitted within **TWO** (2) **MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

Mail Stop PETITION

**Commissioner for Patents** 

P. O. Box 1450

Alexandria, VA 22313-1450

By hand:

U. S. Patent and Trademark Office

Customer Service Window, Mail Stop Petitions

Randolph Building 401 Dulany Street Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4584

/JoAnne Burke/
JoAnne Burke
Petitions Examiner
Office of Petitions





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

DITTHAVONG MORI & STEINER, P.C. 918 Prince Street
Alexandria VA 22314

MAILED

In re Application of

JAN 12 2011

Albanese, et al.

**OFFICE OF PETITIONS** 

Application No. 11/374,414

**DECISION ON PETITION** 

Filed: March 13, 2006

Attorney Docket No. P3635US07

This is a decision on the petition under 37 CFR §1.137(b), filed November 24, 2010, to revive the above-identified application.

The petition is granted.

This application became abandoned for failure to timely remit the issue fee of \$1510.00 as required by the Notice of Allowance and Issue Fee Due (the "Notice") mailed January 26, 2010. The Notice set forth a three (3) month statutory period for reply. No response was received within the allowable period. Accordingly, this application became abandoned on April 27, 2010. A Notice of Abandonment was mailed on May 24, 2010.

The issue fee was received on November 24, 2010.

Form PTOL-85B, filed November 24, 2010, is noted and made of record.

The application is being directed to the Office of Data Management for further processing.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Petitions Attorney Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON VA 20190

MAILED

AUG 0 5 2010

**OFFICE OF PETITIONS** 

In re Application of

Joseph Kenneth Wynne, et al.

Application No. 11/374,421

Filed: March 14, 2006

Attorney Docket No. 02940321PB

**DECISION GRANTING PETITION** 

UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed, August 4, 2010 to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on July 1, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>

Telephone inquiries should be directed to Terri Johnson at (571) 272-2991.

This application is being referred to Technology Center AU 1794 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

Terri Johnson
Petitions Examiner
Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.

Doc Code: PET.PTA.RCAL

**Document Description: Request for Recalculation in view of Wyeth** 

PTO/SB/131 (02-10) Approved for use through 07/31/2010. OMB 0651-0020

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

Attorney Docket Number: CISCP674C1			
Application Number: 11/374,454	Filing Date (or 371(b) or (f) Date): March 13, 2006		
Patent Number: 7,668,101	February 23, 2010		
First Named Alireza Raissinia			
Title: ARQ in a Point to Multipoint Network			

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-WYETH INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

Signature /Thomas J. Frame/	Date August 4, 2010			
Name (Print/Typed) Thomas J. Frame	Registration Number 47,232			
Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below*.				
*Total of forms are submitted.				

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

# Instruction Sheet for: REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

(Not to be Submitted to the USPTO)

This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A).

This form must be filed within 180 days of the day the patent was granted, with the following exception:

Patentees who received a decision from the USPTO under the USPTO's pre-<u>Wyeth</u> interpretation of 35 U.S.C. 154(b)(2)(A) may file a request for reconsideration of that decision if such a request for reconsideration is filed within **two months** of the date of the decision (37 CFR 1.181(f)). If the patentee's sole basis for requesting reconsideration of the decision is the USPTO's pre-<u>Wyeth</u> interpretation of 35 U.S.C. 154(b)(2)(A), the request for reconsideration need only state that reconsideration is being requested in view of <u>Wyeth</u> (this form may be used for this purpose if it is filed within **two months** of the date of the decision from the USPTO).

Do not use this form if the application has been allowed, but not yet issued as a patent.

- 1. For patents issued before March 2, 2010: A request for reconsideration under 37 CFR 1.705(d) and the fee set forth in 37 CFR 1.18(e) are not required, provided that the patentee's sole basis for requesting recalculation of the PTA in the patent is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A) and this form is filed within 180 days of the day the patent was granted.
- 2. For patents issued on or after March 2, 2010 (do not use this form): Patentees seeking a revised PTA in a patent issued on or after March 2, 2010, must file a request for reconsideration under 37 CFR 1.705(d) that complies with the requirements of 37 CFR 1.705(b)(1) and (b)(2) within two months of the day the patent issued.

For more information, see "Notice Concerning Calculation of the Patent Term Adjustment With Respect to the Overlapping Delay Provision of 35 U.S.C. 154(b)(2)(A)" available on the USPTO Web site at http://www.uspto.gov/patents/law/notices/2010.jsp.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

### **Privacy Act Statement**

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

- The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
- 2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
- A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
- 4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
- 5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
- 6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
- 7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
- 8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
- 9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/17/2010

Cindy S. Kaplan P.O. BOX 2448 SARATOGA, CA 95070

Applicant : Alireza Raissinia

Patent Number: 7668101 : 02/23/2010 Issue Date

Application No: 11/374,454 Filed : 03/13/2006 : DECISION ON REQUEST FOR : RECALCULATION of PATENT

: TERM ADJUSTMENT IN VIEW

: OF WYETH AND NOTICE OF INTENT TO

: ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 949 days. The USPTO will sua sponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

# BAXTER INTERNATIONAL INC. ONE BAXTER PARKWAY DEERFIELD IL 60015

MAILED
MAR 1 2 2012
OFFICE OF PETITIONS

In re Application of

Lorraine B. Peddada et al

Application No. 11/374,484 : DECISION ON PETITION

Filed: March 9, 2006

Attorney Docket No. B1:00424

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 24, 2012, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely pay the issue and publication fees on or before November 1, 2011 as required by the Notice of Allowance mailed August 1, 2011. A Notice of Abandonment was mailed on November 14, 2011.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of the issue and publication fees; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice of Allowance mailed August 1, 2011, is accepted as having been unintentionally delayed.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This application is being referred to the Office of Data Management to be processed into a patent.

/KOC/ Karen Creasy Petitions Examiner Office of Petitions

Cc:

JOHN W. PECK 2400 E. KATELLA, SUITE 1050 ANAHEIM, CA 92806



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.usplo.gov

LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD NJ 07090

MAILED

JUL 05 2011

**OFFICE OF PETITIONS** 

In re Patent No. 7,437,342

Issue Date: October 14, 2008

Application No. 11/374,487

Filed: March 13, 2006

Attorney Docket No. INSTAK 3.0-001 DIV

**NOTICE** 

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to Diane Goodwyn at (571) 272-6735.

Thurman K. Page

Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

September 21, 2011

Rene A. Vazquez Sinergia Technology Law Group, PLLC 127 South Main Street Marlborough CT 06447

In re Application of

Thomas E. Ramsay et al. : **DECISION ON PETITION** 

Application No. 11374612 :

Filed: 03/14/2006 : *ACCEPTANCE OF COLOR* 

Attorney Docket No. **GTI-0020** : **DRAWINGS** 

This is a decision on the Petition to Accept Color Drawings under 37 C.F.R 1.84 (a) (2), received in the United States Patent and Trademark Office (USPTO) March 14, 2006.

The petition is **GRANTED**.

A grantable petition under 37 C.F.R. 1.84(a) (2) must be accompanied by the following.

- 1. The fee set forth under 37 C.F.R. 1.17(h),
- 2. Three (3) sets of the color drawings in question, or (1) set if filed via EFS, and
- 3. The specification contains appropriate language referring to the color drawings as the first paragraph in that portion of the specification relating to the brief description of the drawings.

The petition was accompanied by all of the required fees and drawings. The specification contains the appropriate language. Therefore, the petition is <u>GRANTED</u>.

Telephone inquires relating to this decision may be directed to the undersigned in the Office of Data Management at 571-272-4200.

/Laura Feldman/ Quality Control Specialist Office of Data Management Publications Branch



COMMISSIONER FOR PATENTS UNITED STATES PATENT AND TRADEMARK OFFICE P.O. Box 1450 ALEXANDRIA, VA 22313-1450

Paper No.

PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK NJ 08933-7003

**MAILED** 

OCT 0.4 2010

OFFICE OF PETITIONS

In re Application of

Mabus et al.

Application No. 11/374,683

ON APPLICATION FOR

June 27, 2006 PATENT TERM ADJUSTMENT Filed:

Atty Docket No. PRD2455USNP1

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b) WITHIN THREE MONTHS OF RECEIPT OF THE NOTICE OF ALLOWANCE filed May 10, 2010. Applicants request that the determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from two hundred twenty-three (223) days to at least three hundred twenty-eight (328) days.

The application for patent term adjustment is GRANTED.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is three hundred twenty-eight (328) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On March 9, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 223 days. On May 10, 2010, applicants timely submitted an application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is 328 Applicants point out that the patent term adjustment was calculated based on an incorrect filing date of June 27, 2006. Applicants assert that using the filing date of March 14, 2006,

 $<sup>^{</sup>m l}$  PALM records indicate that the Issue Fee payment was received on June 9, 2010.

as corrected by the decision on petition mailed October 5, 2006; the initial determination of patent term adjustment is 328 days.

It appears that a terminal disclaimer was filed in this application on January 14, 2010, but not approved.

Applicants are correct. Pursuant to the decision of October 5, 2006, the filing date of this application has now been corrected in the records of the USPTO to March 14, 2006 (This is now reflected in PALM, as shown in the header of the enclosed PALM Intranet PTA calculation screen; and as of receipt of this decision, applicants should have received a corrected filing receipt). Given the correction of the filing date, the Office delay pursuant to 37 CFR 1.702(a)(1) and 1.703(a)(1) has been corrected from 281 days to 386 days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is three hundred twenty-eight (328) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification, mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded). The revised calculation at issuance should be based on the correct filing date of March 14, 2006.

Telephone inquiries specific to this matter should be directed to the underspigned at (571) 272-3219.

Nancy Johnson

Senjor Petitions Attorney

21mal7

Office of Petitions

Enclosure: Copy of REVISED PALM Screen

Day : Wednesday



# PALM INTRANET

Date: 9/29/2010 Time: 09:35:11

PTA Calculations for Application: <u>11/374683</u>						
Application Filing Date:	03/14/2006	PTO Delay (PTO):	281			
Issue Date of Patent:		Three Years:	0			
Pre-Issue Petitions:	0	Applicant Delay (APPL):	58			
Post-Issue Petitions:	0	Total PTA (days):	328			
PTO Delay Adjustment:	105					

	File Contents History						
Number	Date	Contents Description	PTO	APPL	START		
93	07/27/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	386				
92	07/27/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		281			
77	03/09/2010	MAIL NOTICE OF ALLOWANCE					
76	03/02/2010	ISSUE REVISION COMPLETED					
75	03/02/2010	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED					
74	03/02/2010	CASE DOCKETED TO EXAMINER IN GAU					
73	03/02/2010	DOCUMENT VERIFICATION					
72	03/02/2010	EXAMINER'S AMENDMENT COMMUNICATION					
71	02/25/2010	NOTICE OF ALLOWABILITY					
58	01/14/2010	TERMINAL DISCLAIMER FILED		0	56		
57	02/19/2010	DATE FORWARDED TO EXAMINER					
56	01/14/2010	RESPONSE AFTER NON-FINAL ACTION		28	54		
55	01/14/2010	REQUEST FOR EXTENSION OF TIME - GRANTED					
54	09/17/2009	MAIL NON-FINAL REJECTION					
53	09/14/2009	NON-FINAL REJECTION					
52	08/04/2009	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE					
		DATE FORWARDED TO EXAMINER					
50	07/21/2009	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE					
		DATE FORWARDED TO EXAMINER					
48	07/21/2009	REQUEST FOR CONTINUED EXAMINATION (RCE)					
47	07/23/2009	DISPOSAL FOR A RCE / CPA / R129					
46	07/21/2009	WORKFLOW - REQUEST FOR RCE - BEGIN					
45	04/27/2009	MAIL FINAL REJECTION (PTOL - 326)					

44	04/24/2009	FINAL REJECTION			][]
43	02/24/2009	DATE FORWARDED TO EXAMINER .			
42	01/09/2009	RESPONSE AFTER NON-FINAL ACTION		30	40
41	01/09/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			
40	09/10/2008	MAIL NON-FINAL REJECTION			
39	09/09/2008	NON-FINAL REJECTION			
34	10/13/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
28	07/21/2008	DATE FORWARDED TO EXAMINER			
27	07/01/2008	RESPONSE TO ELECTION / RESTRICTION FILED			
26	06/03/2008	MAIL RESTRICTION REQUIREMENT	281		-1
25	06/02/2008	REQUIREMENT FOR RESTRICTION / ELECTION			
24	09/12/2007	CASE DOCKETED TO EXAMINER IN GAU			
23	07/31/2007	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
22	06/27/2006	NEW OR ADDITIONAL DRAWING FILED			
21	06/27/2006	PRELIMINARY AMENDMENT		,	
20	01/25/2007	PG-PUB ISSUE NOTIFICATION			
19	10/13/2006	REFERENCE CAPTURE ON IDS			
18.7	10/13/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
18		INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
17	10/16/2006	APPLICATION RETURN FROM OIPE			
16	10/16/2006	APPLICATION IS NOW COMPLETE			
15	10/05/2006	MAIL-RECORD PETITION DECISION OF GRANTED RELATED TO FILING DATE			
14	06/27/2006	PETITION ENTERED			
13	07/25/2006	APPLICATION RETURN TO OIPE			
12	07/21/2006	APPLICATION DISPATCHED FROM OIPE			
11	07/24/2006	APPLICATION IS NOW COMPLETE			
10	06/27/2006	ADDITIONAL APPLICATION FILING FEES			
9		A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
8	06/27/2006	DRAWING PRELIMINARY AMENDMENT			

Search Another: Application#

Search

**EXPLANATION OF PTA CALCULATION** 



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 10/29/2010

QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121

Applicant: Perry Willmann Remaklus JR.: DECISION ON REQUEST FORPatent Number: 7586805: RECALCULATION of PATENTIssue Date: 09/08/2009: TERM ADJUSTMENT IN VIEW

Application No: 11/374,838 : OF WYETH AND NOTICE OF INTENT TO Filed : 03/14/2006 : ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be  $\mathbf{293}$  days. The USPTO will suasponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

CHRISTIE PARKER & HALE LLP POST OFFICE BOX 7068 PASADENA, CA 91109-7068

MAILED NOV 08 2011

In re Application of Hyung Bok Lee et al Application No. 11/374,857 Filed: March 13, 2006

Attorney Docket No. 56980/S1170

OFFICE OF PETITIONS

: DECISION GRANTING PETITION

: UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed, November 3, 2011 to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on September 24, 2011 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 1726 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/
Irvin Dingle
Petitions Examiner
Office of Petitions

<sup>&</sup>lt;sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO	
11/374,969	03/15/2006	Tamar Lotan	. 31530 , 106		
;	7590 03/18/2011		EXAM	INER	
MARTIN D. MO P.O. BOX 1644	YNIHAN d/b/a PRTSI,	INC.	AZPURU, (	CARLOS A	
ARLINGTON, V	=		ART UNIT	PAPER NUMBER	
			1617		
			MAIL DATE	DELIVERY MODE	
			03/18/2011	PAPER	

### **ACKNOWLEDGEMENT OF REQUEST**

Notice of Allowance/Allowability Mailed

The request to print a color drawing reference as the first paragraph in the portion of the specification containing a brief description of the drawings as required by 37 CFR 1.84 and MPEP § 608.02 has been received by the United States Patent and Trademark Office and will be entered into the specification.

571-272-4200 or 1-888-786-0101 Application Assistance Unit Office of Data Management



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

March 17, 2011

MARTIN D. MOYNIHAN d/b/a PRTSI, INC. P.O. BOX 16446 ARLINGTON VA 22215

In re Application of

Tamar Lotan, et al : **DECISION ON PETITION** 

Application No. 11374969 :

Filed: 03/15/06 : ACCEPTANCE OF COLOR

Attorney Docket No. 31530 : DRAWINGS

This is a decision on the Petition to Accept Color Drawings under 37 C.F.R 1.84 (a) (2), received in the United States Patent and Trademark Office (USPTO) March 15, 2006.

The petition is **GRANTED**.

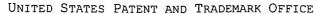
A grantable petition under 37 C.F.R. 1.84(a) (2) must be accompanied by the following.

- 1. The fee set forth under 37 C.F.R. 1.17(h),
- 2. Three (3) sets of the color drawings in question, or (1) set if filed via EFS, and
- 3. The specification contains appropriate language referring to the color drawings as the first paragraph in that portion of the specification relating to the brief description of the drawings.

The petition was accompanied by all of the required fees and drawings. The specification contains the appropriate language. Therefore, the petition is GRANTED.

Telephone inquires relating to this decision may be directed to the undersigned in the Office of Data Management at 571-272-4200.

/Laura Feldman/ Quality Control Specialist Office of Data Management Publications Branch





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MARTIN D. MOYNIHAN d/b/a PRTSI, INC. P.O. BOX 16446 ARLINGTON, VA 22215

MAILED

APR 04 2011

OFFICE OF PETITIONS

In re Application of

Tamar Lotan, et al.

Application No.: 11/374,969

Filed: March 15, 2006

Attorney Docket No.: 31530

ON PETITION

This is a decision on the petition, filed March 31, 2011, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is not signed by an attorney of record. Nevertheless, in accordance with 37 CFR 1.34, the signature of Mr. Jason H. Rosenblum appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on November 18, 2010, cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. \(^1\)

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 1617 for further processing of the Request for Continued Examination (RCE) under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement (IDS).

/SDB/

Sherry D. Brinkley Petitions Examiner Office of Petitions

<sup>&</sup>lt;sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s)
Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

In re Patent No. 7222430

Issue Date:

May 29,2007

Application No. 11375032

:DECISION GRANTING PETITION

:UNDER 37 CFR 1.378(c)

Filed:

March 15,2006

Attorney Docket No. BANDOCK, JOSEPH J, JR.

March 30,2012 This is a decision on the electronic petition, filed ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

March 30,2012 The maintenance fee is accepted, and the above-identified patent reinstated as of This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Approved for use through 03/31/2012. OMB 0651-0016

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION IC	ACCEPI UNIN		PATENT (37 CFI	RAYMENT OF MAINTENANCE FEE IN AN R. 1.378(c))	
Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)	
7222430	2007-05-29	11375032	2006-03-15	Bandock 28043.001	
of the actual U.S. a 1.366(c) and (d).				rifiy: (1) the patent number and (2) the application number e(s) is/are associated with the correct patent. 37 CFR	
SMALL ENTITY  Patentee cla	ims, or has previously	claimed, small en	itity status. See 37 Cl	FR 1.27.	
	EMENT TO SMALL Et no longer entitled to sm		See 37 CFR 1.27(g)		
NOT Small Entity			Small Entity		
Fee 3 14 year	Code (1551)		Fee 3 ½ year	Code (2551)	
3 ½ year 7 ½ year	(1551) (1552)		7 ½ year	(2552)	
11 ½ year	, ,		11 ½ year	,	
SURCHARGE The surcharge req of the maintenance		i)(2) (Fee Code 1	   1558) must be paid as	a condition of accepting unintentionally delayed payment	
	EE (37 CFR 1.20(e)-(g aintenance fee must b		this petition.		
STATEMENT THE UNDERSIGN UNINTENTIONAL		THE DELAY IN	PAYMENT OF THE N	MAINTENANCE FEE TO THIS PATENT WAS	
PETITIONER(S) F REINSTATED	REQUEST THAT THE	DELAYED PAYM	ENT OF THE MAINTI	ENANCE FEE BE ACCEPTED AND THE PATENT	
THIS PORTION M	IUST BE COMPLETED	BY THE SIGNA	TORY OR SIGNATOR	RIES	
	states: "Any petition un fice, or by the patented			ttorney or agent registered to practice before the Patent st."	
I certify, in accorda	ance with 37 CFR 1.4(	d)(4) that I am			
An attorney	or agent registered to	practice before th	e Patent and Tradem	ark Office	
A sole pater	ntee				
A joint pater	ntee; I certify that I am	authorized to sigr	n this submission on b	ehalf of all the other patentees.	
A joint pater	ntee; all of whom are s	igning this e-petiti	on		
The assignee of record of the entire interest					

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

	Patent Practitioner						
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature							
Signature	/William A. Jeckle/	Date (YYYY-MM-DD)	2012-03-30				
Name	William A. Jeckle	Registration Number	55825				

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.

# **Privacy Act Statement**

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

- 1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.
- A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
- 3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
- 4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
- 5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
- 6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
- 7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
- 8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
- 9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Doc Code: PET.PTA.RCAL

**Document Description: Request for Recalculation in view of Wyeth** 

Approved for use through 02/28/2011. OMB 0651-0020

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

Attorney Docket Patent Number: 7,658,228 3658-1006 Number: Filing Date Issue Date: 09-Feb-2010 (or 371(b) or (f) Date): 15-Mar-2006

First Named Inventor:

MOKSVOLD, Harald

Title: HIGH PRESSURE SYSTEM

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-WYETH INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

Signature /Benoit Castel/	Date August 3, 2010
Name (Print/Typed) Benoit Castel	Registration Number 35041

Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature,

~	*Total of1	forms are submitted
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The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

# Instruction Sheet for: REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

(Not to be Submitted to the USPTO)

This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A).

This form must be filed within 180 days of the day the patent was granted, with the following exception:

Patentees who received a decision from the USPTO under the USPTO's pre-<u>Wyeth</u> interpretation of 35 U.S.C. 154(b)(2)(A) may file a request for reconsideration of that decision if such a request for reconsideration is filed within **two months** of the date of the decision (37 CFR 1.181(f)). If the patentee's sole basis for requesting reconsideration of the decision is the USPTO's pre-<u>Wyeth</u> interpretation of 35 U.S.C. 154(b)(2)(A), the request for reconsideration need only state that reconsideration is being requested in view of <u>Wyeth</u> (this form may be used for this purpose if it is filed within **two months** of the date of the decision from the USPTO).

Do not use this form if the application has been allowed, but not yet issued as a patent.

- 1. For patents issued before March 2, 2010: A request for reconsideration under 37 CFR 1.705(d) and the fee set forth in 37 CFR 1.18(e) are not required, provided that the patentee's sole basis for requesting recalculation of the PTA in the patent is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A) and this form is filed within 180 days of the day the patent was granted.
- 2. For patents issued on or after March 2, 2010 (do not use this form): Patentees seeking a revised PTA in a patent issued on or after March 2, 2010, must file a request for reconsideration under 37 CFR 1.705(d) that complies with the requirements of 37 CFR 1.705(b)(1) and (b)(2) within two months of the day the patent issued.

For more information, see "Notice Concerning Calculation of the Patent Term Adjustment With Respect to the Overlapping Delay Provision of 35 U.S.C. 154(b)(2)(A)" available on the USPTO Web site at http://www.uspto.gov/patents/law/notices/2010.jsp.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

#### Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

- 1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
- 2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
- A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record
- 4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
- 5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
- 6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
- 7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
- 8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
- 9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/11/2010

YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314

Applicant : Harald Moksvold

Patent Number: 7658228 Issue Date : 02/09/2010

Application No: 11/375,061 Filed : 03/15/2006 : DECISION ON REQUEST FOR : RECALCULATION of PATENT

: TERM ADJUSTMENT IN VIEW : OF WYETH AND NOTICE OF INTENT TO

: ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 801 days. The USPTO will suasponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

# STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON DC 20036

MAILED

JUL 072011

OFFICE OF PETITIONS

In re Patent No. 7,470,062

Issued: December 30, 2008

Application No. 11/375,131

Filed: March 15, 2006

Attorney Docket No. 29302.0046 D1

ON PETITION

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed June 10, 2011.

On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-7751.

/Joan Olszewski/ Joan Olszewski Petitions Examiner Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

K&L GATES LLP 210 SIXTH AVENUE PITTSBURGH, PA 15222-2613

MAILED

JAN 182011

In re Application of

Steven A. SCHNUR, et al. Application No. 11/375,155 Filed: March 14, 2006 Attorney Docket No. **060104**  OFFICE OF PETITIONS
DECISION ON PETITION TO
WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 3, 2010.

The request is **NOT APPROVED**.

The request to withdraw as attorney/agent of record and change of correspondence address is hereby not accepted. Petitioner has not complied with current USPTO requirements, set forth in 37 CFR 10.40 concerning Request for Withdrawal as Attorney and Change of Correspondence Address. Specifically, pursuant to 37 CFR 10.40, the Office will require the practitioner(s) to certify that he, she or they have:

- (1) given reasonable notice to the client, prior to the expiration of the reply period, that the practitioner(s) intends to withdraw from employment;
- (2) delivered to the client or duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and
- (3) notified the client of any replies that may be due and the time frame within which the client must respond.

Petitioner has not complied with the above certifications. Also, petitioner has not properly submitted forwarding correspondence address information for the application.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest <u>who properly became of record under 37 CFR 3.71</u>, or if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71 (c) states:

An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73 (b) that is signed by a party who is authorized to act on behalf of the assignee.

Inquires concerning either the examination or status of the application should be directed to the Technology Center at (571) 272-3700. Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7253.

/Monica A. Graves/ Petitions Examiner, Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

September 24, 2010

Arles A. Taylor, Jr.
Jenkins, Wilson, Taylor & Hunt, P.A.
3100 Tower Blvd.
Suite 1200
Durham, NC 27707

Patent No.

: 7,767,209 B2

Ser. No.

: 11/375,159

Inventor(s)

: Caroline Staib, et al.

Issued

: August 3, 2010

Docket No.

: 1406/323

Title

: MODIFIED VACCINIA VIRUS ANKARA (MVA) MUTANT AND USE THEREOF

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based solely on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing <u>incorrect or erroneous</u> assignment data, before issuance of a Certificate of Correction, under 37 CFR 1.323 (see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481). This procedure is required at any time after the issue fee is paid, including after issuance of the patent.

In view of the foregoing, your request, in this matter, is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

- A. the processing fee set forth in 37 CFR 1. 17(i) (currently \$130);
- <u>B.</u> a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
- <u>C.</u> a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail:

Mail Stop PETITIONS
Commissioner for Patents

Post Office Box 1450

Alexandria, VA 22313-1450

By hand:

**Customer Service Window** 

Mail Stop Petitions Randolph Building 401 Dulany Street Alexandria, VA 22314

By fax:

(571) 273-0025

ATTN: Office of Petitions

If a fee (currently \$100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

/Virginia Tolbert/ Virginia Tolbert For Mary Diggs Decisions & Certificates of Correction Branch (571) 272-0460 or (703) 756-1814



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

# MAILED

JUN 20 2011

JENKINS, WILSON, TAYLOR & HUNT, P. A. 3100 Tower Blvd.
Suite 1200
DURHAM NC 27707

OFFICE OF PETITIONS

In re Patent No. 7,767,209 Issue Date: August 3, 2010

Application No. 11/375,159

Filed: March 14, 2006

Attorney Docket No. 1406/323

**ON PETITION** 

This is a decision on the petition filed April 18, 2011, which is being treated as a request under 37 CFR 3.81(b)<sup>1</sup> to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-2991. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

/Terri Johnson/ Terri Johnson Petitions Examiner Office of Petitions

<sup>&</sup>lt;sup>1</sup> See MPEP 1309, subsection II; and Official Gazette of June 22, 2004.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

SHAY GLENN LLP 2755 CAMPUS DRIVE SUITE 210 SAN MATEO CA 94403

MAILED
SEP 3 0 2010
OFFICE OF PETITIONS

In re Application of

Jeffrey L. Bleich et al

Application No. 11/375,265

Filed: March 13, 2006

Attorney Docket No. 10376-700.US1

**DECISION DISMISSING PETITIONS** 

UNDER 37 CFR 1.78(a)(3) AND (a)(6)

This is a decision on the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed July 12, 2010, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of priority to the prior-filed nonprovisional and provisional applications set forth in the concurrently filed amendment and Application Data Sheet (ADS).

## The petition is **DISMISSED**

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in  $\S 1.17(t)$ ; and
- a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

The amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). Note MPEP §§ 201.06(c) and 608.04(b).

Before the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition accompanied by a substitute amendment deleting the incorporation by reference statement to the provisional applications is required.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

By mail:

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Alexandria, VA 22313-1450

By hand:

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By fax:

(571) 273-8300

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By internet:

EFS-Web

www.uspto.gov/ebc/efs\_help.html (for help using EFS-Web call the Patent Electronic Business Center

at (866) 217-9197)

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/ Karen Creasy Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

**BAXANO C/O SHAY LAW 2755 CAMPUS DRIVE SUITE 210** SAN MANTEO, CA 94403

MAILED NOV 22 2010

In re Application of Jeffery L. Bleich et al Application No. 11/375,265 Filed: March 13, 2006

OFFICE OF PETITIONS

**DECISION ON PETITIONS** 

Attorney Docket No. 10376-700.US1

: UNDER 37 CFR 1.78(a)(3) AND (a)(6)

This is a decision on the renewed petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed November 9, 2010, to accept an unintentionally delayed claim under 35 U.S.C. §§120, 365(c) and §119(e) for the benefit of the prior-filed applications set forth in the concurrently filed amendment.

## The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ **(1)** 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- the surcharge set forth in § 1.17(t); and **(2)**
- **(3)** a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Additionally, the instant nonprovisional application must be pending at the time of filing of the reference to the prior-filed provisional application as required by 37 CFR 1.78(a)(5)(ii). Further, the nonprovisional application claiming the benefit of the prior-filed provisional application must have been filed within twelve months of the filing date of the prior-filed provisional application. All the above requirements having been satisfied, the late claim for benefit of priority under 35 U.S.C. §§ 120 365(c) and §119(e) is accepted as being unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) should not be construed as meaning that this application is entitled to the benefit of the filing date of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. §\$120 and 1.78(a)(1) and (a)(2) and under 35 U.S.C. §\$19(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed applications, accompanies this decision on petition.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 3775 for consideration by the examiner of the claim under 35 U.S.C. §§120, 365(c) and §119(e) of the prior-filed nonprovisional PCT and provisional applications.

/KOC/ Karen Creasy Petitions Examiner Office of Petitions

**ATTACHMENT**: Corrected Filing Receipt



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address COMMISSIONER FOR PATENTS PO. Box 1450 Alexandria, Virginia 22313-1450 www.uspic.gov

APPLICATION FILING or GRP ART NUMBER 371(c) DATE FIL FEE REC'D UNIT ATTY.DOCKET.NO TOT CLAIMS IND CLAIMS 11/375,265 03/13/2006 3775 2690 10376-700.USI 89

70808 **BAXANO C/O SHAY LAW** 2755 CAMPUS DRIVE SUITE 210 SAN MANTEO, CA 94403

**CONFIRMATION NO. 3659** CORRECTED FILING RECEIPT



Date Mailed: 11/22/2010

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

## Applicant(s)

Jeffery L. Bleich, Palo Alto, CA; Vahid Saadat, Saratoga, CA; Steven A. Spisak, San Jose, CA; John E. Ashley, Danville, CA;

Power of Attorney: The patent practitioners associated with Customer Number 66854

#### Domestic Priority data as claimed by applicant

This application is a CIP of PCT/US2005/037136 10/15/2005 which claims benefit of 60/619,306 10/15/2004 and claims benefit of 60/622.865 10/28/2004 and claims benefit of 60/681,719 05/16/2005 and claims benefit of 60/681,864 05/16/2005 and claims benefit of 60/685,190 05/27/2005

#### Foreign Applications

If Required, Foreign Filing License Granted: 05/15/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/375,265** 

Projected Publication Date: Not Applicable

Non-Publication Request: No Early Publication Request: No

\*\* SMALL ENTITY \*\*

page 1 of 3

Title

METHODS AND APPARATUS FOR TISSUE MODIFICATION

**Preliminary Class** 

606

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

## LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

#### **GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

#### **NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



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APR 1.8 2011

OFFICE OF PETITIONS

In re Application of

Levy Schmuel et al.

Application No. 11/375,471

Filed: March 13, 2006

Attorney Docket No. P23374

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 29, 2010, to revive the above-identified application.

#### The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, December 24, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on March 25, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of \$1620, and (3) an adequate statement of unintentional delay. Accordingly, the reply to the non-final Office action of December 24, 2009 is accepted as having been unintentionally delayed.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a

reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at (571) 272-2783.

This application is being referred to Technology Center AU 2617 for appropriate action on the concurrently filed amendment.

Ramesh Krishnamurthy

Petitions Examiner Office of Petitions

cc: **JOSEPH P. CURTIN** 

COOL PATENT, P.C.

9800 MT. PYRAMID CT.

**SUITE 400** 

**ENGLEWOOD CO 80112** 



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SWANSON & BRATSCHUN, L.L.C. 8210 SOUTHPARK TERRACE LITTLETON CO 80120

**MAILED**JAN 1 1 2011

In re Application of Brian Elliott et al. Application No. 11/375,509 Filed: March 14, 2006 Attorney Docket No. 0318.01

OFFICE OF PETITIONS
ON PETITION

This is a decision on the petition under 37 CFR 1.137(b)<sup>1</sup>, filed September 23, 2010, to revive the above-identified application.

## The petition is **GRANTED**.

In response to the Final Office Action mailed March 22, 2010 which set a three (3) month shortened statutory period for reply, petitioners filed an amendment and a three month extension of time on September 22, 2010. Subsequently however, petitioners filed the instant Petition to Revive and a Request for Continued Examination (RCE) on September 23, 2010. In view thereof, in advance of the mailing of a Notice of Abandonment, the extension of time fee will be refunded and the application will be considered abandoned for failure to timely reply to the Final Office Action mailed March 22, 2010.

Petitioner has submitted a Request for Continued Examination (RCE) with a request that a previously filed amendment be considered as the submission required under 37 CFR 1.114.

This matter is being referred to Technology Center 1726 for processing of the RCE.

Telephone inquiries related to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212

Att and Rall

Patricia Faison-Ball Senior Petitions Attorney

Office of Petitions

'Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

<sup>(1)</sup> the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

<sup>(2)</sup> the petition fee as set forth in 37 CFR 1.17(m);

<sup>(3)</sup> a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and



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OFFICE OF PETITIONS

In re Application of

Kenneth R. BABCOCK, et al.

Application No. 11/375,727

Filed: March 15, 2006

Attorney Docket No. 1125-0104.01

DECISION GRANTING PETITION

UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed March 23, 2011, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on February 23, 2011 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

Telephone inquiries should be directed to the undersigned at (571) 272-7253.

This application is being referred to Technology Center AU 3654 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). <u>Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.</u>





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Kilpatrick Townsend & Stockton LLP Adobe Systems, Inc. 58083 1100 Peachtree Street Suite 2800 Atlanta GA 30309-4530

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APR 1 7 2012

OFFICE OF PETITIONS

In re Patent No. 8,120,610

Stratton : DECISION FOR REQUEST Issue Date: February 21, 2012 : FOR RECONSIDERATION

Application No. 11/375,742 : OF PATENT TERM Filed: March 15, 2006 : ADJUSTMENT

Attorney Docket No. 58083/394705 (B215):

This is a decision on the "Request for Reconsideration of Patent Term Indicated on Face of Patent Pursuant to 37 CFR 1.705(d)," filed March 20, 2012. Patentees request that the patent term adjustment indicated on the face of the Letters of Patent be corrected from one thousand, ninety-four (1,094) days, to one thousand, two hundred and sixty-six (1,266) days.

The request for reconsideration of the patent term adjustment under 37 CFR 1.705(d) is **DISMISSED**.

On February 21, 2012, the above-identified application matured into U.S. Patent No. 8,120,610, with a revised patent term of 1,094 days. By the instant petition, patentees assert that the patent term should be adjusted by 608 days pursuant to 37 CFR 1.702(b) and 37 CFR 1.703(b). It is noted that patentees failed to account for the filing of the Notice of Appeal on August 4, 2009. The Office reminds patentees that the period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. See 35 U.S.C. 154(b)(1)(B)(ii). In this instance, the period consumed by appellate review is 171 days, beginning on the date on which the Notice of Appeal to the Board of Patent Appeals and Interferences was filed, August 4, 2009, and ending on the day the non-final Office action was mailed January 21, 2010. Thus, the B delay is 531 days (702 – 171). Accordingly, the patent term adjustment is 1,094 days (658 days of A delay + 531 days of B delay – 95 days of overlap - 0 days of applicant delay). In view thereof, the patent term adjustment of 1,094 days indicated in the patent is correct.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office is in receipt of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Further correspondence with respect to this decision should be addressed as follows:

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Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Petitions Attorney Office of Petitions

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PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK NJ 08933-7003 MAILED
JUN 1-6 2011
OFFICE OF PETITIONS

In re Application of

Don F. Yeager

Application No. 11/375,774

Filed: March 15, 2006

Attorney Docket No. ALCN-139US

This is a decision on: (a) the petition, filed May 2, 2011, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment, and in the

**DECISION ON PETITION** 

alternative, (b) a petition to revive the above-identified under the unintentional provision of 37 CFR 1.137(b).

The petition under 37 CFR 1.181 is **GRANTED**.

This application was held abandoned for failure to reply to the non-final Office action mailed April 14, 2010, which set a three (3) month shortened statutory period for reply. A Notice of Abandonment was mailed on November 24, 2010.

Petitioner asserts that the Office action dated April 14, 2010 was not received.

A review of the written record indicates an irregularity in the mailing of the Office action of April 14, 2010. In this regard, the Office received a revocation of power of attorney with new power of attorney and a request for a change of address on November 10, 2009, prior to the mailing of the Office action of April 14, 2010. Office records were not timely updated to reflect this new address. Accordingly, as the Office action was mailed to an incorrect address, the Notice of Abandonment mailed November 24, 2010 is hereby vacated and the holding of abandonment withdrawn.

In view of the above, the petition under 37 CFR 1.137(b) filed concurrently with the above petition will not be considered and the \$1,620 petition fee paid therefor will be credited back to petitioner's deposit account, as authorized.

This application is being referred to the Technology Center Art Unit 3781 for further action on the reply filed concurrently with the instant petition.

/Ramesh Krishnamurthy/
Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions



COMMISSIONER FOR PATENTS UNITED STATES PATENT AND TRADEMARK OFFICE

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**OFFICE OF PETITIONS** 

In re Application of

Knopeck, et al.

Application No. 11/375,826 : DECISION ON PETITION Filed: March 15, 2006 : UNDER 37 CFR 1.78(a)(3)

Attorney Docket No. H0008783 (4520)

This is a decision on the petition under 37 CFR 1.78(a)(3), filed December 23, 2010, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed with the petition.

## The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not satisfy item (1) above.

The reference to add the above-noted, prior-filed applications in the first sentence of the specification on page one following the title is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior

application. See <u>Dart Industries v. Banner</u>, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). Note MPEP §§ 201.06(c) and 608.04(b).

If reconsideration of this decision is desired, a renewed petition under 37 CFR § 1.78(a)(3) and an Application Data Sheet or an amendment (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5)) to correct the above matters are required.

As to item (3) set forth above, the rule at 37 CFR § 1.78(a)(3) requires a statement that the entire delay between the date the claim was due under 37 CFR § 1.78(a)(2)(ii) and the date the claim was filed was unintentional. Since the statement appearing in the petition varies from the required language, the statement is being construed as the statement required by 37 CFR §1.78(a)(3). If this is not a correct reading of the statement appearing in the petition, petitioner should promptly notify the Office.

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Attorney Advisor Alesia M. Brown at (571) 272-3205.

Chris Bottorff Supervisor

Office of Petitions

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: DECISION ON PETITION

UNDER 37 CFR 1.78(a)(3)

In re Application of

Knopeck, et al.

Application No. 11/375,826 Filed: March 15, 2006

Attorney Docket No. H0008783 (4520)

1.78(a)(3), filed April 1, 2011, to accept an

This is a decision on the petition under 37 CFR 1.78(a)(3), filed April 1, 2011, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed with the petition.

## The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this

# <u>benefit claim and determine whether the application is entitled to the benefit of the earlier</u> filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional applications, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3205. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 1611 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed applications.

/ALESIA M. BROWN/

Alesia M. Brown Attorney Advisor Office of Petitions



## United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. BOX 1450 Alexandria, Virginia 22313-1450

1	APPLICATION	FILING or	GRP ART				
	NUMBER	371(c) DATE	UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
	11/375.826	03/15/2006	1611	2130	H0008783 (4520)	32	

91970 HONEYWELL/FOX ROTHSCHILD Patent Services 101 Columbia Road Morristown, NJ 07962 CONFIRMATION NO. 6192 CORRECTED FILING RECEIPT



Date Mailed: 06/06/2011

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

#### Applicant(s)

Gary M. Knopeck, Lakeview, NY; Jeremy Diringer, Morristown, NJ; Louis Herena, Scarsdale, NY; Rajiv R. Singh, Getzville, NY;

#### **Assignment For Published Patent Application**

Honeywell International Inc., Morristown, NJ

#### **Power of Attorney:**

Colleen Szuch--32126 Joseph Posillico--32290 Scott Jacobson--42689 Deborah Chess--44611 Jimmie Johnson Jr--52485

## Domestic Priority data as claimed by applicant

This appln claims benefit of 60/662,579 03/16/2005 and is a CIP of 10/837,525 04/29/2004 PAT 7,279,451 and is a DIV of 10/837,526 04/29/2004 PAT 7,524,805 and is a DIV of 10/837,521 04/29/2004 PAT 7,655,610

**Foreign Applications** (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see <a href="http://www.uspto.gov">http://www.uspto.gov</a> for more information.)

If Required, Foreign Filing License Granted: 04/27/2006

The country code and number of your priority application, to be used for filling abroad under the Paris Convention, is **US 11/375,826** 

Projected Publication Date: Not Applicable

Non-Publication Request: No

**Early Publication Request: No** 

Title

Medicament formulations

**Preliminary Class** 

424

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

#### LICENSE FOR FOREIGN FILING UNDER

## Title 35, United States Code, Section 184

#### Title 37, Code of Federal Regulations, 5.11 & 5.15

#### **GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

#### **NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

DATE	:07/21/11		
TO SPE OF	: ART UNIT <b>2462</b>		
SUBJECT	: Request for Certificate of Corr	ection for Appl. No.: <u>11375853</u> Patent No.: <u>7965733</u>	
		CofC mailroom date: 07/13/11	
Please resp	ond to this request for a c	ertificate of correction within 7 days.	
FOR IFW FI	LES:		
Please review the requested changes/corrections as shown in the <b>COCIN</b> document(s) the IFW application image. No new matter should be introduced, nor should the scope meaning of the claims be changed.			
	olete the response (see be nent code <b>COCX</b> .	elow) and forward the completed response to scanning	
FOR PAPER	R FILES:		
Please review the requested changes/corrections as shown in the attached certificate correction. Please complete this form (see below) and forward it with the file to:			
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Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Eustace P. Isidore 5720 Brittlyn's Court Austin TX 78730

MAILED JAN 102011

OFFICE OF PETITIONS

In re Application of Isidore, et al. Application No. 11/375,892 Filed: March 15, 2006

ON PETITION

Attorney Docket No. EPINVENTCORP.001

This is a decision on the petition under 37 CFR 1.181 filed on July 21, 2010, to withdraw the holding of abandonment in the above-cited application.

The petition is **DISMISSED**.

The above-identified application became abandoned for failure to reply to the Notice of Allowance and Issue Fee Due mailed August 24, 2009, which set a statutory period for reply of three-months from its mailing date. No response was received within the allowable period, and the application became abandoned on November 25, 2009 A Notice of Abandonment was mailed on June 16, 2010.

The instant petition was filed on July 21, 2010. The petition will not be treated on its merits at this juncture because it is not signed by all of the necessary parties. Further to this point, 37 CFR 1.33(b) provides, in pertinent part that:

- b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to  $\S 1.27(c)(2)(ii)$  of this part, filed in the application must be signed by:
- (1) \*\*>A patent practitioner of record appointed in compliance with § 1.32(b);<
- (2) \*\*>A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34;<
- (3) An assignee as provided for under § 3.71(b) of this chapter; or
- (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

The petition, as filed on July 21, 2010, is defective because it is only signed by inventor Isidore, but there is an additional joint inventors listed on the application. Further, registration number 56,104 is not assigned to Eustace Isidore and no other signature appears on the petition. The renewed petition must be signed by either all the named joint inventors, an attorney of record in the application, or a representative of the assignee that is empowered by 37 CFR 3.73(b).

The address cited on the petition differs from the address of record. A courtesy copy of this decision is being mailed to the address cited on the petition, however, all future correspondence will be mailed solely to the address of record until appropriate written instructions to the contrary are received.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Commissioner for Patents

United States Patent and Trademark Office

Box 1450

Alexandria, VA 22313-1450

By facsimile:

(571) 273-8300

Attn: Office of Petitions

Telephone inquiries regarding this decision should be directed to the undersigned (571) 272-3222.

Kenya A. McLaughlin

Petitions Attorney Office of Petitions

cc:

Dillon & Yudell LLP 8911 North Capital of Texas Highway Suite 2110

Austin, TX 78759



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

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Eustace P. Isidore 5720 Brittlyn's Court Austin TX 78730

FEB 14 2011

OFFICE OF PETITIONS

In re Application of Isidore, et al.

Application No. 11/375,892

Filed: March 15, 2006

Attorney Docket No. EPINVENTCORP.001

ON PETITION

This is a decision on the petition under 37 CFR 1.181 filed on July 21, 2010, to withdraw the holding of abandonment. The petition is also being treated as a petition under 37 CFR 1.137(a) and a petition under 37 CFR 1.137(b).

The decision mailed January 19, 2011 is vacated<sup>1</sup>.

The petition under 37 CFR 1.181 is **DISMISSED**.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The application became abandoned on November 25, 2009, after no response was received to the Notice of Allowance and Issue Fee Due mailed August 24, 2009, which set a statutory period for reply of threemonths from its mailing date. The Notice required payment of the issue and publication fees. No response was received within the allowable period, and the application became abandoned on November 25, 2009. A Notice of Abandonment was mailed on June 16, 2010.

The instant petition was filed on July 21, 2010. Petitioner maintains that the holding of abandonment should be withdrawn because a Supplemental Notice of Allowability was mailed October 20, 2009, which set the period by which the issue and publication fee must be paid as three months from the mailing date of the Supplemental Notice of Allowability. Petitioner maintains that Form PTOL-85b authorizing the issue and publication fees to be charged to a deposit account was filed within that three month period. Accordingly, petitioner concludes that the holding of abandonment is improper and should be withdrawn. Alternatively, petitioner argues that the abandonment was unavoidable, and at least unintentional.

As to the petitions under 37 CFR 1.181(a) and 37 CFR 1.137(a), petitioner's arguments are not persuasive.

#### TREATMENT UNDER 37 CFR 1.181(a)

A petition to withdraw the holding of abandonment is only proper when there is some question as to whether the application is actually abandoned. A review of the application history reveals that a Notice of

<sup>&</sup>lt;sup>1</sup> The decision mailed January 10, 2011, is being vacated in view of the fact that petitioner has established that Eustace P. Isidore, who signed the petition, is a registered patent practitioner.

Allowance and Issue Fee Due was mailed August 24, 2009, requiring payment of the issue fee and publication fee and setting a statutory, non-extendable period for reply of three months from its mailing date. A Notice of Allowability was also mailed on August 24, 2009. On October 20, 2009, a Supplemental Notice of Allowability was mailed. The Supplemental Notice of Allowability stated, in pertinent part:

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

The Supplemental Notice of Allowability made no indication that the requirements set forth in the Notice of Allowance and Issue Fee Due mailed August 24, 2009, were changed or that the period for reply to that notice was reset. The Notice of Allowance and Issue Fee Due and Notice of Allowability are exclusive of each other as are the requirements and time periods for reply set by the notices. Thus, the mailing of the Supplemental Notice of Allowability had no effect on the period for reply set by the Notice of Allowance and Issue Fee Due. Applicant is not a liberty to ignore a requirement made in the Notice of Allowance and Issue Fee Due. The Notice of Allowance and Issue Fee Due made a requirement for payment of the issue and publication fees and set a three-month statutory period for reply. Applicant was obligated to file a timely response to the Notice of Allowance and Issue Fee Due. See MPEP 710.06. Section 711.02 of the Manual of Patent Examining Procedure, citing 37 CFR 1.135(a) states, in pertinent part, that, "...an application becomes abandoned if applicant "fails to reply" to an office action within the fixed statutory period. This failure may result either from (A) failure to reply within the statutory period, or (B) insufficiency of reply, i.e., failure to file a "complete and proper reply, as the condition of the case may require" within the statutory period (37 CFR 1.135(b))." The record does not demonstrate and petitioner does not establish that a proper response to the Notice of Allowance and Issue Fee Due was filed within the period set for reply; the application was properly held abandoned on November 25, 2009.

The petition to withdraw the holding of abandonment is dismissed, accordingly.

#### TREATMENT UNDER 37 CFR 1.137(a)

A grantable petition under 37 CFR 1.137(a)<sup>2</sup> must be accompanied by: (1) the required reply,<sup>3</sup> unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks item (3).

# The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is

<sup>&</sup>lt;sup>2</sup>As amended effective December 1, 1997. <u>See Changes to Patent Practice and Procedure</u>; Final Rule Notice 62 <u>Fed. Reg.</u> 53131, 53194-95 (October 10, 1997), 1203 <u>Off. Gaz. Pat. Office</u> 63, 119-20 (October 21, 1997).

<sup>&</sup>lt;sup>3</sup> In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."<sup>4</sup>

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked **any** basis in reason or common sense."<sup>5</sup>

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law."

"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."

#### The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?" Nonawarness of a PTO rule will not constitute unavoidable delay. 10

<sup>&</sup>lt;sup>4</sup>Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")

<sup>&</sup>lt;sup>5</sup>Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

<sup>&</sup>lt;sup>6</sup>Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

<sup>&</sup>lt;sup>7</sup>Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

<sup>8</sup>Id.

<sup>&</sup>lt;sup>9</sup>See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

<sup>&</sup>lt;sup>10</sup>See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

#### Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner asserts that the failure to pay the issue and publication fees was unavoidable because the Supplemental Notice of Allowability appeared to set a three month period for reply beginning from its October 20, 2009, mailing date.

With regard to item (3), the unavoidable standard requires that petitioner establish, by evidentiary showing, that petitioner acting reasonably and prudently relative to the prosecution of the application and despite petitioner's action the application was unavoidably abandoned. It is again noted that the Supplemental Notice of Allowability is silent as to any change in the requirements and period for reply set forth in the Notice of Allowability or simply made incorrect assumptions of the language of the Supplemental Notice of Allowability or simply made incorrect assumptions of the effect the Supplemental Notice of Allowability would have on applicants' responsibilities relative to the Notice of Allowance and Issue Fee Due. In any case, applicants misinterpretation or misunderstanding is not tantamount to unavoidable delay as is meant by 37 CFR 1.137(a). Rather, the circumstances as set forth in the petition are more akin to unintentional delay as set forth in 37 CFR 1.137(b). The petition under 37 CFR 1.137(a) is dismissed accordingly.

Deposit account 50-3083 will be charged \$270.00 for the instant petition fee.

#### TREATMENT UNDER 37 CFR 1.137(b)

The petition under 37 CFR 1.137(b) is granted.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. If the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is not a correct interpretation of the statement contained in the instant petition.

Deposit account 50-3083 will be charged \$810.00 for the instant petition fee.

The issue fee, publication fee, and Form PTOL-85b were received on December 4, 2009.

The application is being directed to the Office of Data Management for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Petitions Attorney Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

3D Systems, Inc.

Attn: Keith A. Roberson 333 Three D Systems Circle

Rock Hill SC 29730

MAILED

FEB 1 4 2011

OFFICE OF PETITIONS

In re Application of

Jouni P. Partanen et al.

Application No. 11/375,917

Filed: March 15, 2006

Attorney Docket No. USA.407-1

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 5, 2011, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before January 4, 2011, as required by the Notice of Allowance and Fee(s) Due, mailed October 4, 2010. Accordingly, the date of abandonment of this application is January 5, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of \$755 and the publication fee of \$300, (2) the petition fee of \$810; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571) 272-4584.

This application is being referred to the Office of Data Management for processing into a patent.

Joahne Burke

Petitions Examiner Office of Petitions



## United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
11/375,967	03/15/2006	Wilhelm R. Lowell	75449-023	1546	
87472 7590 02/28/2011 Brandau & Associates, LLC			EXAMINER		
634 Lee Ave.			NI, SUHAN		
St. Louis, MO	53119		ART UNIT	PAPER NUMBER	
			2614		
			MAIL DATE	DELIVERY MODE	
			02/28/2011	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

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		<b>Paper No</b> .:20110201
DATE	: February 01, 2011	
TO SPE C	OF : ART UNIT 2614	
SUBJECT	: Request for Certificate of Correcti	ion on Patent No.: 7,844,067
A response	e is requested with respect to the accompa	anying request for a certificate of correction.
Certificate	mplete this form and return with file, wes of Correction Branch - ST (South tion 7590 - Tel. No. (703) 305-8309	•
read as sho	3 ( ) .	Office and/or Applicant's errors, should the patent w matter should be introduced, nor should the scope or
Thank Yo	u For Your Assistance	Certificates of Correction Branch
•	est for issuing the above-identified of sion on the appropriated box.	correction(s) is hereby:
$\boxtimes$	Approved	All changes apply.
	Approved in Part	Specify below which changes do not apply.
	Denied	State the reasons for denial below.
Comment	is:	
		TIS KUNTZ/ rvisorv Patent Examiner.Art Unit 2614

Issue	Classification	

Application/Control No.	Applicant(s)/Patent ( Reexamination	under
11/376,018	MITSUHASHI, MAS	SATO
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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

KENYON & KENYON LLP ONE BROADWAY NEW YORK NY 10004

MAILED

MAR 21 2011

In re Application of

OFFICE OF PETITIONS

Hrakovsky, et al.

ON PETITION

Application No. 11/376,029 Filed: March 14, 2006

Attorney Docket No. 1662/72302

;

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 14, 2011, to revive the above-identified application.

### The petition is **GRANTED**.

The application became abandoned June 4, 2010 for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of March 3, 2010. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed September 28, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and required fee, and the submission required by 37 CFR 1.114; (2) the required petition fee; and (3) an adequate statement of unintentional delay. 37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is **not** a correct reading of the statement appearing in the petition.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See, In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the \$1,110.00 extension of time fee submitted with the petition was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3205.

This application is being referred to Technology Center AU 1612 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

/ALESIA M. BROWN/

Alesia M. Brown Attorney Advisor Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER

MAILED

LLP

901 NEW YORK AVENUE, NW WASHINGTON DC 20001-4413

JUN 0 8 2011

OFFICE OF PETITIONS

In re Patent No. 7,920,299

: DECISION ON REQUEST

Abraitis et al.

: FOR

Issue Date: 04/05/2011 : RECONSIDERATION OF

Application No. 11/376,052

: PATENT TERM ADJUSTMENT

Filing or 371(c) Date: 03/14/2006

Atty Docket No.

: NOTICE OF INTENT TO ISSUE

09930.0011-00000

: CERTIFICATE OF CORRECTION

This is a decision on the APPLICATION FOR PATENT TERM ADJUSTMENT—POST-GRANT, filed on April 19, 2011, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand three hundred five (1305) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand three hundred five (1305) days is **GRANTED**.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one thousand three hundred five (1305) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3231.

Douglas I. Wood

Senior Petitions Attorney

Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

# UNITED STATES PATENT AND TRADEMARK OFFICE **CERTIFICATE OF CORRECTION**

**PATENT** 

: 7,920,299 B2

DATED

Apr. 5, 2011

**DRAFT** 

INVENTOR(S): Abraitis et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 1289 days.

Delete the phrase "by 1289 days" and insert – by 1305 days--



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

KASHA LAW LLC 14532 Dufief Mill Road North Potomac MD 20878

MAILED
MAR 2 7 2012
OFFICE OF PETITIONS

In re Application of Dixon Cleveland et al. Application No. 11/376,182

Filed: March 16, 2006

Attorney Docket No. LCT0107-US

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 7, 2012, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, May 25, 2011, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 26, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of \$930, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571) 272-4584.

This application is being referred to Technology Center AU 2873 for appropriate action by the Examiner in the normal course of business on the reply received.

JoAnne Burke Petitions Examiner Office of Petitions Doc Code: PET.PTA.RCAL

Document Description: Request for Recalculation in view of Wyeth

PTO/SB/131 (02-10) Approved for use through 07/31/2010, OMB 0651-0020

Approved for use through 07/31/2010. OMB 0651-0020 U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

Attorney Docket Number: 033036 M 104

Application Number: 11/376,363

Patent Number: 7,629,398

Filing Date (or 371(b) or (f) Date): March 15, 2006

Issue Date: December 8, 2009

First Named Inventor: Yasuhiro MIZUNO

# Title: EPOXY RESIN COMPOSITION AND SEMICONDUCTOR DEVICE

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-WYETH INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

Signature /Michael A. Makuch/	Date August 26, 2010					
Name (Print/Typed) Michael A. Makuch	Registration Number 32,265					
Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below*.						
*Total of _1 forms are submitted.						

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 10 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 09/01/2010

: DECISION ON REQUEST FOR

: RECALCULATION of PATENT : TERM ADJUSTMENT IN VIEW

: OF WYETH

SMITH, GAMBRELL & RUSSELL SUITE 3100, PROMENADE II 1230 PEACHTREE STREET, N.E. ATLANTA, GA 30309-3592

Applicant : Yasuhiro Mizuno

**Patent Number**: 7629398 **Issue Date**: 12/08/2009

Application No: 11/376,363

Filed : 03/15/2006

The Patentee's Request for Recalculation is DISMISSED.

This Request is deemed ineligible for consideration for one or more of the following reasons:

- (A). The patent for which PTA recalculation is requested is either a design or reissue application or is a reexamination proceeding;
- (B). The patent for which PTA recalculation is requested resulted from a utility or plant application filed under 35 USC 111(a) before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;
- (C). The patent for which PTA recalculation is requested resulted from an international application in which the international filing date was before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;
- (D). The patent for which PTA recalculation is requested issued on/after March 2, 2010;
- (E). The Request for Recalculation was filed more than 180 days after the grant date of the patent and the request was not filed within two months of a dismissal of a request for reconsideration of the of the patent term under 37 CFR 1.705(d);
- not solely limited to USPTO pre-Wyeth The Request for Recalculation is interpretation of 35 U.S.C. 154(b)(2)(A);

(G). A civil action was filed pursuant to 35 U.S.C. 154(b)(4)(A)concerning the same patent at issue in this request.

Patentee may file a reply to this decision dismissing the Request for Recalculation. Patentee must file such reply within one month or thirty days, whichever is longer, of the mail date of the decision dismissing the Request for Recalculation. No fee is required if patentee is asserting in the reply that the dismissal for ineligibility is improper.

Patentee should use document code PET.OP if electronically filing a reply to this dismissal. If the USPTO finds that the request was improperly deemed ineligible, the USPTO will mail applicant a recalculation determination.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A). Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154 (b) (4) (A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702,

SPE RESPONSE FOR	CERTIFICATE OF CORRECTION
DATE 10/5/10	Paper No.:
TO SPE OF : ART UNIT 1765	
SUBJECT : Request for Certificate of Correction	for Appl. No.: 11/376363 Patent No.: 1629398 Ed
Please respond to this request for a certific	rate of correction within 7 days
FOR IFW FILES:	Sale of correction within 7 days.
Please review the requested changes/corr	ections as shown in the COCIN document(s) in r should be introduced, nor should the scope or
Please complete the response (see below) using document code COCX.	and forward the completed response to scanning
FOR PAPER FILES:	
Please review the requested changes/correction. Please complete this form (see	ections as shown in the attached certificate of below) and forward it with the file to:
Certificates of Correction Branch Randolph Square – 9D10-A Palm Location 7580	(CofC)  Virginia Tolbert
	Certificates of Correction Branch
	571-272-0460
	Thank You For Your Assistance
The request for issuing the above-identi	
	All changes apply.
☐ Approved in Part	Specify below which changes do not apply.
☐ Denied	State the reasons for denial below.
Comments:	
-306 (REV. 7/03)	U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

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PTOL-306 (REV. 7/03)



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

BRINKS HOFER GILSON & LIONE/MARVELL P.O. BOX 10395 CHICAGO, IL 60610

MAILED

SEP 27 2010 ·

**OFFICE OF PETITIONS** 

In re Application of

MELMAN, David et al.

Application No. 11/376,428

Filed: March 14, 2006

Attorney Docket No. MP0725

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 13, 2010.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to BRINKS HOFER GILSON & LIONE/MARVELL has been revoked by the assignee of the patent application on August 31, 2010. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

/Tredelle D. Jackson/ Petitions Examiner Office of Petitions

cc: MARSHALL, GERSTEIN & BORUN, LLP (MARVELL)

233 SOUTH WACKER DRIVE 6300 WILLIS TOWER

CHICAGO IL 60606-6357



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

MAILED

MAY 25-2011

OFFICE OF PETITIONS

KENYON & KENYON LLP ONE BROADWAY NEW YORK NY 10004

In re Application of Julia Hrakovsky et al.

Application No. 11/376,472

Filed: March 14, 2006

Attorney Docket No. 01662/72202

**ON PETITION** 

This is a decision on the petition under 37 CFR 1.137(b)<sup>1</sup>, filed May 12, 2011 to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned September 15, 2010 for failure to timely file a reply to the final Office action mailed June 14, 2010. Accordingly, a Notice of Abandonment was mailed December 22, 2010.

Petitioner has submitted a Request for Continued Examination (RCE) and an amendment as the submission required under 37 CFR 1.114.

This matter is being referred to Technology Center 1613 for processing of the RCE.

Telephone inquiries related to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Senior Petitions Attorney

Office of Petitions

<sup>&</sup>lt;sup>1</sup>Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) <u>must</u> be accompanied by:

<sup>(1)</sup> the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

<sup>(2)</sup> the petition fee as set forth in 37 CFR 1.17(m);

<sup>(3)</sup> a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

North Weber & Baugh, LLP - Oracle 2479 E. Bayshore Road, Suite 707 Palo Alto, CA 94303 MAILED

MAY 3 1 2011

OFFICE OF PETITIONS

In re Application of

Edwin Kenneth Margulies et al.

Application No. 11/376,486

Filed: March 15, 2006

Attorney Docket No. 20077-1466

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 3, 2011.

The request is moot because a revocation of power of attorney has been filed.

A review of the file record indicates that the power of attorney to North Weber & Baugh, LLP, has been revoked by the assignee of the patent application on May 16, 2011. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to Kimberly Inabinet at 571-272-4618.

/Kimberly Inabinet/

Kimberly Inabinet Petitions Examiner Office of Petitions

cc:

Fliesler Meyer, LLP 650 California Street 14<sup>th</sup> Floor San Francisco, CA 94108



### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.			
11/376,515	03/15/2006	David P. Kurrasch	20165-0002001	3953			
26221 FISH & RICHA	7590 03/28/2012 ARDSON P.C. (DE)		EXAM	INER			
P.O. BOX 1022	2		CHANG, I	CHANG, EDWARD			
MINNEAPOLI	IS, MN 55440-1022		ART UNIT	PAPER NUMBER			
			3691				
			NOTIFICATION DATE	DELIVERY MODE			
			03/28/2012	ELECTRONIC			

### Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAR 2 7 2012

Fish & Richardson P.O. Box 1022 Minneapolis, MN 55440-1022

In re Application of: KURRASCH et al

Application No. 11/376,515

Filed: March 15, 2006

For: SYTEM AND METHOD FOR ELECTRONIC PROCESSING OF PAYMENT OBLIGATIONS

**DECISION ON PETITION** 

REGARDING REQUEST TO

WITHDRAW FINALITY

**UNDER 37 CFR 1.181** 

This is in response to the petition filed on December 12, 2011 under 37 CFR 1.181 requesting the withdrawal of the finality of the Office action mailed October 11, 2011 as being premature.

Applicant alleges that the Final rejection mailed October 11, 2011 was premature in accordance with the guidelines of MPEP 706.07(a) in that "the new grounds of rejection in the Office Action issued on October 11, 2011, was not necessitated by Applicants' amendment and was not based on information submitted in an Information Disclosure Statement." Applicant points out that an amendment was filed on June 29, 2011, essentially incorporating the limitations of dependent claims 18, 24, 28 and 29 into independent claims 10, 11, 14, and 15 respectively. Claims 18, 24, 28 and 29 were cancelled. A new grounds of rejection was set forth in the Final Rejection mailed October 11, 2011.

A review of the record reveals that a Non-final rejection was mailed on March 31, 2011 rejecting claims 10-11 and 14-33 based on 35 USC 103 over Pat. No. 5,649,117 (Landry) in view of Pat. No. 5,920,848 (Schutzer). Specifically, the limitations of claims 18, 24, 28 and 29 were addressed by features taught in the Landry reference. Applicant then filed an amendment on June 29, 2011, cancelling claims 18, 24, 28, and 29 and amending claims 10, 11, 14, and 15. Applicant essentially incorporated the limitations of the dependent claims 18, 24, 28 and 29 into their respective independent claims, namely 10, 11, 14 and 15. The remaining claims were not amended. New grounds of rejection were set forth in a Final rejection mailed on October 11, 2011 rejecting claims 10-11, 14-17, 19-23, 25-27 and 30-37 based on 35 USC 103 over Landry in view of Schutzer and newly added reference US 2004/0076320 (Downs). The Examiner indicated that this final rejection was proper because the new grounds of rejection were necessitated by the Applicants' amendment. Newly cited reference Downs was used to address the amended language in claims 10, 11, 14, and 15. However, the amendment to claims 10, 11, 14, and 15 essentially recited the same limitations that were found in previously pending claims 18, 24, 28 and 29. Furthermore, the Downs reference was not cited in an Information Disclosure Statement. Applicant's amendment filed on June 29, 2011 did not necessitate the new grounds of rejection as explained by the Examiner in the Final rejection.

Therefore since the new grounds of rejection in the Final rejection mailed October 11, 2011 were not necessitated by Applicants' amendment and was not based on information submitted in an Information Disclosure Statement, the Final rejection of claims 10-11, 14-17, 19-23, 25-27 and 30-37 based on 35 USC 103 over Landry in view of Schutzer and Downs was premature.

The petition is **Granted**.

The application will be forwarded to the Supervisory Legal Instruments Examiner for removal of the final rejection status. The rejection itself is maintained as a non-final rejection and the response period continues to run from the mail date, October 11, 2011, of the action.

Telephone inquiries should be directed to Alexander Kalinowski, Supervisory Patent Examiner, at (571) 272-6771.

Gregory Vidovich, Director

Patent Technology Center 3600

(571) 272-5350

ak/tl: 3/25/12



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Michael F. Krieger Kirton & McConkie 60 East South Temple Suite 1800 Salt Lake City UT 84111

MAILED

MAR 08 2012

OFFICE OF PETITIONS

In re Application of

Sanderson

Application No. 11/376,526

Filed: March 14, 2006

Attorney Docket No. 9279.226

Title: APPARATUS FOR CREATING.

AN ALTERNATE POINT OF

ATTACHMENT FOR AN ATTACHABLE°

END OF A LOAD-BEARING SHOULDER

STRAP

DECISION ON PETITION

PURSUANT TO

37 C.F.R. § 1.137(B)

This is a decision on the petition pursuant to 37 C.F.R. § 1.137(b), filed February 1, 2012, to revive the aboveidentified application.

This petition pursuant to 37 C.F.R. § 1.137(b) is DISMISSSED.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed June 23, 2009, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on September 24, 2009. A notice of abandonment was mailed on December 31, 2009.

With this petition, Petitioner has submitted, inter alia, the petition fee, the required statement of unintentional delay, an amendment, and remarks. The first and second requirements of Rule 1.137(b) have been met. The fourth requirement of Rule

1.137(b) is not applicable, as a terminal disclaimer is not required. 1

Regarding the third requirement, Applicant has not established that the entire period of delay was unintentional. It is noted that the present petition was not filed until more than two years and one month had passed since the mailing of the notice of abandonment. It is not clear why the Applicant chose to take no course of action for such a long period of time. It does not appear that any action was taken to further the prosecution of this application, subsequent to the mailing of the notice of abandonment on December 31, 2009, for more than two years and one month.

As such, it appears that the Applicant <u>intentionally</u> allowed this application to go abandoned. The extended inaction of the Applicant appears to be intentional.

A discussion follows.

In order for a petition under 37 C.F.R. § 1.137(b) to be granted, the holder of the rights to the application must have unintentionally allowed the application to go abandoned, and a delay resulting from a deliberately chosen course of action on the part of the applicant is not an "unintentional" delay within the meaning of 37 C.F.R. § 1.137(b).

### The periods of delay:

There are three periods to be considered during the evaluation of a petition under 37 C.F.R. § 1.137(b):

- (1) the delay in reply that originally resulted in the abandonment;
- (2) the delay in filing an initial petition pursuant to 37 C.F.R. § 1.137(b) to revive the application; and
- (3) the delay in filing a grantable petition pursuant to 37 C.F.R. § 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) or (2).

As to Period (1), the patent statute at 35 U.S.C. \$ 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247

<sup>1 &</sup>lt;u>See</u> Rule 1.137(d).

reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Commissioner to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 C.F.R. § 1.137(b)(3) provides that a petition under 37 C.F.R. § 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here there is a question whether the initial delay was unintentional, the Applicant must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. § 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay of more than two years and one month in resuming prosecution, there is a question whether the entire delay was unintentional. Applicant should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 C.F.R. § 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment (the Applicant). That party, in turn must explain what effort(s) was made to reply to the non-final Office action of June 23, 2009. If no effort was made to continue prosecution, then that party must explain why the delay in this application does not result from a deliberate course of action (or inaction). It is noted that Petitioner is listed as an attorney of record as a result of the submission of a Power of Attorney on February 1, 2012. Therefore, it does not appear

that Petitioner, Michael F. Krieger, Reg. No. 35,232, has firsthand knowledge of the facts and circumstances regarding the abandonment of this application. As such, the Applicant should explain why this application became abandoned subsequent to the mailing of the non-final Office action of June 23, 2009. A statement from this individual must be provided. It must be explained why no response was submitted to the non-final Office action of June 23, 2009 for such an extended period of time.

As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2), where the applicant deliberately chose not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 C.F.R. § 1.137(b).<sup>2</sup>

The language of both 35 U.S.C. § 41(a)(7) and 37 C.F.R. § 1.137(b) are clear and unambiguous, and furthermore, without That is, the delay in filing the reply during qualification. prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 to the public. (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 C.F.R. § 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. See Changes to Patent

<sup>2</sup> See MPEP § 711.03(c).

Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated clear that any protracted delay (here, more than two years and one month) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at \*21-\*23. A statement is required from the Applicant, explaining why this petition was not filed sooner.

Moreover, Applicant must explain what prompted the decision to advance the prosecution of this application after the passage of so much time. A statement is required.

### Punctuality and Due Diligence:

For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894).

Similarly, an invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. <u>Automatic Electric Co. v. Dyson</u>, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R.§§1.181, 182, 183.

The lengthy period of inaction does not appear to be consistent with the requirements of punctuality, due diligence, good faith, and the encouragement of reasonable promptness.

On renewed petition, each of these issues will need to be addressed, and a statement from the Applicant must be included, if it is to be established that the entire period of delay was unintentional.

Petitioner is reminded that any statement of facts should be made by one having firsthand knowledge of the facts set forth therein.

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.137(b)". This is not a final agency action within the meaning of 5 U.S.C § 704.

# Thereafter, there will be no further reconsideration of this matter. 3

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail, 4 hand-delivery, 5 or facsimile. 6 Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web. 7

If responding by mail, Applicant is advised <u>not</u> to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.8 All other inquiries concerning examination procedures should be directed to the Technology Center.

Paul Shanoski Senior Attorney Office of Petitions

<sup>3</sup> If, on request for reconsideration, Applicant fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. \$ 1.137(e), will **not** apply to that decision.

<sup>4</sup> Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

<sup>5</sup> Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314

<sup>6 (571) 273-8300;</sup> please note this is a central facsimile number.

<sup>7 &</sup>lt;a href="https://sportal.uspto.gov/authercicate/authenticateuserlocalepf.html">https://sportal.uspto.gov/authercicate/authenticateuserlocalepf.html</a>

<sup>8</sup> Applicant will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Applicant is reminded that no telephone discussion may be controlling or considered authority for Applicant's further action(s).



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Michael F. Krieger Kirton & McConkie 60 East South Temple Suite 1800 Salt Lake City UT 84111

MAILED MAR 3 0 2012 OFFICE OF PETITIONS

In re Application of

Sanderson

Application No. 11/376,526

DECISION ON RENEWED PETITION

Filed: March 14, 2006

PURSUANT TO

Attorney Docket No. 9279.226

Title: APPARATUS FOR CREATING

AN ALTERNATE POINT OF

ATTACHMENT FOR AN ATTACHABLE END OF A LOAD-BEARING SHOULDER

STRAP

37 C.F.R. § 1.137(B)

This is a decision on the renewed petition pursuant to 37 C.F.R. § 1.137(b), filed March 19, 2012, to revive the above-identified application.

This renewed petition pursuant to 37 C.F.R. § 1.137(b) is GRANTED.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed June 23, 2009, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on September 24, 2009. A notice of abandonment was mailed on December 31, 2009.

An original petition pursuant to 37 C.F.R. § 1.137(b) was filed on February 1, 2012, along with, inter alia, the petition fee, the required statement of unintentional delay, an amendment, and remarks. The original petition pursuant to 37 C.F.R. § 1.137(b) was dismissed via the mailing of a decision on March 8, 2012,

which indicated first and second requirements of Rule 1.137(b) have been met and the fourth requirement of Rule 1.137(b) is not applicable, as a terminal disclaimer is not required.

The record (including the two petitions filed on February 1, 2012 and March 19, 2012) does not necessitate a finding that the delay between September 24, 2009 (the date of abandonment) and March 19, 2012 (the date of the filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on the duty of candor and good faith of Petitioner (Brian Matthew Sanderson) and his Counsel (Michael F. Krieger, Reg. No. 35,232) when accepting Petitioners' representation that the delay in filing the response was unintentional.<sup>2</sup>

It follows that the third requirement of 37 C.F.R. § 1.137(b) has been satisfied.

The Technology Center will be notified of this decision, and jurisdiction over this application is transferred to the Technology Center, so that the application may receive further processing. The Technology Center's support staff will notify the Examiner of this decision, so that the amendment that was received on February 1, 2012 can be processed in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the present decision to ensure that the revival has been acknowledged by the Technology Center in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Technology Center where that change of status must be effected - the Office of Petitions cannot effectuate a change of status.

Telephone inquiries <u>regarding this decision</u> should be directed to the undersigned at (571) 272-3225. All other inquiries

authority for any of Petitioner's further action(s).

<sup>1</sup> See Rule 1.137(d).

<sup>2</sup> See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 C.F.R. § 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. § 1.137(b) to the Patent and Trademark Office).

3 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered

Application No. 11/376,526

Decision on Renewed Petition under 37 C.F.R. § 1.137(b)

Page 3 of 3

concerning examination procedures or status of the application should be directed to the Technology Center.

Paul Shanoski

Senior Attorney

Office of Petitions





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO IL 60661 MAILED
FEB 162011
OFFICE OF PETITIONS

In re Application of

BEHZAD et al.

Application No. 11/376,531

Filed: 03/15/2006

Attorney Docket No. 16888US02

ON APPLICATION FOR

PATENT TERM ADJUSTMENT

This is in response to the APPLICATION FOR RECONSIDERATION OF THE DETERMINATION OF PATENT TERM ADJUSTMENT UNDER 35 U.S.C. 154(b) ACCOMPANYING THE NOTICE OF ALLOWANCE (37 CFR § 1.705) filed January 13, 2011. Applicants submit that the correct patent term adjustment to be indicated on the patent is 942 days, not 230 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants seek this correction on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined.

Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.1

For example, if applicants dispute both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed, and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicants must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within two months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3211.

Christina Partera Donnell

Christina Tartera Donnell Senior Petitions Attorney Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.usplo.gov

WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP BRADFORD GREEN, BUILDING 5 755 MAIN STREET, P O BOX 224 MONROE CT 06468

MAILED

AUG 2 6 2010

OFFICE OF PETITIONS

In re Application of

Mika Kasslin et al.

Application No. 11/376,611

ON PETITION

Filed: March 14, 2006

Attorney Docket No. 944-004.067-

1/NC47622US

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 10, 2010, to revive the above-identified application.

### The petition is **GRANTED**.

The application became abandoned for failure to submit a proper reply in a timely manner to the final Office action mailed, October 15, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on January 16, 2010. A Notice of Abandonment was mailed on June 7, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a RCE (Request for Continued Examination), with the required fee of \$810, (2) the petition fee of \$1,620, and (3) a proper statement of unintentional delay. Accordingly, the RCE is accepted as being unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to the Technology Center AU 2617 for appropriate action in the normal course of business for processing of the RCE received June 10, 2010.

/Kimberly Inabinet/

Kimberly Inabinet Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C. P.O. BOX 398 AUSTIN, TX 78767-0398

MAILED

SEP 03 2010 Office of Petitions

In re Application of

Dominik J. Schmidt

Application No.: 11/376,700

ON PETITION

Filed: March 15, 2006

Attorney Docket No.: 6057-60801

This is a decision on the petition, filed September 2, 2010, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on June 14, 2010, cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 2812 for further processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

/SDB/

Sherry D. Brinkley Petitions Examiner Office of Petitions

<sup>&</sup>lt;sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s)
Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MAILED SEP 2 8 2010

FROST BROWN TODD, LLC 2200 PNC CENTER **201 E. FIFTH STREET CINCINNATI OH 45202** 

**OFFICE OF PETITIONS** 

In re Application of

George Digenis, et al.

Application No. 11/376,710

Filed: March 14, 2006

Attorney Docket No. 0114985.0558866

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 30, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, December 17, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on March 18, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment and RCE, (2) the petition fee of \$1,620, and (3) a proper statement of unintentional delay.

Télephone inquiries concerning this decision should be directed to Terri Johnson at (571) 272-2991.

This application is being referred to Technology Center AU 1627 for appropriate action by the Examiner in the normal course of business on the reply received.

/Terri Johnson/ Terri Johnson **Petitions Examiner** Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MARGARET ANDERSON 106 E. 6TH STREET, SUITE 900 AUSTIN TX 78701 MAILED
MAR 1 1 2011
OFFICE OF PETITIONS

In re Application of

Jung et al.

Application No. 11/376,711

Filed: March 15, 2006

Attorney Docket No. QQ1-0080US

DECISION ON PETITION

TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 26, 2011.

### The request is **NOT APPROVED**.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest who properly became of record under 37 CFR 3.71, or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.

According to a review of current USPTO records petitioner has not requested the address be changed to a properly recorded assignee or the first listed inventor. The Customer Number 55922 is neither the first named inventor nor the assignee who properly became of record under 37 CFR 3.71 As such, all future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Additionally, the address given on the petition differs from the address of record. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Further, the instant application became abandoned on December 11, 2010 for failure to timely respond to the Office action mailed September 10, 2010. The Office will not decide requests to withdraw from representation as practitioner of record which are filed

after the expiration date of a time period for reply or the expiration date of a time period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a). As such, any renewed Request to Withdraw as Attorney will not be treated on the merits, but will only be placed in the application.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-7751.

Joan Olszewski Petitions Examiner Office of Petitions

cc: LEE & HAYES, PLLC 601 W RIVERSIDE SUITE 1400 SPOKANE, WA 99201



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JUN 28 2011

OFFICE OF PETITIONS

KILPATRICK TOWNSEND & STOCKTON LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO CA 94111-3834

In re Application of:

YAN ET AL.

Serial No.: 11/376,768 Filed: March 15, 2006

Attorney Docket No.: 02307W-204010US

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 3, 2011, to revive the above-identified application.

### The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed October 19, 2010, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on December 20, 2010. See MPEP 1215.04.

The proposed reply required for consideration of a petition to revive must be an appeal brief under 37 CFR 41.37 and the appeal brief fee required by 37 CFR 41.20(b)(2), a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b).

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of \$405.00, and the submission required by 37 CFR 1.114; (2) the petition fee of \$810.00; and (3) a statement of unintentional delay.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the \$1,175.00 extension of time fee submitted with the petition on June 3, 2011 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's credit card.

This application is being referred to Technology Center AU 1725 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Any questions concerning this matter may be directed to Jose' G Dees at (571) 272-1569.

Christopher Bottorff Petitions Examiner

Cityl Bout

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

COOK, ALEX, McFARRON, MANZO, CUMMINGS & MEHLER, LTD. SUITE 2850 200 WEST ADAMS STREET CHICAGO IL 60606

In re Application of

Seo, et al.

Application No. 11/376,842

Filed: March 16, 2006

Attorney Docket No. 0553-0486

MAILED

SEP 2 0 2010

OFFICE OF PETITIONS

**DECISION ON PETITION** 

This is a decision on the renewed petition to withdraw the holding of abandonment under 37 CFR 1.181(a), filed May 12, 2010.

The renewed petition is granted.

This application was held abandoned September 16, 2009, after no reply was received to the non-final Office action mailed June 15, 2009. The notice set forth a shortened statutory period of reply of three months from its mailing date. No response was received within the allowable period and the application became abandoned on September 16, 2009. A Notice of Abandonment was mailed December 31, 2009. The instant petition was filed on February 24, 2010. Petitioner maintains that the non-final Office action was never received.

A review of the application file history reveals that the non-final Office action was returned to the USPTO on June 29, 2009. The evidence is convincing that petitioner did not receive the non-final Office action. The petition is granted. The holding of abandonment is, therefore, withdrawn<sup>1</sup>.

The application file is being directed to Technology Center, GAU 2815 for further processing.

<sup>&</sup>lt;sup>1</sup> As of the date of mailing of the instant petition decision, USPTO records still cite firm name preceding the mailing address for the subject application as that of "Cook, Alex, McFarron, Mazo, Cummings & Mehler, Ltd." Petitioner has indicated that the name of the firm has been shortened to "Cook Alex." Petitioner is cautioned to correct the firm name in the USPTO records to avoid future mishaps wherein the U.S. Postal Service returns correspondence to the USPTO because the firm name on the correspondence does not match address to which it is directed. Should the application become abandoned again because of such a mishap, and applicants have not corrected the firm name in USPTO record, it is likely that a petition to withdraw the holding of abandonment would not have a favorable outcome when the totality of application history is examined.

Questions concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Petitions Attorney Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

CADWALADER, WICKERSHAM & TAFT LLP ONE WORLD FINANCIAL CENTER NEW YORK NY 10281

# MAILED AUG 23 2011 OFFICE OF PETITIONS

In re Patent No. 7,959,664 : DECISION ON REQUEST FOR

JACOB RICHTER

Issued: June 14, 2011

Application No. 11/376,879

Filed: March 15, 2006

Attorney Docket No.

92077.027US1

: RECONSIDERATION OF PATENT

: TERM ADJUSTMENT AND

: NOTICE OF INTENT TO ISSUE

: CERTIFICATE OF CORRECTION

This is a decision on the petition filed on July 11, 2011, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the aboveidentified patent is extended or adjusted by one thousand thirteen (1013) days.

The petition to correct the patent term adjustment is being GRANTED to the extent that patent term adjustment indicated on the above-identified patent is nine hundred thirteen (913) days.

On June 4, 2011, the above-identified application matured into U.S. Patent No. 7,959,664. The patent issued with a revised Patent Term Adjustment of 934 days. On July 11, 2011, patentees filed a timely request for reconsideration within two months of the date the patent issued. See 37 CFR 1.705(d).

Patentees assert that the Office should not have assessed a period of 2 days of applicant delay pursuant to 37 CFR 1.704(b) for the filing of a reply on the next business day, Monday, June 15, 2009, to a non-final Office action mailed March 13, 2009.

Patentees' assertion is well taken. The reduction of 2 days pursuant to 37 CFR 1.704(b) will be removed.

Next, patentees dispute the period of reduction of 4 days for applicant delay pursuant to 37 CFR 1.704(c)(8) for the filing of an IDS on October 26, 2010. Patentees assert that the IDS was accompanied by an appropriate statement under 37 CFR 1.704(d).

## 37 CFR 1.704(c)(8) provides that:

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

\* \* \*

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date the supplemental reply or other such paper was filed.

## 37 CFR 1.704(d) provides that:

(d) A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6),(c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

It is undisputed that patentees filed an IDS on October 26, 2010, after a response was filed to the non-final Office action on October 22, 2010. A review of the IDS filed October 26, 2010, reveals that the IDS was accompanied by a statement under 37 CFR 1.704(d). Therefore, the period of reduction of 4 days is not merited and will be removed.

Patentees dispute the period of reduction of 9 days pursuant 37 CFR 1.704(c)(10) for the filing of the IDS on February 10, 2011, after the mailing of the notice of allowance. Patentees argue: "The rule \$1.704(b)(8) exception should have applied, because the information was submitted on instruction from the Examiner, and the IDS indicated this fact." Petition p. 4. "However, it appears the Office incorrectly applied \$1.704(b)(10)." Id. Additionally, patentees dispute the period of reduction pursuant to 37 CFR 1.704(c)(10) of 70 days for the filing of the IDS on March 8, 2011, after the mailing of the notice of allowance. Patentees assert that the IDS filed on March 8, 2011, was accompanied by an appropriate statement under 37 CFR 1.704(d).

### 37 CFR 1.704(c)(10) provides:

- (10) Submission of an amendment under  $\S$  1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in  $\S$  1.703 shall be reduced by the lesser of:
  - (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

#### (ii) Four months;

With regards to the IDS filed on February 10, 2011, patentees are incorrect the Office should have applied 37 CFR 1.704(c)(8) instead of 37 CFR 1.704(c)(10) to determine any period of reduction for its filing. As the supplemental IDS was filed after the mailing of the notice of allowance, the basis for entry of a period of reduction is 37 CFR 1.704(c)(10). By Notice entitled Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance, 1247 OG 111 (June 26, 2001), the Director set forth examples of papers deemed not to cause substantial interference and delay in the patent issue process. Other than those papers identified in this Notice, all papers filed after allowance of an application substantially delay the Office's ability to process an application for a patent because the Office does not wait until payment of the issue fee to begin the patent issue process. As a result, 37 CFR 1.704(c)(10) does not distinguish between papers that are and are not required by the Office.

The record reveals that the IDS was filed on February 10, 2011, after the mailing of the notice of allowance on January 7, 2011. The Office mailed a response to the IDS on February 18, 2011. The IDS filed February 10, 2011, did not include a statement under 37 CFR 1.704(d). Accordingly, the submission of the IDS on February 10, 2011, after the mailing of the notice of allowance, is a proper basis under 37 CFR 1.704(c)(10) for reduction of the period of adjustment set forth in § 1.703. Therefore, the period of reduction of 9 days is merited and will not be removed.

With regards to the IDS filed on March 8, 2011, it is undisputed that patentee filed the IDS after the mailing of the notice of allowance on January 7, 2011. A review of the IDS filed March 8, 2011, reveals that the IDS was accompanied by a statement under 37 CFR 1.704(d). Therefore, the period of reduction of 70 days is not merited and will be removed.

Lastly, a further review of the record reveals that an additional period of reduction is warranted under 37 CFR 1.704(c)(8) for the filing of Information Disclosure Statements on April 19, 2010, and May 18, 2010, after a response was filed to the nonfinal Office action on February 10, 2010. A review of the Information Disclosure Statements, filed April 19, 2010, and May 18, 2010, reveals that the Information Disclosure Statements were not accompanied by a statement under 37 CFR 1.704(d). Furthermore, the record does not support a conclusion that the examiner expressly requested the filing of either Information Disclosure Statement. Thus, patentees failed to engage in reasonable efforts to conclude prosecution of the application.

Pursuant to 37 CFR 1.704(c)(8), a first period of reduction of 68 days should have been entered, counting the number of days beginning on the day after the date the reply was filed, February 11, 2010, and ending on the date that the IDS was filed, April 19, 2010. Pursuant to 37 CFR 1.704(c)(8), a second period of reduction of 97 days should have been entered, counting the number of days beginning on the day after the date the initial reply was filed, February 11, 2010, and ending on the date that the IDS was filed, May 18, 2010.

37 CFR 1.704(c) provides that "[c]ircumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application ... will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping." In this instance, the first period of reduction of 68 days (from February 11, 2010 to April 19, 2010) totally overlaps with the second period of reduction of 97 days (from

February 11, 2010 to May 18, 2010). As the periods of reduction under 37 CFR 1.704(c)(10) completely overlap, a single reduction of 97 days (from February 11, 2010 to May 18, 2010) will be entered.

In view thereof, the patent term adjustment is 913 days (714 days of "A delay" + 331 days of "B delay" - 4 days of overlap - 128 day of applicant delay).

The Office will sua sponte issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentee is given one (1) month or thirty (30) days, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges the payment of the \$200.00 fee set forth in 37 CFR 1.18(e) as authorized. No additional fees are required.

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by 913 days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

C. Y. Donnell

Christina Tartera Donnell Senior Petitions Attorney Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

## **DRAFT COPY**

## UNITED STATES PATENT AND TRADEMARK OFFICE **CERTIFICATE OF CORRECTION**

PATENT

: 7,959,664 B2

DATED

: Jun. 14, 2011

INVENTOR(S): Richter

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

Subject to any disclaimer, the term of this patent is extended or adjusted [\*] Notice: under 35 USC 154(b) by (934) days.

Delete the phrase "by 934 days" and insert – by 913 days--





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MAILED

Barry J. Marenberg 76 Brookside Drive New Providence NJ 07974 1

NOV 2 2 2010

OFFICE OF PETITIONS

In re Application of Braginsky, et al.

Application No. 11/376,947

Filed: March 16, 2006

Attorney Docket No PYMBBJM0005

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 2, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on February 9, 2010, for failure to respond to the Notice Requiring Excess Claim Fees mailed January 8, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the excess claim fees; (2) the petition fee; (3) and adequate statement of unintentional delay.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being

mailed to the person signing the instant petition, all future correspondence will be directed to the address of currently of record until such time as appropriate instructions are received to the contrary.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

The application file is being directed to Technology Center, GAU 1619 further processing.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Petitions Attorney Office of Petitions

cc: Philip Y. Braginsky 100-17 67<sup>th</sup> Drive Forest Hills, NY 11375



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

CANTOR COLBURN LLP - SABIC EXATEC 20 CHURCH STREET 22ND FLOOR HARTFORD, CT 06103

MAILED OCT 2 4 2011 OFFICE OF PETITIONS

In re Application of

Meng Chen, et al.

Application No.: 11/376,999

1/376,999 :

Filed: March 16, 2006

Attorney Docket No.: 10EXT0043-US-NP

ON PETITION

This is a decision on the petition, filed October 24, 2011, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on September 22, 2011, cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.\(^1\)

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 1787 for further processing of the request for continued examination and for consideration of the concurrently filed Information Disclosure Statement (IDS).

/SDB/

Sherry D. Brinkley Petitions Examiner Office of Petitions

<sup>&</sup>lt;sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s)
Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.

Doc Code: PET.PTA.RCAL

Document Description: Request for Recalculation in view of Wyeth

PTO/SB/131 (01-10)

Approved for use through 02/28/2011, OMB 0651-0020 U.S. Patent and Trademark Office, U. S. DEFARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless if displays a valid OMB control number.

### REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

Attorney Docket Patent Number: 7,667,747 060070 Number: Filing Date Issue Date: 2-23-2010 (or 371(b) or (f) Date): 3-15-2006

inventor

SZEPO ROBERT HUNG

Title: PROCESSING OF SENSOR VALUES IN IMAGING SYSTEMS

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-WYETH INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

Signature State A A A	Date 4-1/2/2013	
Name (Print/Typed) Espartaco Diaz Hidalgo	Registration Number 60586	
Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below*.		
*Total of forms are submitted.		

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450, DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OM8 control number

### Instruction Sheet for: REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

(Not to be Submitted to the USPTO)

This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A).

This form must be filed within 180 days of the day the patent was granted, with the following exception:

Patentees who received a decision from the USPTO under the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A) may file a request for reconsideration of that decision if such a request for reconsideration is filed within two months of the date of the decision (37 CFR 1.181(f)). If the patentee's sole basis for requesting reconsideration of the decision is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A), the request for reconsideration need only state that reconsideration is being requested in view of Wyeth (this form may be used for this purpose if it is filed within two months of the date of the decision from the USPTO).

Do not use this form if the application has been allowed, but not yet issued as a patent.

- 1. For patents issued before March 2, 2010: A request for reconsideration under 37 CFR 1,705(d) and the fee set forth in 37 CFR 1,18(e) are not required, provided that the patentee's sole basis for requesting recalculation of the PTA in the patent is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A) and this form is filed within 180 days of the day the patent was granted.
- 2. For patents issued on or after March 2, 2010 (do not use this form): Patentees seeking a revised PTA in a patent issued on or after March 2, 2010, must file a request for reconsideration under 37 CFR 1.705(d) that complies with the requirements of 37 CFR 1.705(b)(1) and (b)(2) within two months of the day the patent issued.

For more information, see "Notice Concerning Calculation of the Patent Term Adjustment With Respect to the Overlapping Delay Provision of 35 U.S.C. 154(b)(2)(A)" available on the USPTO Web site at http://www.uspto.gov/patents/law/notices/2010.jsp.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

#### Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

- The information on this form will be treated confidentially to the extent allowed under the
  Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from
  this system of records may be disclosed to the Department of Justice to determine whether
  disclosure of these records is required by the Freedom of Information Act.
- A record from this system of records may be disclosed, as a routine use, in the course of
  presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to
  opposing counsel in the course of settlement negotiations.
- A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record
- 4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
- 5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
- A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
- 7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
- 8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
- A record from this system of records may be disclosed, as a routine use, to a Federal, State,
  or local law enforcement agency, if the USPTO becomes aware of a violation or potential
  violation of law or regulation.



## United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/17/2010

QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121

Applicant : Szepo Robert Hung

Patent Number: 7667747 Issue Date : 02/23/2010

Application No: 11/377,086 Filed : 03/15/2006 : DECISION ON REQUEST FOR : RECALCULATION of PATENT

: TERM ADJUSTMENT IN VIEW : OF WYETH AND NOTICE OF INTENT TO

: ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 967 days. The USPTO will sua sponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Decision Date February 6, 2012

In re Application of Toru Yahagi

Application No. 11377087

Filed: 15-Mar-2006

DECISION ON PETITION UNDER CFR 1.137(b)

Attorney Docket No. MDA-001

This is an electronic decision on the petition under 37 CFR 1.137(b), February 6, 2012 , to revive the above-identified application.

#### The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the outstanding Office communication. The date of abandonment is the day after the last day of the period set for reply in the Office action plus any applicable extensions of time properly requested.

The electronic petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of a response; (2) the petition fee as set forth in 37 CFR 1.17 (m); and (3) the required statement of unintentional delay have been received. Accordingly, the response is accepted as having been unintentionally delayed.

The statement of unintentional delay is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay and by a person having firsthand or direct knowledge of the facts and circumstances of the delay at issue. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg.53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

This application file is being directed to the Technology Center.

oc Code: PET.AUTO ocument Description: Petition aut	omatically granted by EFS-Web	PTO/SB/64 U.S. Patent and Trademark Office Department of Commerce
Electronic Petition Request	PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)	
Application Number	11377087	
Filing Date	15-Mar-2006	
First Named Inventor	Toru Yahagi	
Attorney Docket Number	MDA-001	
Title	Surgical procedure and instrumentation for intrastromal implants of lens or strengthenin	
United States Patent and Tradema		imely and proper reply to a notice or action by the the day after the expiration date of the period set for otained.
APPLICANT HEREBY PETITIONS FO	R REVIVAL OF THIS APPLICATION	
design applications; and (4) Statement that the entire delay	imer fee - required for all utility and pla	nnt applications filed before June 8, 1995; and for all
etition Fee	TV status   Coo 27 (*ED 1 27	
Applicant claims SMALL ENTI		N-7/ \/0\
0	ng SMALL ENTITY status. See 37 CFR 1.2	2/(g)(2).
<ul> <li>Applicant(s) status remains a</li> </ul>		
Applicant(s) status remains as  Reply and/or fee	s other than SMALL ENTITY.	
. ,	.7 CFR 1.4(d)(4) that the amendment an e-identified application on	nd response have
<ul> <li>Amendment and response ar</li> </ul>	re attached	
CE request, submission, and fee.		
I certify, in accordance with 37	7 CFR 1.4(d)(4) that the RCE Request, Su e-identified application on	bmission, and Fee have
RCE Request, Submission, and Fee are attached		
otice of Appeal		

I certify, in accordance with 37 CFR 1.4(d)(4) that the Notice of Appeal and Fee have already been filed in the above-identified application on			
Notice of Appeal and Fee are a	Notice of Appeal and Fee are attached		
. Terminal Disclaimer is not required, since the Electronic Petition format is not support for Design applications and pplications filed before June 8, 1995. Please file using regular petition format for review by the Office of Petitions.			
STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.			
THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES			
I certify, in accordance with 37 CFR 1.4(d)(4) that I am:			
An attorney or agent registered to practice before the Patent and Trademark Office who has been given power of attorney in this application.			
An attorney or agent registered to practice before the Patent and Trademark Office, acting in a representative capacity.			
A sole inventor			
A joint inventor; I certify that I am authorized to sign this submission on behalf of all of the inventors			
A joint inventor; all of whom are signing this e-petition			
The assignee of record of the entire interest that has properly made itself of record pursuant to 37 CFR 3.71			
Signature	/DMMorse/		
Name	David M. Morse		
Registration Number	50505		



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP 390 LYTTON AVENUE PALO ALTO, CA 94301

MAILED

MAR 25 2011

OFFICE OF PETITIONS

In re Application

Anthony G. Martin

Application No. 11/377,095

Filed: March 16, 2006

Attorney Docket No. CLAR 1057-1

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 8, 2011.

The request is **NOT APPROVED**.

The Office strongly encourages practitioner(s) requesting withdrawal from representation as practitioner of record in an application to review the record to determine whether he or she is, in fact, of record and how he or she was made of record. For example, the practitioner(s) should determine whether he or she was appointed by naming each practitioner individually or through the use of a Customer Number.

In the instant application, the practitioner(s) were appointed via Customer Number however the request does not designate a Customer Number to be withdrawn by. Therefore, the current request cannot be approved at this time. Any subsequent request must withdraw all associated practitioner(s) in the same manner as appointed.

All future communications from the Office will continue to be directed to the above-listed address until properly notified.

There is an outstanding Office action mailed November 1, 2010, that requires a reply from the applicant.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-6059. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Alicia Kelley

**Petitions Examiner** 

		PTO/SB/83	
Doc Code:  PET.AUTO Document Description: Petitic	on automatically granted by EFS-Web	U.S. Patent and Trademark Office Department of Commerce	
Electronic Petition Request	REQUEST FOR WITHDRAWAL AS ATTORI	REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF	
Application Number	11377095	11377095	
Filing Date	16-Mar-2006	16-Mar-2006	
First Named Inventor	Anthony Martin	Anthony Martin	
Art Unit	2169	2169	
Examiner Name	JAMES WILCOX		
Attorney Docket Number	4001-0018		
Title	Categorization of locations and documents in a computer network		
The reason(s) for this request a	d associated with Customer Number: re those described in 37 CFR:		
Certifications			
I/We have given reasonab intend to withdraw from e	ole notice to the client, prior to the expiration of themployment	e response period, that the practitioner(s)	
I/We have delivered to the to which the client is entit	e client or a duly authorized representative of the led	client all papers and property (including funds)	
	ent of any responses that may be due and the time		
	, ,	e frame within which the client must respond	
	dress and direct all future correspondence to: ned inventor or assignee that has properly made it		
The address of the first nam 37 CFR 3.71, associated with Cus	dress and direct all future correspondence to: ned inventor or assignee that has properly made it	16.6	
The address of the first nam 37 CFR 3.71, associated with Cus	dress and direct all future correspondence to: ned inventor or assignee that has properly made it stomer Number:	16.6	
The address of the first nam 37 CFR 3.71, associated with Cus I am authorized to sign on beha	dress and direct all future correspondence to: ned inventor or assignee that has properly made it stomer Number:  If of myself and all withdrawing practitioners.	16.6	



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Decision Date : December 1, 2011

In re Application of : DECISION ON REQUEST TO WITHDRAW AS

Anthony Martin ATTORNEY/AGENTOF RECORD

Application No: 11377095 Filed: 16-Mar-2006

Attorney Docket No: 4001-0018

This is an electronic decision on the Request to Withdraw as attorney or agent of record under 37 CFR§ 1.36(b), filed December 1, 2011

#### The request is **APPROVED**

The request was signed by Brian Siritzky (registration no. 37497 ) on behalf of all attorneys/agents associated with Customer Number 91944 have been withdrawn.

Since there are no remaining attorneys of record, all future communications from the Office will be directed to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71, with Customer number 86636

As a reminder, requester is required to inform the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 of the electronically processed petition.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

**SMARTDRIVE SYSTEMS, INC.** P.O. BOX 757 LA JOLLA CA 92038

MAILED

OCT 18 2011

OFFICE OF PETITIONS

In re Application of

**PLANTE** 

Application No. 11/377,164

**DECISION ON PETITION** 

Filed: March 16, 2006

Docket No. 266.8

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 20, 2011, to revive the above-identified application.

#### The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, September 11, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on December 12, 2008. A Notice of Abandonment was mailed May 6, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of \$810; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6735.

This application is being referred to Technology Center AU 3661 for appropriate action by the Examiner in the normal course of business.

/Diane Goodwyn/ Diane Goodwyn **Petitions Examiner** Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

SMARTDRIVE SYSTEMS, INC. P.O. BOX 757
LA JOLLA CA 92038

MAILED

SEP 29 2011

In re Application of

:

OFFICE OF PETITIONS

Plante

Application No. 11/377,167

DECISION ON PETITION

Filed: March 16, 2006

PURSUANT TO

Attorney Docket No. 266.6

37 C.F.R. § 1.137(B)

Title: VEHICLE EVENT

DECORDED GUGERIG TIE

RECORDER SYSTEMS AND NETWORKS HAVING INTEGRATED

CELLULAR WIRELESS

COMMUNICATIONS SYSTEMS

identified application.

This is a decision on the petition pursuant to 37 C.F.R. § 1.137(b), filed September 20, 2011, to revive the above-

This petition pursuant to 37 C.F.R. § 1.137(b) is GRANTED.

The above-identified application became abandoned for failure to reply in a timely manner to a non-final Office action, mailed June 5, 2008, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on September 6, 2008. A notice of abandonment was mailed on January 23, 2009.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R.
  § 1.17(m);

- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

With this petition, Petitioner has submitted an amendment, the petition fee, and the proper statement of unintentional delay. As such, the first three requirements of Rule 1.137(b) have been met. The fourth requirement of Rule 1.137(b) is not applicable, as a terminal disclaimer is not required.

The record (including the petition filed on September 20, 2011) does not necessitate a finding that the delay between September 6, 2008 (the date of abandonment) and September 20, 2011 (the date of the filing of a grantable petition) was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on the duty of candor and good faith of Petitioners (Smartdrive Systems, Inc. and James Plante) and their Counsel (Joseph Page, Reg. No. 35,311) when accepting Petitioners' representation that the delay in filing the response was unintentional.<sup>2</sup>

The Technology Center will be notified of this decision, and jurisdiction over this application is transferred to the Technology Center, so that the application may receive further processing. The Technology Center's support staff will notify the Examiner of this decision, so that the amendment that was received on September 20, 2011 can be processed in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the present decision to ensure that the revival has been acknowledged by the Technology Center in response to this decision. It is noted that all inquiries with regard to any

<sup>1</sup> See Rule 1.137(d).

<sup>2</sup> See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 C.F.R. \$ 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. \$ 1.137(b) to the Patent and Trademark Office).

failure of that change in status should be directed to the Technology Center where that change of status must be effected the Office of Petitions cannot effectuate a change of status.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.3 All other inquiries concerning this application should be directed to the Technology Center.

Paul Shanoski Senior Attorney

<sup>3</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

November 4, 2011

OSI PHARMACEUTICALS, LLC 1 Bioscience Park Drive Farmingdale NY 11735

In re Application of

Hally, John D. et. al : **DECISION ON PETITION** 

Application No. 11/377,530 :

Filed: 03/16/2006 : *ACCEPTANCE OF COLOR* 

Attorney Docket No. OS-10033 : DRAWINGS

This is a decision on the Petition to Accept Color Drawings under 37 C.F.R 1.84 (a) (2), received in the United States Patent and Trademark Office (USPTO) March 16, 2006.

The petition is **GRANTED**.

A grantable petition under 37 C.F.R. 1.84(a) (2) must be accompanied by the following.

- 1. The fee set forth under 37 C.F.R. 1.17(h),
- 2. Three (3) sets of the color drawings in question, or (1) set if filed via EFS, and
- 3. The specification contains appropriate language referring to the color drawings as the first paragraph in that portion of the specification relating to the brief description of the drawings.

The petition was accompanied by all of the required fees and drawings. The specification contains the appropriate language. Therefore, the petition is <u>GRANTED</u>.

Telephone inquires relating to this decision may be directed to the undersigned in the Office of Data Management at 571-272-4200.

/Diane Terry/
Quality Control Specialist
Office of Data Management
Publications Branch

	SPE RESPONS	SE FOR CERTIFICATE OF CORRECTION		
DATE	: <u>9-24-11</u>			
TO SPE OF	: ART UNIT <b>1781</b>			
SUBJECT	: Request for Certificate of C	Request for Certificate of Correction for Appl. No.: 11377621 Patent No.: 8003147		
CofC mailroon	n date: 9-13-11			
		a certificate of correction within 7 day	ys.	
FOR IFW FI	LES:			
the IFW app		es/corrections as shown in the COC v matter should be introduced, nor s		
•	olete the response (see	below) and forward the completed	response to scanning	
FOR PAPER	R FILES:			
		es/corrections as shown in the attac rm (see below) and forward it with the		
Rand	icates of Correction E olph Square – 9D40-E Location 7580	•		
Note: _				
			Omega Lev	
			<u>703-756-15</u>	
Thank You	For Your Assistance			
•	t for issuing the above non the appropriate box.	e-identified correction(s) is hereb	y:	
	Approved	All changes apply.		
	Approved in Part	Specify below which cha	nges <b>do not</b> apply.	
	Denied	State the reasons for der	nial below.	
Comments:	Approved			
		/ D Lawrence Tarazano/	1781	
		SPE	Art Unit	
L-306 (REV. 7/03)		U.S. DEPARTMENT OF COMMER	CE Patent and Trademark Off	

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450

MAILED

JUL 06 2011

OFFICE OF PETITIONS

TOD R NISSLE PO BOX 55630 PHOENIX AZ 85078

In re Application of

Adam A. OCHOA : ON PETITION

Application No. 11/377,624 :

Filed: March 16, 2006 :

Atty. Docket No.: 1191-P-1

This is a decision on the petition under 37 CFR 1.137(b), filed March 3, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application was held abandoned for failure to reply in a timely manner to the Notice of Allowance and Fee(s) Due mailed December 5, 2008, which set a statutory period for reply of three (3) months. The application became abandoned on March 6, 2009, and a Notice of Abandonment was mailed March 31, 2009.

The petition satisfies the conditions for revival pursuant to 37 CFR 1.137(b) by including (1) a reply in the form of payment of the issue and publication fees in accordance with the Notice of Allowance and Fee(s) Due, (2) a petition fee of \$810, and (3) a statement of unintentional delay. The reply to the Notice is accepted as having been unintentionally delayed.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. If the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

Telephone inquires regarding this decision should be directed to Robert DeWitty, Petitions Attorney, Office of Petitions (571-272-8427).

The application file will be referred to Office of Data Management for further processing.

Anthony Knight

Director



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Rahman LLC 10025 Governor Warfield Parkway, Suite 110 Columbia MD 21044

MAILED

AUG 03 2010

In re Application of

OFFICE OF PETITIONS

ISMAIL et al.

:

Application No. 11/377,721

: DECISION ON PETITION

Filed: March 16, 2006

Attorney Docket No. NMI.5005

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 3, 2009, to revive the above-identified application.

#### The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item(s) (3) in that the statement of delay included with the instant petition is unacceptable for the reason(s) set forth below.

In regard to item (3), it should be noted that petitioner's statement (see page 2 of the petition previously filed on July 21, 2009) "On April 6, 2009, a Notice of Allowance was issued for the Patent Application with a three-month statutory period for response (i.e., the issue fee was due by July 6, 2009)" clearly shows that the petitioner was aware of the requirement to pay the Issue and Publication fees on or before July 6, 2009. Furthermore, petitioner states on page 4 of this earlier filed petition, "Because of the unresolved issue pertaining to whether all of the cited prior art

contained in both PTO-1449 Forms had been considered by the Examiner in determining patentability of the Patent Application, the issue fee was not paid by the statutory 3-month date of July 6, 2009" (emphases added). These two statements by the petitioner appear to suggest that the decision to delay the payment of the Issue fee was intentional. An intentional delay precludes revival under 37 CFR 1.137(a) ("unavoidable" delay) or 37 CFR 1.137(b) ("unintentional" delay). See In Re Maldague, 10 USPQ2d at 1478.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

Mail Stop PETITION

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

By hand:

U. S. Patent and Trademark Office

Customer Service Window, Mail Stop Petitions

Randolph Building 401 Dulany Street Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Telephone inquiries concerning this decision should be directed to Ramesh Krishnamurthy at (571) 272-4914.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4914.

Ranesh Krishnamurthy

Petitions Examiner,

SPE RESPONSE FI	OR CERTIFICATE OF CORRECTION	<b>¬</b>
DATE <u>January 13, 2011</u>	Paper No.:	.
TO SPE OF : ART UNIT 2116	tion for Appl. No.: 11/377747 Patent No.: 7814307	Deleted: Z
•	CofC mailroom date: 01-5-10	·
Please respond to this request for a cer	tificate of correction within 7 days.	
FOR IFW FILES:		ļ.
Please review the requested changes/of the IFW application image. No new marked meaning of the claims be changed.	corrections as shown in the COCIN document(s) in latter should be introduced, nor should the scope or	
Please complete the response (see beliusing document code COCX.	ow) and forward the completed response to scanning	
FOR PAPER FILES:		
Please review the requested changes/c correction. Please complete this form (	orrections as shown in the attached certificate of see below) and forward it with the file to:	
Palm Location 7580	Magdalene Talley	
	Certificates of Correction Branch	
	<u>571-272-0423</u>	
Thank You For Your Assistance		
The request for issuing the above-ide Note your decision on the appropriate box.	entified correction(s) is hereby:	
<u>x</u> Approved	All changes apply.	Formatted: Indent: Left: 8
<u>x</u> Approved  ☐ Approved in Part	All changes apply.  Specify below which changes do not apply.	Formatted: Indent: Left: 8
_ , ,		Formatted: Indent: Left: 8
☐ Approved in Part☐ Denied	Specify below which changes <b>do not</b> apply.  State the reasons for denial below.	Formatted: Indent: Left: 8
☐ Approved in Part	Specify below which changes <b>do not</b> apply.  State the reasons for denial below.	,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,
☐ Approved in Part☐ Denied	Specify below which changes <b>do not</b> apply.  State the reasons for denial below.	,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,
☐ Approved in Part☐ Denied	Specify below which changes <b>do not</b> apply.  State the reasons for denial below.	,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,
☐ Approved in Part☐ Denied	Specify below which changes <b>do not</b> apply.  State the reasons for denial below.	Formatted: Indent: Left: 88
☐ Approved in Part☐ Denied	Specify below which changes <b>do not</b> apply.  State the reasons for denial below.	,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,

2115
U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

PTOL-306 (REV. 7/03)

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701 JUL 01 2011

OFFICE OF PETITIONS

In re Patent No. 7,818,185 Issued: October 19, 2010

Application No. 11/377,773

Filed: March 15, 2006

Attorney Docket No.: UHGI.P0457US

**NOTICE** 

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28, filed May 27, 2011.

The Office no longer investigates or rejects original or reissue patent under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

/SDB/

Sherry D. Brinkley Petitions Examiner Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION		
	Paper No.:	
DATE <u>11/23//10</u>	<del></del>	
TO SPE OF : ART UNIT 3766 (3700)		
SUBJECT : Request for Certificate of Correction for A	Appl. No.: 11/377,881 Patent No.: 7,693,579	
Please respond to this request for a certificate	of correction within 7 days.	
FOR IFW FILES:		
Please review the requested changes/correcti the IFW application image. No new matter sh meaning of the claims be changed.	· · · · · · · · · · · · · · · · · · ·	
Please complete the response (see below) an using document code COCX.	d forward the completed response to scanning	
FOR PAPER FILES:		
Please review the requested changes/correctic correction. Please complete this form (see be		
Certificates of Correction Branch (CofC) Randolph Square – 9D10-A Palm Location 7580		
	Ernest C. White. 19E	
	Randolph Sq. Ste 9D62A	
	703-756-1590	
Thank You For Your Assistance		
The request for issuing the above-identified Note your decision on the appropriate box.	d correction(s) is hereby:	
Approved	All changes apply.	
☐ Approved in Part	Specify below which changes do not apply.	
Denied  Correction OF TYPORIABITICAL	State the reasons for denial below.	

SPE Carl H- Fayro ART UNIT 376

PTOL-306 (REV. 7/03)



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.usplo.gov

SHEPPARD MULLIN RICHTER & HAMPTON, LLP 390 LYTTON AVENUE PALO ALTO, CA 94301

MAILED

MAR 21 2011

OFFICE OF PETITIONS

In re Application of

Scott EAGLE, et al.

Application No. 11/377,932

Filed: March 16, 2006

Attorney Docket No. 4001-0005

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 7, 2011.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to **SHEPPARD MULLIN RICHTER & HAMPTON**, **LLP** has been revoked by the assignee of the patent application on February 8, 2011. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-7253.

/Monica A. Graves/ Petitions Examiner, Office of Petitions

CC: DAVIDSON BERQUIST JACKSON & GOWDEY, LLP ATTN: CLARIA/DR. BRIAN SIRITZKY, ESQ. 4300 WILSON BOULEVARD, 7<sup>TH</sup> FLOOR

ARLINGTON, VA 22203

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Patent No. : 7833334 Application No.: 11/378041

Inventor(s) : Pierre de Saint-Romain

Issued : 11/16

: 11/16/2010

Title : INK COM

: INK COMPOSITION FOR CONTINUOUS DEVIATED JET PRINTING

Attorney Docket No.: BRE-40016

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based solely on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing <u>incorrect or erroneous</u> assignment data, before issuance of a Certificate of Correction, under 37 CFR 1.323 (see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481). This procedure is required at any time after the issue fee is paid, including after issuance of the patent.

In view of the foregoing, your request, in this matter, is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

- A. the processing fee set forth in 37 CFR 1. 17(i) (currently \$130);
- <u>B.</u> a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
- <u>C.</u> a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail:

Mail Stop PETITIONS Commissioner for Patents Post Office Box 1450 Alexandria, VA 22313-1450 By hand:

Customer Service Window

Mail Stop Petitions Randolph Building 40l Dulany Street Alexandria, VA 22314

By fax:

571-273-0025

ATTN: Office of Petitions

If a fee (currently \$100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

## Tasneem Siddiqui

For Mary Diggs (Supervisor)
Decisions & Certificates of Correction Branch
(703) **756-1593** or (703) 756-1814
Date: 01/12/2011

Address: Joseph J. Corso Pearne & Gordon, LLP 1801 East Ninth Street, Suite 1200 Cleveland, Ohio 44114-3108

ts/md



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

www.uspto.gov

9/7/2010

Patent No.

:7762094

Ser. No.

:11/378044

Inventor(s)

:Izumi Iwaki et al.

Issued

:7/27/10

Title

:VALVE CONTROL SYSTEM, VALVE CONTROL APPARATUS AND

VALVE CONTROL METHOD

Docket No. :

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing *incorrect or erroneous* assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 (see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481). This procedure is required at any time after the issue fee is paid, including after issuance of the patent.

In view of the foregoing, your request, in this mater, is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

- A. the processing fee set forth in 37 CFR 1.17(h) (currently \$130);
- B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
- <u>C.</u> a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail:

Mail Stop PETITIONS Commissioner for Patents Post Office Box 1450

Alexandria, VA 22313-1450

By hand:

Customer Service Window

Mail Stop Petitions Randolph Building 40l Dulany Street Alexandria, VA 22314

By fax:

(703) 872-9306

ATTN: Office of Petitions

If à fee (currently \$100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, , no additional fee is required.

A certificate of correction will be issued to correct the remaining errors noted in your request.

# Henry Randall .

Decisions & Certificates of Correction Branch (703) 756-1571

GRGORY D. DEGRAZIA HOWARD & HOWARD PLLC 450 W. 4<sup>TH</sup> ST. ROYAL OAK, MI 48067

HR



COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
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Paper No.

HOWARD & HOWARD ATTORNEYS PLLC 450 West Fourth Street Royal Oak MI 48067

DEC 0 6 2010

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**OFFICE OF PETITIONS** 

In re Application of

Iwaki et al.

Application No. 11/378,044

In re Patent No. 7,762,094 Filing Date: March 17, 2006

DECISION ON PETITION PURSUANT TO 37 C.F.R.

Issue Date: July 27, 2010 : § 3.81(B)

Attorney Docket Number:

060233.00023

Title: VALVE CONTROL SYSTEM, VALVE CONTROL APPARATUS AND

VALVE CONTROL METHOD

:

This is a decision on the petition pursuant to 37 C.F.R. § 3.81(b), filed November 18, 2010, to correct the Assignee's information on the Issue Fee Transmittal Form PTOL-85(b).

:

The petition is GRANTED.

With this petition, Petitioner requests that a Certificate of Correction be issued to correct the assignee information that appears on the face of the patent. Petitioner has requested that the name of the Assignee should be changed from "Fujkoki Corporation, Tokyo (JP)" to "Fujikoki Corporation, Tokyo (JP)."

# 37 C.F.R. §3.81(b), effective June 25, 2004, reads:

(b) After payment of the issue fee: Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in 3.11 before issuance of the patent, and must include a request for a certificate of correction under 1.323 of this chapter (accompanied

<sup>1</sup> Petitioner has also listed the incorrect Assignee name as "Fujkojo Corporation," but this appears to be a typographical error. Petition, page 1.

Application No. 11/378,044 Patent No. 7,762,094

by the fee set forth in 1.20(a)) and the processing fee set forth in 1.17(i) of this chapter.

Petitioner has set forth that the assignment was submitted for recordation as set forth in 37 C.F.R. § 3.11 before issuance of the patent, and Office records confirm that an assignment was received in the Office on March 24, 2006, listing Fujikoki Corporation of Tokyo, Japan as the assignee.

Payment of the required \$100 certificate of correction fee and the \$130 processing fee is acknowledged.

The Certificates of Correction Branch will be notified of this decision so that the requested Certificate of Correction can be issued, correcting the Assignee information to "Fujikoki Corporation, Tokyo (JP)."

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. Any questions concerning the issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (703) 756-1814.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

April 5, 2011

James F. Lea, III 321 S. Boston Suite 800 Tulsa, OK 74103

Patent No.: 7870138 B2

Inventor(s): Richard Alton Van Voorhis

Issued: January 11, 2011

Title: FILE STORAGE AND RETRIEVAL METHOD

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322/1.323.

A petition under C.F.R. 1.182 is required to correct the alleged errors in incorrect inventors' address, since inventors' addresses are printed in accordance with the "Residence Address in assigned patents or P.O. Box Address for not assigned patents" on the Declaration. The error is the result of applicant' failure to comply with requirements that the complete and correct address is indicated. Therefore, no correction is in order here under the provisions of Rule 1.322 or 1.323 (required fee currently \$100), unless a petition is granted.

In view of the foregoing, your request, in this mater, is hereby denied.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 1.182 should be directed to the following address or facsimile number:

By mail: Mail Stop PETITIONS

Commissioner for Patents Post Office Box 1450

Alexandria, VA 22313-1450

By hand:

Customer Service Window

Mail Stop Petitions Randolph Building 401 Dulany Street Alexandria, VA 22314

By fax:

(703) 872-9306

ATTN: Office of Petitions

If a fee (currently \$100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

/Virginia Tolbert/ Virginia Tolbert For Mary F. Diggs Decisions & Certificates of Correction Branch (571) 272-0460



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P.O. Box 1450
Alexandria, VA 22313-1450
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LEE & HAYES, PLLC 601 W. RIVERSIDE AVENUE SUITE 1400 SPOKANE WA 99201

MAILED

JUL 2 5 2011

OFFICE OF PETITIONS

In re Application of

David M. Chickering et al

Application No. 11/378,202

Filed: March 17, 2006

Attorney Docket No. MS1-4537US

: DECISION GRANTING PETITION

: UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed, July 22, 2011 to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on July 6, 2011 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 2626 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/
Irvin Dingle
Petitions Examiner
Office of Petitions

<sup>&</sup>lt;sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).



Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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NIXON PEABODY, LLP 300 S. Riverside Plaza, 16th Floor CHICAGO IL 60606-6613

MAILED

JUN 06 2011

In re Application of : OFFICE OF PETITIONS

Alfred Perlin Application No. 11/378,457

Filed: March 17, 2006

Attorney Docket No. 68485-00002USP1

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 13, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Restriction Requirement mailed August 6, 2008, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on September 7, 2008. A Notice of Abandonment was mailed on May 13, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an election and amendment, (2) the petition fee of \$810, and (3) a proper statement of unintentional delay. Accordingly the election and amendment are accepted as being unintentionally delayed.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to Technology Center AU 3731 for appropriate action by the Examiner in the normal course of business on the reply received May 13, 2011.

/Kimberly Inabinet/

Kimberly Inabinet Petitions Examiner Office of Petitions

cc: Marc D. Machtinger
Law Office of Marc D. Machtinger, Ltd.
750 W. Lake Cook Road, #350
Buffalo Grove, IL 60089



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

C. JAMES BUSHMAN 5851 SAN FELIPE SUITE 975 HOUSTON TX 77057

MAILED
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OFFICE OF PETITIONS

In re Application of

Wood et al.

Application No. 11/378,498

Filed: 03/17/2006

Attorney Docket No. Xtreme-18-1

**DECISION ON PETITION** 

This is a decision on the petition under 37 CFR 1.137(b), filed October 20, 2010, to revive the above-identified application.

# The petition is **GRANTED**.

The application became abandoned for failure to timely and proper reply within the meaning of 37 CFR 1.113 to the final Office action, mailed April 13, 2010, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on July 14, 2010. A Notice of Abandonment was mailed on October 21, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that applicant has supplied (1) the reply in the form of a RCE, the RCE fee, and the submission required by 37 CFR 1.114; (2) the petition fee; and (3) a proper statement of unintentional delay.

This application is being referred to Technology Center AU 3676 for processing of the RCE and for appropriate action by the Examiner on the amendment submitted in accordance with 37 CFR 1.114.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell Senior Petitions Attorney

Christina Partere Donnell

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI, L.L.P. 20333 SH 249 6th Floor HOUSTON TX 77070

MAILED
JUN 2 0 2011
OFFICE OF PETITIONS

In re Application of

Mark A. George et al.

Application No. 11/378,580

Filed: March 15, 2005 Attorney Docket No. 149-0119US-D **DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 16, 2011.

#### The request is **NOT APPROVED.**

The Office will no longer accept address changes to a new practitioner or law firm filed with a Request, absent the filing of a power of attorney to the new representative. The Office will either change the correspondence address of record to the most current address information provided for the assignee of the entire interest who properly became of record under 37 CFR 3.71 or, if no assignee of the entire interest has properly been made of record under 37 CFR 3.71, the most current address information provided for the first named inventor.

Accordingly, the request to withdraw from record cannot be approved because a proper forwarding address was not provided. The request to change the correspondence address should be that of the: (1) the first named inventor; or (2) an assignee of the entire interest under 37 C.F.R 3.71. If an assignee has intervened in this application then a Statement under 37 CFR 3.73(b), or a copy of the actual assignment must be submitted with a renewed request.

All future communications from the Office will continue to be directed to the above-identified address until otherwise properly notified.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4618.

/Kimberly Inabinet/

Kimberly Inabinet Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI,

L.L.P.

20333 SH 249 6th Floor

**HOUSTON TX 77070** 

MAILED

MAY 24:2011

OFFICE OF PETITIONS

In re Application of

Mark A. George et al.

Application No. 11/378,585

Filed: March 15, 2006

Attorney Docket No. 149-0119US-C

**DECISION ON PETITION** TO WITHDRAW

FROM RECORD

This is a decision on the request to withdraw as attorney of record under 37 CFR § 1.36(b), filed May 16, 2011.

The request is **NOT APPROVED**.

The request cannot be approved because it lacks the name of the first inventor or the assignee of record that is associated with the address listed in the request. Therefore, the change of correspondence address is considered improper.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest who properly became of record under 37 CFR 3.71, or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.

The assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, the statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

All future communications from the Office will continue to be directed to the abovelisted address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-4584.

Retations Examiner
Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI,

L.L.P.

20333 SH 249 6th Floor HOUSTON TX 77070 MAILED

JUN 20 2011

OFFICE OF PETITIONS

In re Application of

Mark A. George et al.

Application No. 11/378,585 Filed: March 15, 2006

Attorney Docket No. 149-0119US-C

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the renewed request to withdraw as attorney of record under 37 CFR § 1.36(b), filed June 15, 2011.

The request is **NOT APPROVED**.

The request cannot be approved because the Office no longer accept address changes to a new practitioner/customer number or law firm filed with a request, absent the filing of a power of attorney to the new representative. Therefore, the change of correspondence address is still considered to be improper.

As stated in the previous decision of May 24, 2011, the Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest who properly became of record under 37 CFR 3.71, or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.

The assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, the statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-4584.

Joanne Burke Petitions Examiner Office of Petitions



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/05/2010

Trellis Intellectual Property Law Group, PC 1900 EMBARCADERO ROAD SUITE 109 PALO ALTO, CA 94303

Applicant: Mukul Jain: DECISION ON REQUEST FORPatent Number: 7660405: RECALCULATION of PATENTIssue Date: 02/09/2010: TERM ADJUSTMENT IN VIEW

Application No: 11/378,602 : OF WYETH AND NOTICE OF INTENT TO Filed : 03/17/2006 : ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 501 days. The USPTO will suas ponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.usplo.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/378,624	03/20/2006	Geoffrey Goldspink	BJS-117-576	6959
23117 7590 12/07/2010 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR			EXAMINER	
			LUKTON, DAVID	
ARLINGTON, VA 22203			ART UNIT	PAPER NUMBER
			1654	
			MAIL DATE	DELIVERY MODE
			. 12/07/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

# DEC 0 7 2010

B. J Sadoff NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON VA 22203

In re Application of

Goldspink

Serial No.: 11/378,624

Filed: 20 March 2006

Attorney Docket No.: BJS-117-576

: PETITION DECISION

This is in response to the petition under 37 CFR 1.144, filed 7 June 2010, requesting reconsideration of the three restriction requirements. While the petition is not reviewable under 37 CFR 1.144, because the restriction requirement has not been made final, the petition has been treated under 37 CFR 1.181, in view of the extended prosecution of the application.

#### **BACKGROUND**

This application is a national application filed under 35 U.S.C. 111(a) and, as such, would be considered for restriction under US practice in chapter 800 of the MPEP.

On 16 October 2007, the examiner restricted claims 1-100 into four groups as follows:

- 1) Claims 1-13, 17-35, 37-44, 70-73, 78-80, 86-90, 92-99, limited to G1.
- 2) Claims 1-9, 14-20, 24-27, 29, 33-44, 74-77, 81-85, 91, limited to G2.
- 3) Claims 35-36, drawn to peptides which comprise 51 or more amino acids.
- 4) Claims 45-69, 100, drawn to methods.

On 7 December 2007, applicants elected group I. This election was <u>without</u> traverse as applicant did not specifically point out errors in the restriction requirement.

On 5 March 2008 and then on 11 December 2008, the examiner set forth a second and then third restriction among the elected subject matter.

Applicants made an election with traverse on 5 September 2008 and then again 11 March 2009. The 11 March 2009 response was treated as a non-compliant amendment on 26 May 2009. On 25 June 2009, applicant elected the subgenus of G1, SEQ ID No 15, where at least one amino acid is in the "D" configuration.

On 8 July 2009, the examiner withdrew claims 5-7, 9-13, 17-28, 30-32, 34-36 and 42-100 as being directed to non-elected inventions. The Office action did not address the traversal or indicate that the restriction was being made final. Claims 1-4, 14 and 37-41 were rejected as follows:

Claims 1-4, 14, 37-41 were rejected under 35 U.S.C. 103 as being unpatentable over Goldspink '842 or Goldspink '946.

Claims 1-3, 37-41 were rejected under 35 U.S.C. 103 as being unpatentable over Goldspink '842 or Goldspink '946 in view of any one of '782, '096, '614 or '127.

Claims 1-3, 37-41 were rejected under 35 U.S.C. 103 as being unpatentable over Goldspink '842 or Goldspink '946 in view of Larsen.

The Office action summary sheet indicated that claims 8, 15, 16, 29 and 33 were objected to, but the remainder of the Office action does not provide reasons for this objection. The Office action is incomplete in that claims 8, 15, 16 and 29 are neither indicated as withdrawn, allowed nor rejected.

On 7 June 2010, Applicants filed this petition.

On 12 August 2010, the examiner withdrew claims 5-7, 9-13, 17-28, 30-32, 34-36 and 42-100 as being directed to non-elected inventions. Claims 4 and 101-102 were rejected under 35 U.S.C. 112, second paragraph. Claims 1-4, 8, 29 and 37-41 were variously rejected under 35 U.S.C. 103 as being unpatentable over Goldspink '842 or Goldspink '946, alone or in view of additional references. On page 8, the examiner indicated that no claim was allowed. On the Office action summary sheet, the examiner indicated that claims 15, 16 and 33 were allowed.

# **DISCUSSION**

The petition and file history have been carefully considered.

MPEP 803 provides the follow criteria for restriction between patentably distinct inventions:

- "There are two criteria for a proper requirement for restriction between patentably distinct inventions:
- (A) The inventions must be independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 § 806.05(j)); and
- (B) There would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808, and § 808.02)."

In the original restriction, dependent claims 35 and 36 were placed in Group III.

- 35. (Withdrawn) An extended polypeptide comprising a polypeptide of claim 1 extended by non-wild-type amino acid sequence N-terminal and/or C-terminal to said polypeptide of claim 1.
- 36. (Withdrawn) An extended polypeptide of claim 35, wherein said extension comprises a Cysteine residue at the C-terminus and/or a D-Arginine residue at the N-terminus.

Because claims 35 and 36 depend from and require all the limitations of the claims of Group I and II, they are considered not patentably distinct from Groups I and II. For this reason, restriction between Groups (I and II) and Group III is unwarranted per MPEP 803.

In the second restriction requirement, as pointed out by applicant, it is noted that the same embodiments are placed into different groups. For example, G1 and G3 both encompass a peptide consisting of or comprising SEQ ID Nos 13-23. Moreover, the embodiments described in terms of functional limitations in G5 overlaps with the embodiments described in terms of structure in G1. Placing the same inventions into different groups is counter to MPEP 803.01.

Moreover, it is noted that the examiner did not provide any reasons for burden, as required by MPEP 808. For these reasons, the second restriction requirement is improper.

The third restriction requirement divided the elected invention again up, this time into ten groups, in an Office action without a statement setting forth a proper rationale for this requirement. For these reasons, the third restriction requirement is improper.

Finally, in the original restriction, the examiner required applicants to elect a "subgenera" of either Group I or Group II, drawn to the "L" and "D" forms of the amino acids, as follows:

A restriction is imposed, as set forth below. First, however, the following subgenera are defined:

- G1: this subgenus is limited to peptides that consist of, or comprise any of SEQ ID numbers 13-24, 27-36 (it is assumed at the present time that each of the sequences in the sequence listing is limited to "all-L" amino acids);
- G2: This subgenus encompasses any peptide that falls within the scope of claim 1, with the proviso that G1 is excluded.

The second and third restriction also required divisions between various sequences and between "L" and "D" forms of the amino acids. The petition on page 3 provides an alignment of the various sequences to show overlap. Page 8 of the petition demonstrates overlap between the sequences as they are grouped in the various restrictions. These showings are found to be persuasive. MPEP 808.01(a) indicates that

"Election of species should not be required between claimed species that are considered clearly unpatentable (obvious) over each other. In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other." (Emphasis in the original).

In the Office actions on the merits, the examiner made a rejection that has in essence taken Official Notice by specific to the obviousness of the L- to D- substitutions.

The obviousness rationale applied to the elected invention is inconsistent with the determination in the restriction requirement that the various G1-G10 groups are patentably distinct and inconsistent with MPEP 808.02.

#### DECISION

For these reasons, the petition is **GRANTED**.

The original restriction between Group I, drawn to G1 and Group II, drawn to G2 has been withdrawn.

The original restriction between Groups (I and II) and Group III, drawn to claims 35-36 has been withdrawn.

The second and third restriction requirements have been withdrawn.

The Notice of Non-compliant Amendment mailed 26 May 2009 has been withdrawn.

Product claims 1-44, 70-99 and 101-102 are under examination. The restriction required between product and processes is deemed proper and was not traversed. These claims are subject to rejoinder pending allowability of the product claim(s).

The Office action mailed 12 August 2010 has been withdrawn as incomplete for not addressing improperly withdrawn claims on the merits.

The application will be forwarded to the examiner for preparation of an Office action consistent with this decision. The Office action will be reviewed per MPEP 707.02. Should all the claims to the product become allowable, the examiner will consider the withdraw process claims for rejoinder per MPEP 821.04(a).

Should there be any questions about this decision, please contact Quality Assurance Specialist Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-0512 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Jackie Stone

Director, Technology Center 1600



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

# QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO CA 92121

MAILED

MAY 262011

In re Application of

OFFICE OF PETITIONS

Shuxue Quan et al Application No. 11/378,720

: DECISION GRANTING PETITION

El-1-M---1-17 2006

UNDER 37 CFR 1.313(c)(2)

Filed: March 17, 2006

Attorney Docket No. 050925

This is a decision on the petition under 37 CFR 1.313(c)(2), filed May 24, 2011, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on May 13, 2011 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 2624 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

/Karen Creasy/ Karen Creasy Petitions Examiner Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.usnto.gov

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FEB 23 2012
OFFICE OF PETITIONS

JUAN CARLOS A. MARQUEZ C/O STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA VA 22314-1437

In re Patent No. 7, 402,839

Issued: July 22, 2008

Application No. 11/378,794

Filed: March 16, 2006

Attorney Docket No.: CHIP.O030

ON PETITION

This is a decision regarding your request for acceptance of a fee deficiency submission and loss of small entity status filed February 2, 2012, which is being treated under 37 CFR 1.28.

On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. <u>See DH Technology v. Synergystex International</u>, <u>Inc.</u>. 154 F.33d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission in the amount of \$565.00 under 37 CFR 1.28 has been applied and is hereby accepted. The petition is therefore **GRANTED**.

Inquiries related to this communication should be directed to the Office of Petitions Staff

at (571) 272-3282.

Patricia Faison-Ball Senior Petitions Attorney

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

ZILKA-KOTAB, PC P.O. BOX 721120 SAN JOSE CA 95172-1120

MAILED

MAR 282011
OFFICE OF PETITIONS

In re Application of

CHENG, William et al.

Application No. 11/378,857

Filed: March 16, 2006 Attorney Docket No. NAI1P170H/96.007.14 **DECISION ON PETITION** 

TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 24, 2011.

The request is **NOT APPROVED**.

The Office will no longer accept address changes to a new practitioner or law firm filed with a Request, absent the filing of a power of attorney to the new representative. The Office will either change the correspondence address of record to the most current address information provided for the assignee of the entire interest who properly became of record under 37 C.F.R 3.71 or, if no assignee of the entire interest has properly been made of record under 37 CFR 3.71, the most current address information provided for the first named inventor.

Accordingly, the request to withdraw from record cannot be approved because the change of address is not that of: (1) the first named inventor; or (2) an assignee of the entire interest under C.F.R 3.71, who has properly intervened.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4231.

Michelle R. Eason Paralegal Specialist Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

CANTOR COLBURN LLP 20 CHURCH STREET 22ND FLOOR HARTFORD CT 06103

MAILED

JAN 24 2011

In re Application of

Chung

Application No. 11/378,861

Filed/Deposited: 4 September, 2001

Attorney Docket No. 00-1009

OFFICE OF PETITIONS

**DECISION** 

This is a decision on the petition filed 18 August, 2010, for revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b).

The pursuant to 37 C.F.R. §1.137(b) is **DISMISSED**.

Any request for reconsideration of this decision or any petition in the alternative is to be filed within two (2) months from the mail date of this decision. *Note* 37 C.F.R. §1.181(f). The request for reconsideration should include a cover letter and be entitled as a "Renewed Petition under 37 C.F.R. §1.181 to Withdraw the Holding of Abandonment," and/or "Renewed Petition under 37 C.F.R. §1.137(b)."

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

As to the Allegations of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

Petitioner does not appear to have addressed satisfactorily the statement/showing requirements under the rule. These deficiencies must be overcome.

# Application No. 11/378,861

# **BACKGROUND**

The record reflects as follows:

The record reflects that Counsel failed to Notice the Office of Counsel's change of address that appears to have taken place on or before 13 March, 2008.

Thereafter, Counsel failed to reply timely and properly to the final Office action:

- mailed on 23 January, 2009, with reply due absent extension of time on or before 23 April, 2009, but was returned undeliverable on 6 February, 2009; and .
- again mailed on 8 May, 2009, with reply due absent extension of time on or before 8 August, 2009, but was returned undeliverable on 26 May, 2009.

The application went abandoned by operation of law after midnight 8 August, 2009.

Counsel finally filed a Notice of Charge of Address on 10 November, 2009.

The Office mailed the Notice of Abandonment on 30 June, 2010.

On 18 August, 2010—more than a year after abandonment and nearly two months after Notice thereof—Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.137(b), with fee and a reply in the form of a request for continued examination (RCE), with fee, and a submission under the provisions of 37 C.F.R. §1.114 in the form of an amendment, and made the statement of unintentional delay. However, in light of Counsel/Petitioner's failure to address the Notice of Change of Address to the Office timely—i.e., prior to 13 March, 2008—Petitioner seems not to have satisfied the statement/showing requirements under the rule.

Petitioner must overcome these deficiencies.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

# STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994). And the regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.<sup>2</sup>,<sup>3</sup>

Moreover, the Office has set forth in the Commentary at MPEP §711.03(c)(I) the showing and timeliness requirements for a proper showing for relief under 37 C.F.R. §1.181 in these matters.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.<sup>4</sup>

<sup>&</sup>lt;sup>2</sup> See: Changes to Patent Practice and Procedure, Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an <u>unavoidable</u> delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under <u>Pratt</u>, and so cannot satisfy the test for diligence and due care. (By contrast, <u>unintentional</u> delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, <u>and</u> also, by definition, are not intentional.))

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Application No. 11/378,861

# As to Allegations of Unintentional Delay

As indicated above, the requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a proper reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

As discussed above, it does not appear that Petitioner has satisfied the statement/showing requirements under the rule.

Petitioners' attentions always are directed to the guidance in the Commentary at MPEP §711.03(c)(II) as to a petition pursuant to 37 C.F.R. §1.137.

# CONCLUSION

Accordingly, the petition pursuant to 37 C.F.R. §1.137(b) is dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

Mail Stop PETITION

Commissioner for Patents

P. O. Box 1450

Alexandria, VA<sup>1</sup> 22313-1450

By hand:

U. S. Patent and Trademark Office

Customer Service Window, Mail Stop Petitions

Randolph Building 401 Dulany Street Alexandria, VA 22314

By facsimile:

(571) 273-8300

Attn: Office of Petitions

# Application No. 11/378,861

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2<sup>5</sup>) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./ John J. Gillon, Jr. Senior Attorney Office of Petitions

<sup>&</sup>lt;sup>5</sup> The regulations at 37 C.F.R. §1.2 provide:

<sup>§1.2</sup> Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

CANTOR COLBURN LLP 20 CHURCH STREET 22ND FLOOR HARTFORD CT 06103

MAILED
MAY 1 0 2011
OFFICE OF PETITIONS

In re Application of

Chung

Application No. 11/378,861

Filed/Deposited: 4 September, 2001

Attorney Docket No. 00-1009

**DECISION** 

This is a decision on the petition filed 31 January, 2011, pursuant to 37 C.F.R. §1.137(a) for revival of an application abandoned due to unavoidable delay; alternatively, pursuant to 37 C.F.R. §1.137(b) for revival of an application abandoned due to unintentional delay.

# **NOTE:**

Petitioner seems not to appreciate that the showing burden pursuant to 37 C.F.R. §1.137(a) (i.e., to evidence the unavoidable nature of delay) is substantially greater than that pursuant to 37 C.F.R. §1.137(b) (i.e., to evidence the unintentional nature of delay).

As a result, Petitioner appears to suggest that the fall-back position from the failure to explain on the original petition averring unintentional delay the reasons for the extended delay was then to aver unavoidable delay.

Petitioner will find that a review of the guidance in the Commentary at MPEP §711.03(c)(II) will inform her efforts.

The petition pursuant to 37 C.F.R. §1.137(a) is **DISMISSED**; the petition pursuant to 37 C.F.R. §1.137(b) is **GRANTED**.

Application No. 11/378,861

# As to Allegation of Unavoidable Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(a) are the petition and fee therefor, a reply, a proper showing of unavoidable delay under the regulation, and, where applicable, a terminal disclaimer and fee.

Petitioner does not appear to have satisfied the showing requirements (as to unavoidable delay) under the Rule.

Petitioners' attentions always are directed to the guidance in the Commentary at MPEP  $\S711.03(c)$  as to the showing regarding unavoidable delay and a petition pursuant to 37 C.F.R.  $\S1.137(a)$ .

# As to the Allegations of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

## BACKGROUND

The record reflects as follows:

The record reflects that Counsel failed to Notice the Office of Counsel's change of address that appears to have taken place on or before 13 March, 2008.

Thereafter, Counsel failed to reply timely and properly to the final Office action mailed on 23 January, 2009, with reply due absent extension of time on or before 23 April, 2009, but was returned undeliverable on 6 February, 2009; and mailed again on 8 May, 2009, with reply due absent extension of time on or before 8 August, 2009 (but returned undeliverable on 26 May, 2009).

The application went abandoned by operation of law after midnight 8 August, 2009.

Counsel finally filed a Notice of Change of Address on 10 November, 2009.

The Office mailed the Notice of Abandonment on 30 June, 2010.

On 18 August, 2010—more than a year after abandonment and nearly two months after Notice thereof—Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.137(b), with fee and a reply in the form of a request for continued examination (RCE), with fee, and a submission under the provisions of 37 C.F.R. §1.114 in the form of an amendment,

and made the statement of unintentional delay. However, in light of Counsel/Petitioner's failure to address the Notice of Change of Address to the Office timely—i.e., prior to 13 March, 2008—Petitioner seems not to have satisfied the statement/showing requirements under the rule. The petition was dismissed on 24 January, 2011.

On 31 January, 2011, Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.137(a) (averring unavoidable delay) with fee (authorization (charged, as authorized, to Deposit Account 06-1130) and pointed to the a reply filed on 18 August, 2010, in the form of a request for continued examination (RCE), with fee, and a submission under the provisions of 37 C.F.R. §1.114 in the form of an amendment, but failed to evidence unavoidable delay—i.e., the error herein is stated to be a "clerical error"—and Petitioner re-advanced her petition pursuant to 37 C.F.R. §1.137(b), with fee and reply, and made a showing of unintentional delay.

The record (including the petitions filed on 18 Auygust, 2010, an 31 January, 2011) does not necessitate a finding that the delay between midnight 8 August, 2009 (the date of abandonment), and 31 January, 2011 (the date of the filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on the duty of candor and good faith of Petitioner/Counsel Amy bison-Copp (Reg. No. 53,993) when accepting Petitioners' representation that the delay in filing the response was unintentional.<sup>1</sup>

Petitioners' attentions always are directed to the guidance in the Commentary at MPEP  $\S711.03(c)$  as to the showing regarding unavoidable delay and a petition pursuant to 37 C.F.R.  $\S1.137(a)$ .

The guidance in the Commentary at MPEP §711.03(c)(II) as to the showing required pursuant to 37 C.F.R. §1.137(a) provides in pertinent part:

# ... Unavoidable Delay

As discussed above, "unavoidable" delay is the epitome of "unintentional" delay. Thus, an intentional delay precludes revival under 37 C.F.R..§137(a) ("unavoidable" delay) or 37 C.F.R. §1.137(b) ("unintentional" delay). See Maldague, 10 USPQ2d at 1478.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

<sup>1</sup> See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. '10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. '1.137(b) to the Patent and Trademark Office).

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(A)the error was the cause of the delay at issue;

(B)there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C)the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See In re Egbers, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), rev'd on other grounds sub nom., Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988). For example, where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of "unavoidable" delay will require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address (see MPEP § 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and

in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. The following do not constitute proper notification of a change in correspondence address:

(A)the mere inclusion, in a paper filed in an application for another purpose, of an address differing from the previously provided correspondence address, without mention of the fact that an address change was being made;

(B)the notification on a paper listing plural applications as being affected (except as provided for under the Customer Number practice - see MPEP § 403); or

(C)the lack of notification, or belated notification, to the U.S. Patent and Trademark Office of the change in correspondence address.

Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay. See Haines, 673 F. Supp. at 317, 5 USPQ2d at 1132; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). For example, as 37 C.F.R. 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not "unavoidable" when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action.

Likewise, as a "reasonably prudent person" would file papers or fees in compliance with 37 C.F.R. §1.8 or §1.10 to ensure their timely filing in the USPTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant's failure to file papers or fees in compliance with 37 C.F.R. §1.8 and §1.10 does not constitute "unavoidable" delay. See *Krahn*, 15 USPQ2d at 1825. Finally, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985).

35 U.S.C. §133 and §151 each require a showing that the "delay" was "unavoidable," which requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable, but also a showing of unavoidable delay until the filing of a petition to revive. See *In re Application of Takao*, 17 USPQ2d 1155 (Comm'r Pat. 1990).

The burden of continuing the process of presenting a grantable petition in a timely manner likewise remains with the applicant until the applicant is informed that the petition is granted. *Id.* at 1158. Thus, an applicant seeking to revive an "unavoidably" abandoned application must cause a petition under 37 C.F.R.  $\S1.137(a)$  to be filed without delay (i.e., promptly upon becoming notified, or otherwise becoming aware, of the abandonment of the application).

An applicant who fails to file a petition under 37 C.F.R. §1.137(a) "promptly" upon

becoming notified, or otherwise becoming aware, of the abandonment of the application will not be able to show that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(a) was unavoidable. The removal of the language in 37 C.F.R. §1.137(a) requiring that any petition thereunder be "promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment" should **not** be viewed as: (A) permitting an applicant, upon becoming notified, or otherwise becoming aware, of the abandonment of the application, to delay the filing of a petition under 37 C.F.R. §1.137(a); or (B) changing (or modifying) the result in In re Application of S, 8 USPQ2d 1630 (Comm'r Pat. 1988), in which a petition under 37 C.F.R. §1.137(a) was denied due to the applicant's deliberate deferral in filing a petition under 37 C.F.R. § 1.137. An applicant who deliberately chooses to delay the filing of a petition under 37 C.F.R. §1.137 (as in Application of S, 8 USPQ2d at 1632) will not be able to show that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to [37 C.F.R. §1.137(a)] was unavoidable" or even make an appropriate statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to [37 C.F.R. §1.137(b)] was unintentional."

The dismissal or denial of a petition under 37 C.F.R. §1.137(a) does not preclude an applicant from obtaining relief pursuant to 37 C.F.R. 1. §137(b) on the basis of unintentional delay (unless the decision dismissing or denying the petition under 37 C.F.R. 1.137(a) indicates otherwise). In such an instance, a petition under 37 C.F.R. 1.137(b) may be filed accompanied by the fee set forth in 37 C.F.R. §1.17(m), the required reply, a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional, and any terminal disclaimer required by 37 C.F.R. §1.137(c).

Form PTO/SB/61 or PTO/SB/61PCT may be used to file a petition for revival of an unavoidably abandoned application.

\*\*\*

Petitioner has failed to satisfy the requirements pursuant to 37 C.F.R. §1.137(a) as discussed above.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice <u>and</u> all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.<sup>2</sup>

## STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.<sup>3</sup>

A Petitioner's attentions always are directed to the guidance in the Commentary at MPEP §711.03(c).

<sup>&</sup>lt;sup>2</sup> See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

<sup>&</sup>lt;sup>3</sup> In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Application No. 11/378,861

## As to Allegations of Unavoidable Delay

The requirements under 37 C.F.R. §1.137(a) are the petition and fee therefor, a reply, a proper showing of unavoidable delay under the regulation, and, where applicable, a terminal disclaimer and fee.

It appears that Petitioner has failed to satisfy the requirements under the Rule.

# As to Allegations of Unintentional Delay

As indicated above, the requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a proper reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

It appears that Petitioner has satisfied the statement/showing requirements under the Rule.

## CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.137(a) is <u>dismissed</u>; the petition pursuant to 37 C.F.R. §1.137(b) is <u>granted</u>.

The instant application is released to the Technology Center/AU 2812 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

## Application No. 11/378,861

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2<sup>4</sup>) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./ John J. Gillon, Jr. Senior Attorney Office of Petitions

The regulations at 37 C.F.R. §1.2 provide: §1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attdance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.



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AMPACC Law Group, PLLC 6100 219th Street SW, Suite 580 Mountlake Terrace, WA 98043

**MAILED** 

OCT 03 2011

OFFICE OF PETITIONS

In re Application of

Sang Mook Kim, et. al. Application No. 11/378,909

Filed: March 17, 2006

Attorney Docket No. 159WI-000200US

**ON PETITION** 

This is a decision on the petition under 37 CFR 1.137(b), filed September 25, 2011 and supplemented on September 28, 2011, to revive the above-identified application.

The application became abandoned for failure to file a proper reply to the final Office action mailed on March 9, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) along with the \$405 fee; (2) the petition fee of \$810; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to Technology Center Art Unit 1745 for processing of the RCE filed on September 28, 2011.

elephone inquiries concerning this decision should be directed to the undersigned at

(571) 272-3226.

And ea Amith

Petitions Examiner Office of Petitions



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BOZICEVIC, FIELD & FRANCIS LLP 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303 MAILED

AUG 26 2011

OFFICE OF PETITIONS

In re Application of

McGrath :

Application No. 11/378,987 Filed: March 17, 2006

Attorney Docket No. UCSF-313DIV

DECISION ON APPLICATION

FOR PATENT TERM ADJUSTMENT

This is a decision on the request filed July 7, 2011, which is being treated as a petition under 37 C.F.R. § 1.705(b) requesting the initial determination of patent term adjustment be corrected from seven hundred twelve (712) days to eight hundred nineteen (819) days.

The petition is granted.

The Office has updated the Office's PALM records to reflect the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is 819 days. A copy of an updated PALM screen showing the correct determination is enclosed.

The Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) on June 23, 2011, advising Applicant of a patent term adjustment to date of 712 days. The instant petition was subsequently filed with the issue fee on July 7, 2011.

The petition asserts the Office's entry of a 107-day reduction in patent term adjustment, as the result of the submission of an information disclosure statement ("IDS") on June 1, 2011, was improper.

Although the IDS was submitted after Applicant filed a reply to a non-final Office action, a letter submitted with the IDS included a statement under 37 C.F.R. § 1.704(d). Therefore, the entry of a 107-day reduction in patent term adjustment was unwarranted.

The correct patent term adjustment at the time of mailing of the notice of allowance is 819 days.

Submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged. No additional fee is required.

Applicant is reminded any delays by the Office pursuant to 37 C.F.R. §§ 1.702(a)(4) and 1.702(b) and any delays under 37 C.F.R. § 1.704(c)(10) will be calculated at the time of the issuance of the patent and Applicant will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley Senior Petitions Attorney

Office of Petitions

Enclosure: Copy of REVISED PALM screen



# . Patent

## Adjustments

PTA/PTE Information Patent Term Adjustment Patent Term Extension

Application Number\*: 11378987 Search Explanation of PTA Calculation Explanation of PTE Calculation PTA Calculations for Application: 11378987 Θ

;	Application Filing Date	03/17/2006	OverLapping Days Between (A and B) or (A and C) 0
!	Issue Date of Patent		Non-Overlapping USPTO Delays: 875
	A Delays	875	PTO Manual Adjustment 107
1	B Delays	0	Applicant Delay (APPL) 163
1	C Delays	0	Total PTA (days) 819

#### \* - Sorted Column

File Contents History	<b>v</b>	回

	<u>nber ∭.≊Date</u> <u>Date</u>	Code Description PTO APPL Action Num
2.5	08/08/2011	P028 Adjustment of PTA Calculation by PTO
58	06/23/2011 06/14/2011	
57	06/21/2011	OAR Office Action Review
56	06/21/2011	OAR Office Action Review 0
	06/21/2011	IREV Issue Revision Completed 0
54	06/21/2011	DVER Document Verification 0
		N/=Notice of Allowance Data Verification Completed
52	06/16/2011	EX.A Examiner's Amendment Communication 0
51	06/16/2011	CNTA Allowability Notice 0
44	06/01/2011	IDSC Information Disclosure Statement considered 0
43	06/01/2011 02/14/2011	EIDS. Electronic Information Disclosure Statement 107 35.
42	06/01/2011	WIDS Information Disclosure Statement (IDS) Filed 0
45 🔻	05/19/2011	IDSC Information Disclosure Statement considered 0
41	05/19/2011	EIDS. Electronic Information Disclosure Statement 0
10	05/19/2011	WIDS Information Disclosure Statement (IDS) Filed
16	02/22/2011	IDSC Information Disclosure Statement considered 0
39 -	02/22/2011	EIDS. Electronic Information Disclosure Statement 0'
38	02/22/2011	WIDS Information Disclosure Statement (IDS) Filed 0
36	02/16/2011	FWDX Date Forwarded to Examiner
37	02/14/2011	C602 Oath or Declaration Filed (Including Supplemental) 0
35	02/14/2011 01/13/2011	
34	02/14/2011	XT/G Request for Extension of Time - Granted 0
33	10/13/2010	MCTNF Mall Non-Final Rejection
32	10/12/2010	CTNF Non-Final Rejection 0
31	07/07/2010	FWDX Date Forwarded to Examiner 0
30	06/25/2010 06/01/2010	
29	06/25/2010	XT/G Request for Extension of Time - Granted 0
28	03/01/2010	MCTNF Mail Non-Final Rejection 0
44	02/26/2010	
23	12/17/2009	FWDX Date Forwarded to Examiner 0
22	11/23/2009	ELC. Response to Election / Restriction Filed
21	11/23/2009	XT/G Request for Extension of Time - Granted 0
	09/29/2009 05/17/2007	
18	09/26/2009	MCTRS Mall Restriction Requirement 866 0.5 CTRS Restriction / Election Requirement 0
	04/02/2009	
20	04/02/2009	
17	04/02/2009	
		WIDS Information Disclosure Statement (IDS) Filed 0
15 14 :	08/17/2006	TSSCOMP IFW TSS Processing by Tech Center Complete
14 : 25	08/17/2006	DOCK Case Docketed to Examiner in GAU
2	08/07/2006	IDSC Information Disclosure Statement considered 0
	08/07/2006	RCAP Reference capture on IDS
1.7	08/07/2006	M844 Information Disclosure Statement (IDS) Filed 0
	08/07/2006	The state of the s
	04/13/2006	COMP Application Is Now Complete 0
	04/12/2006	WROIPE Application Return from OIPE
3	04/12/2006	ROIPE Application Return TO OIPE 0
	04/12/2006	OIPE Application Dispatched from OIPE 0
5	04/12/2006	COMP Application Is Now Complete 0
5	04/09/2006	L128 Cleared by L&R (LARS)
•	04/04/2006	L198 Referred to Level 2 (LARS) by OIPE CSR 0
3	04/04/2006	CLSS CASE CLASSIFIED BY OIPE
2	03/29/2006	SCAN IFW Scan & PACR Auto Security Review 0
13	03/17/2006	A.PE Preliminary Amendment 0 0 0 0 0 0 0 0 0 0 0 0 0 0 0 0 0 0 0
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COOLEY LLP ATTN: PATENT GROUP SUITE 1100 777 – 6<sup>TH</sup> STREET, NW WASHINGTON, DC 20001

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JAN 212011

OFFICE OF PETITIONS

In re Application of

Kevin Stewart Dick et al

Application No. 11/379,045

Filed: April 17, 2006

Attorney Docket No. NETW-002/01US 314154-

2004

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) or 37 C.F.R. § 10.40 filed December 8, 2010.

The request is **APPROVED**.

A review of the file record indicates that Todd M. Schneider: (1) does not have power of attorney in this patent application; and (2) has been employed or otherwise engaged in the proceedings in this patent application. In view of the present decision, Todd M. Schneider has been withdrawn from the present application and may not prepare or submit papers under 37 C.F.R. § 1.34, or correspond in any manner in this application unless appointed in an acceptable power of attorney under 37 C.F.R. § 1.32(b).

Telephone inquires concerning this decision should be directed to Irvin Dingle at 571-272-3210.

Trvin Dingle
Petitions Examiner
Office of Petitions

cc: Todd M. Schneider

P.O. Box 919092 San Diego, CA 92191-9092

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OFFICE OF PETITIONS

In re Application of
An, et al.

Application No. 11/379,047 : ON PETITION

Filed: April 17, 2006

Attorney Docket No. 12200-04USA

This is a decision on the petition to revive under 37 CFR 1.137(b), filed September 24, 2011.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The above application became abandoned for failure to timely file a reply in response to the non-final Office action, mailed September 11, 2009. This Office action set a shortened statutory period for reply of three months. No reply having been received, the application became abandoned on December 12, 2009.

With the instant petition, applicants made the proper statement of unintentional delay, paid the petition fee, and filed an Amendment.

The application is being forwarded to Group Art Unit 1637 for consideration of the Amendment, filed September 24, 2011.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo Petitions Attorney Office of Petitions



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WESTINGHOUSE ELECTRIC COMPANY, LLC 1000 Westinghouse Drive Suite 141 Cranberry Township PA 16066

**MAILED** 

NOV 212011

In re Application of

Ales, et al.

Application No. 11/379,082

Filed: April 18, 2006

Atty. Dkt. No.: ARF2006-004

OFFICE OF PETITIONS

**DECISION ON PETITION** 

This decision is in response to the renewed petition to revive under 37 CFR 1.137(a), filed July 29, 2010.

The application became abandoned December 23, 2009 for failure to timely submit a proper reply to the final Office action mailed September 22, 2009. The final Office action set a three month shortened statutory period of time for reply. Notice of Abandonment was mailed April 27, 2010.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The petition satisfies the requirements of 37 CFR 1.137(a) in that petitioner has supplied (1) the required reply (Notice of Appeal filed May 25, 2010 and Appeal Brief filed July 19, 2010) to the final Office action mailed September 22, 2009; (2) the required petition fee; and (3) a showing to the satisfaction of the Director that the entire delay was unavoidable.

This application is being referred to Group Art Unit 3663 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown Attorney Advisor Office of Petitions





Commissioner for Patents
United States Patent and Trademark Office
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SCHLUMBERGER OILFIELD SERVICES 200 GILLINGHAM LANE MD 200-9 SUGAR LAND TX 77478

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AUG 23 2011

**OFFICE OF PETITIONS** 

In re Application of Pabon, et al.

Application No. 11/379,134

Filed: 18 April, 2006

Attorney Docket No. 24.0938

**DECISION** 

This is a decision on the petition filed on 2 August, 2011, for revival of an application abandoned due to unintentional delay pursuant to 37 C.F.R. §1.137(b).

## NOTE:

For reasons not revealed in the record, Petitioner appears to have inappropriately submitted a request and fee for extension of time after expiration of the statutory period.

The fee was refunded via deposit account.

Should Petitioner later find that the fee was not refunded, Petitioner should request a refund from the Office of Finance and submit therewith a copy of this decision.

The petition pursuant to 37 C.F.R. §1.137(b) is **GRANTED**.

# As to the Allegations of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee

Petitioners' attentions always are directed to the guidance in the Commentary at MPEP  $\S711.03(c)(II)$ .

### **BACKGROUND**

Petitioner failed to reply timely and properly to the final Office action mailed on 14 January, 2011, with reply due absent extension of time on or before 14 April, 2011.

The application went abandoned after midnight 14 April, 2011.

The Office mailed the Notice of Abandonment on 21 July, 2011.

On 2 August, 2011, Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.137(b), with fee, a reply in the form of a request for continued examination and fee and a submission pursuant to 37 C.F.R. §1.114 in the form of an amendment, and made the statement of unintentional delay.

Petitioners' attentions always are directed to the guidance in the Commentary at MPEP  $\S711.03(c)$  as to the showing regarding unintentional delay and a petition pursuant to 37 C.F.R.  $\S1.137(b)$ .

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.<sup>1</sup>

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup> The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

<sup>&</sup>lt;sup>1</sup> See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

<sup>&</sup>lt;sup>2</sup> 35 U.S.C. §133 provides:

<sup>35</sup> U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

Application No. 11/379,134

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and, by definition, are not intentional.<sup>3</sup>))

As to Allegations of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

It appears that the requirements under the rule have been satisfied.

## **CONCLUSION**

Accordingly, the petition pursuant to 37 C.F.R. §1.137(b) is granted.

The instant application is released to the Technology Center/AU 2832 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2<sup>4</sup>) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

John J. Gillon, Jr./ John J. Gillon, Jr. Senior Attorney Office of Petitions

Therefore, by example, an <u>unintentional</u> delay in the reply might occur if the reply and transmittal form are <u>to be</u> prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

The regulations at 37 C.F.R. §1.2 provide:

<sup>§1.2</sup> Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attdance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.



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POLSINELLI SHUGHART PC 700 West 47th Street Suite 1000 KANSAS CITY MO 64112 MAILED
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OFFICE OF PETITIONS

In re Application of :

Matthew T. Jarman :

Application No. 11/379,180 : ON PETITION

Filed: April 18, 2006 :

Attorney Docket No. 9392 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 17, 2010, to revive the above-identified application.

## The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed October 16, 2009, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on December 17, 2009. See MPEP 1215.04.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a continuing application under 37 CFR 1.53(b); (2) the petition fee of \$810; and (3) a proper statement of unintentional delay.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the \$555 extension of time fee submitted with the petition on September 17, 2010 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

This application is being revived solely for purposes of continuity. As continuity has been established by this decision, the application is again abandoned in favor of continuing application No. 12/761,293.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries concerning this decision should be directed to Terri Johnson at (571) 272-2991.

/Terri Johnson/ Terri Johnson Petitions Examiner Office of Petitions

cc: Gregory P. Durbin
POLSINELLI SHUGHART PC
1515 Wynkoop, Suite 600
Denver, CO 80202



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

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OCT 0 4 2010

OPPICE OF PETITIONS

In re Application of

Byron J. KNIGHT, et al

Application No. 11/379,205

Filed: April 18, 2006

Attorney Docket No. GP181-02 UT

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 20, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, September 29, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on December 30, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a request for reconsideration/arguments (2) the petition fee of \$1620; and (3) the required statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6735.

This application is being referred to Technology Center AU 1797 for appropriate action by the Examiner in the normal course of business.

/dcg/ Diane C. Goodwyn Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

Currie Kendall PLC 6024 Eastman Ave Midland MI 48640-2518

MAILED

AUG 1 3 2010

In re Application of

**OFFICE OF PETITIONS** 

James R. Heim, Sr. et al. Application No. 11/379,215

**DECISION ON PETITION** 

Filed: April 18, 2006

TO WITHDRAW FROM RECORD

Attorney Docket No. 2098-001

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) or 37 C.F.R. § 10.40 filed June 25, 2010.

The request is **NOT APPROVED**.

A review of the file record indicates that Stanley K. Hill, no longer has power of attorney in this patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

All future communications from the Office will continue to be directed to the above-listed address until otherwise properly notified by the applicant.

Telephone inquires concerning this decision should be directed to Kimberly Inabinet at 571-272-4618.

/Kimberly Inabinet/

Kimberly Inabinet Petitions Examiner Office of Petitions

cc:

Stanley Hill

5950 Grand Pavilion Way, #311

Alexandria, VA 22303



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

#### CHOATE, HALL & STEWART LLP TWO INTERNATIONAL PLACE BOSTON MA 02110

**MAILED** 

In re Application of

APR 1 1 2011

Jason Redi et al.

OFFICE OF PETITIONS

Application No. 11/379,294

DECISION ON PETITION

Filed: April 19, 2006

TO WITHDRAW FROM RECORD

Attorney Docket No. 2006491-0003/BBN 05-5032

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 2, 2011.

## The request is **NOT APPROVED.**

The Office will no longer accept address changes to a new practitioner or law firm filed with a Request, absent the filing of a power of attorney to the new representative. The Office will either change the correspondence address of record to the most current address information provided for the assignee of the entire interest who properly became of record under 37 CFR 3.71 or, if no assignee of the entire interest has properly been made of record under 37 CFR 3.71, the most current address information provided for the first named inventor.

:

Accordingly, the request to withdraw from record cannot be approved because no proper forwarding address was provided. The request to change the correspondence address should be that of the: (1) the first named inventor; or (2) an assignee of the entire interest under 37 C.F.R 3.71. If an assignee has intervened in this application then a Statement under 37 CFR 3.73(b), or a copy of the actual assignment must be submitted with a renewed request. The most current address of the inventor/assignee is needed.

All future communications from the Office will continue to be directed to the above-identified address until otherwise properly notified.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4618.

/Kimberly Inabinet/

Kimberly Inabinet Petitions Examiner Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
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THE GRAFE LAW OFFICE, P.C. P.O. BOX 2689 CORRALES NM 87048

MAILED DEC 08 2011

OFFICE OF PETITIONS

In re Application of

Dave et al.

Application No. 11/379,378

Filed: April 19, 2006

Attorney Docket No: BB-CP

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 29, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, August 19, 2010, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on November 22, 2010. A Notice of Abandonment was mailed March 23, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Amendment, (2) the petition fee of \$930.00, and (3) a proper statement of unintentional delay.

Further, it is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

This application is being referred to Technology Center AU 3641 for further appropriate action by the Examiner in the normal course of business on the reply received.

/Joan Olszewski/ Joan Olszewski Petitions Examiner Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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MAILED SEP 1 3 2011

JOHN S. PRATT, ESQ KILPATRICK TOWNSEND & STOCKTON LLP 1100 PEACHTREE STREET SUITE 2800 ATLANTA GA 30309

OFFICE OF PETITIONS

In re Application of

Castonguay, et al.

Application No. 11/379,462 : DECISION ON PETITION Filed: April 20, 2006 : UNDER 37 CFR 1.78(a)(6)

Attorney Docket No. 61682-384425

This is a decision on the petition under 37 CFR § 1.78(a)(6), filed June 13, 2011, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for benefit of priority to the prior-filed provisional applications set forth in the concurrently filed amendment.

## The petition is **DISMISSED AS MOOT**.

The petition is accompanied by an amendment to the first sentence of the specification following the title to include a reference to the prior-filed provisional applications. While a reference to the prior-filed provisional applications was not included in an Application Data Sheet (ADS) or in the first sentence of the specification following the title as required by the rules, a reference, nevertheless, was made in the declaration filed transmittal letter filed with the application.

Where a claim for priority under 37 CFR § 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR § 1.78(a)(5)(ii). On the other hand, if the USPTO does not note the claim for priority to the prior-filed applications set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR § 1.78(a)(6). In the present case, the Office noted the claim for priority to the prior-filed provisional applications in the transmittal letter filed with the application, as shown by their inclusion on the filing receipt.

Note MPEP 201.11 (III)(D) and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

In view of the above, the \$1,410.00 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

Any questions concerning this decision on petition may be directed to the undersigned at (571) 272-3205. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

The application is being forwarded to Technology Center AU 1743 for consideration by the examiner of the claim under 35 U.S.C. §119(e) for the benefit of priority to the prior-filed provisional application.

/ALESIA M. BROWN/

Alesia M. Brown Attorney Advisor Office of Petitions



## United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Viginius 22313-1450 www.uspto.gov

APPLICATION	FILING or	GRP ART		· · · · · · · · · · · · · · · · · · ·		
NUMBER	371(c) DATE	UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
11/379,462	04/20/2006	1743	1130	61682-384425	14	1

23370
JOHN S. PRATT, ESQ
KILPATRICK TOWNSEND & STOCKTON LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

CONFIRMATION NO. 9885
CORRECTED FILING RECEIPT



Date Mailed: 09/06/2011

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

#### Applicant(s)

Bertin Castonguay, Magog, CANADA; Marcel Thomassen, L'Epiphanie, CANADA; Robert Daoust, Boucherville, CANADA; Marc-Andre Lacas, Laval, CANADA;

Power of Attorney: The patent practitioners associated with Customer Number 23370

### Domestic Priority data as claimed by applicant

This appln claims benefit of 60/673,344 04/21/2005

Foreign Applications (You may be eligible to benefit from the Patent Prosecution Highway program at the USPTO. Please see <a href="http://www.uspto.gov">http://www.uspto.gov</a> for more information.)

If Required, Foreign Filing License Granted: 05/02/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/379,462** 

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

#### Title

MOLDING APPARATUS FOR PRODUCING DRY CAST PRODUCTS HAVING TEXTURED SIDE SURFACES

#### **Preliminary Class**

264

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

### LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

#### **GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where

the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

#### **NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Nyemaster, Goode, West, Hansell & O''Brien, P.C. 625 First Street SE Suite 400 Cedar Rapids IA 52401 MAILED
SEP 262011
OFFICE OF PETITIONS

In re Application of

Diane Troyer

Application No. 11/379,477 Filed: April 20, 2006

Attorney Docket No. 17235-1

**DECISION ON PETITION** 

TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 19, 2011.

## The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Ryan N. Carter on behalf of all attorneys/agents associated with customer number 85110. All attorneys/agents associated with customer number 85110 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The correspondence address has been changed and is copied below.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at 571-272-4618.

/Kimberly Inabinet/

Kimberly Inabinet Petitions Examiner Office of Petitions

cc:

Diane Troyer 1805 Kathlin Drive Iowa City, Iowa 52246



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS PO. Box 1450 Alexandria, Vignia 22313-1450 www.uspto.gov

APPLICATION NUMBER FILING OR 371(C) DATE FIRST NAMED APPLICANT ATTY. DOCKET NO./TITLE

11/379,477 04/20/2006 Diane Troyer 17235-1

85110 Nyemaster, Goode, West, Hansell & O"Brien, P.C. 625 First Street SE Suite 400 Cedar Rapids, IA 52401

POWER OF ATTORNEY NOTICE

Date Mailed: 09/26/2011

**CONFIRMATION NO. 9901** 

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/19/2011.

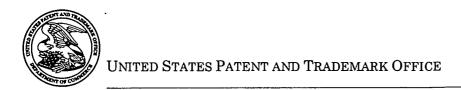
• The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

	/kainabinet/
Office of Data I	Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-010

DATE	:6/02/11	
	: ART UNIT	
O SPE OF		50000
SUBJECT	: Request for Certificate of Corre	ection for Appl. No.: <u>11379535</u> Patent No.: <u>7682067</u>
		CofC mailroom date: 5/12/11
Please resp	ond to this request for a ce	ertificate of correction within 7 days.
OR IFW F	ILES:	
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	plete the response (see be nent code <b>COCX</b> .	elow) and forward the completed response to scannin
FOR PAPE	R FILES:	
	ew the requested changes/ Please complete this form	corrections as shown in the attached certificate of
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PTOL-306 (REV. 7/03)



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450

LEIGHTON K. CHONG PATENT ATTORNEY 133 KAAI STREET HONOLULU HI 96821 MAY 02 2011
OFFICE OF PETITIONS

In re Patent No. 7,656,459

Issue Date: February 2, 2010 : ON PETITION

Application No. 11/379,539

Filed: April 20, 2006

Atty. Docket No. CATN-P1

This is a decision on the petition under 37 CFR 1.48, filed August 19, 2009, which is being treated as a petition filed 37 CFR 1.324.

## The petition is **DISMISSED**.

Applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration for Petition Under 37 CFR 1.324," and should address the deficiencies noted below. Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

Petitioner requests that Rudolph F. Mician be added as a named inventor under 37 CFR 1.48(a). Because a patent has issued, the petition will be treated under 37 CFR 1.324.

37 CFR 1.324(b) requires that a request to correct inventorship of a patent be accompanied by:

- (1) a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intent on his or her part;
- (2) a statement from the current named inventors who have not submitted a statement under paragraph (b)(1) either agreeing to the change of inventorship or stating that the have no disagreement in regard to the requested change;
- (3) a statement from all assignees of the parties submitting a statement under paragraphs (1) and (2) above agreeing to the change of inventorship in the patent that complies with 37 CFR 3.73(b); and
- (4) the fee set forth in 37 CFR 1.20(b).

The instant petition lacks item (1).

Regarding item (1), the statement from Rudolph F. Mician, who is to be added as an inventor, asserts that:

"I believe that I was omitted as an inventor in U.S. Patent Application 11/379,539 through error, and without any deceptive intention on the part of the currently named inventor, Chris Catanzaro, or the authorized official of the assigneed company, David Catanzaro."

However Mr. Mician has failed to state that the inventorship error occurred without any deceptive intent on his part. Thus, the petition cannot be granted. See MPEP §1481.02.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

Mail Stop PETITION

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

By hand:

U.S. Patent and Trademark Office

Customer Service Window, Mail Stop Petitions

Randolph Building 401 Dulany Street Alexandria, VA 22314

The centralized facsimile number is 571-273-8300.

Telephone inquiries relating to this decision should be directed to Robert DeWitty (571-272-8427).

David Bucci

Petitions Examiner

Office of Petitions

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450

MAILED

DEC 19 2011

OFFICE OF PETITIONS

LEIGHTON K. CHONG PATENT ATTORNEY 133 KAAI STREET HONOLULU HI 96821

In re Patent No. 7,656,459

Issue Date: February 2, 2010

Application No. 11/379,539

Filed: April 20, 2006

Atty. Docket No. CATN-P1

**ON PETITION** 

This is a decision on the renewed petition under 37 CFR 1.324, filed May 11, 2011.

The petition is **GRANTED**.

Petitioner has shown that omission of Rudolph R. Mician as an inventor in U.S. Patent No. 7,656,459 was through error and not through any deceptive intent on his part.

Telephone inquiries concerning this decision may be directed to Robert DeWitty, Petitions Attorney, Office of Petitions at (571) 272-8427. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition and directing issuance of the requested Certificate of Correction.

Ramesh Krishnamurthy

Petitions Examiner Office of Petitions

## **CERTIFICATE OF CORRECTION**

PATENT NO : 7,656,459 APPLICATION NO. : 11/379,539 ISSUE DATE : 2/2/2010

INVENTOR(S) : Catanzaro, Chris and Rudolph R. Mician

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Title Page: Item 75

Ruldolph R. Mician will be added as an inventor in U.S. Patent Application No. 11/379,539.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

AFFYMETRIX, INC ATTN: CHIEF IP COUNSEL, LEGAL DEPT. 3420 CENTRAL EXPRESSWAY SANTA CLARA CA 95051

MAILED

FEB 17 2011

OFFICE OF PETITIONS

In re Application of

David Stern

Application No. 11/379,641

Filed: April 21, 2006

Attorney Docket No. 3722.2

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 21, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the final Office action mailed, May 19, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 20, 2009. A Notice of Abandonment was mailed December 8, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a proper After-Final Amendment, (2) the petition fee of \$1,620.00, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

This matter is being referred to Technology Center AU 2886 for processing of the After-Final Amendment filed with the instant petition.

Joan Olszewski Petitions Examiner Office of Petitions



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/03/2010

TEXAS INSTRUMENTS INCORPORATED P O BOX 655474, M/S 3999 DALLAS, TX 75265

**Applicant**: Masanori Otobe

Patent Number : 7653240

Issue Date : 01/26/2010

Application No. : 11/379 654

**Application No:** 11/379,654 **Filed** : 04/21/2006

: DECISION ON REQUEST FOR : RECALCULATION of PATENT

: TERM ADJUSTMENT IN VIEW : OF WYETH AND NOTICE OF INTENT TO

: OF WYETH AND NOTICE OF INTENT TO : ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 950 days. The USPTO will suasponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

22852 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP 901 New York Avenue, NW Washington, DC 20001-4413

MAILED

In re Application of

DANNENMAIER et al

Application No.: 11/379,725 Filing Date: April 21, 2006

Attorney Docket No.: N0129-US01

For: ÉND-CAP ASSEMBLY WITH PUMP

HOSE FOR A FILTER AND FILTER COMPRISING SUCH AN END-CAP

**ASSEMBLY** 

FEB 2 2 2012

**PCT LEGAL ADMINISTRATION** 

**DECISION** 

This decision is in response to the petition under 37 CFR 1.181 filed December 22, 2011which is hereby **DISMISSED** without prejudice for the following reasons.

Applicants request that the subject application be treated as a national stage application under 35 U.S.C. § 371. Applicants submitted a copy of a transmittal letter filed as part of a response in the subject application on September 5, 2008 which identifies the application as a filing under 35 U.S.C. § 371. Applicants claim that this submission should make the application be processed as the national stage of PCT/EP2004/011707.

That is not the case.

The subject application was originally filed electronically with the USPTO on April 21, 2006 as a regular utility application. It is noted that (1) the Electronic Acknowledgement Receipt indicates that the application was filed as a "Utility" application; (2) there was no PCT number listed on the Electronic Acknowledgement Receipt; and, (3) applicants submitted payment fees for a regular utility application.

Accordingly, the subject application was properly processed by the Office under 35 U.S.C. § 111(a). A filing receipt was mailed on 14 October 2008.

It is also noted that the thirty-month period of the international application (PCT/EP2004/011707) had already expired when applicants filed the transmittal letter listing the application as the national stage of PCT/EP2004/011707 on September 5, 2008.

If reconsideration on the merits of any part of this decision is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson Attorney Advisor

Office of PCT Legal Administration

Tel.: (571) 272-3302



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

JELLETT LAW, PS MATTHEW JELLETT, ESQ. 910 HARRIS AVE SUITE A205 BELLINGHAM WA 98225

MAILED

APR 1:1-2011

OFFICE OF PETITIONS

In re Application of

RAPELJE, Donald

Application No. 11/379,762

Filed: April 21, 2006

Attorney Docket No. P415855

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 12, 2011.

:

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by Matthew Jellett, the sole attorney of record. Matthew Jellett has been withdrawn as attorney or agents of record. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the inventor Donald Rapelje at the address indicated below.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

/Tredelle D. Jackson/ Paralegal Specialist Office of Petitions

cc:

DONALD RAPELJE 85 PANORAMA BOULEVARD SEQUIM WA 98382



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

RADA HIGGINS KEIZERSGRACHT 63 B AMSTERDAM 1015 CE NL NETHERLANDS

**MAILED** 

SEP 23 2010

**OFFICE OF PETITIONS** 

In re Application of Rada Ruth Higgins

Application No. 11/379,793

Filed: April 23, 2006

Attorney Docket No. shaynemoira04230

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed September 7, 2010, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration or petition under 37 CFR 1.137(b) must be submitted within TWO (2) MONTHS from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C § 704.

The above-identified application became abandoned for failure to reply to the restriction/election requirement mailed February 16, 2010, which set a shortened period for reply of one (1) month from its mailing date. Extension of time set for reply was available pursuant to 37 CFR 1.136(a). A Notice of Abandonment was mailed on August 30, 2010.

A grantable petition under 37 CFR 1.137(a)<sup>1</sup> must be accompanied by: (1) the required reply,<sup>2</sup> unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due

<sup>&</sup>lt;sup>1</sup>As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

<sup>&</sup>lt;sup>2</sup> In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

Page 2

date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks items (2) and (3).

# The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked **any** basis in reason or common sense."

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law." 5

"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."

<sup>&</sup>lt;sup>3</sup>Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")

<sup>&</sup>lt;sup>4</sup>Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

<sup>&</sup>lt;sup>5</sup><u>Haines v. Quigg</u>, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

<sup>&</sup>lt;sup>6</sup>Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

#### The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?" Nonawarness of a PTO rule will not constitute unavoidable delay.

# Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner asserts that a response to the Notice was timely sent via facsimile, but apparently not received by the USPTO.

As to item (2), petitioner is advised that the fee for the instant petition is \$270.00 (small entity) and that the fee did not accompany the petition. The fee of \$270.00 must accompany the renewed petition.

A review of the papers filed September 7, 2010, reveals that applicant is placing an incorrect application serial number on the correspondence applicant is mailing to the USPTO. The response that applicant faxed on March 11, 2010, cites application serial number 11/279,793. The paper faxed March 11, 2010, were located in application serial number 11/279,793. As were papers applicant filed on September 7, 2010, and September 9, 2010. The correct application serial number is 11/379,793. Applicant is cautioned to be sure to use the correct application number in future filings.

Because a response to the restriction requirement was timely received, albeit it in the wrong application, applicant is not required to make a showing that the entire delay in responding to the restriction requirement was unavoidable. Steps have been taken to have the incorrectly filed papers put in the subject application file.

<sup>7</sup>Id.

<sup>&</sup>lt;sup>8</sup>See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

<sup>&</sup>lt;sup>9</sup>See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

# In re Application of Rada Ruth Higgins 11/379,793

Page 4

However, the application is in abandoned status and petitioner is required to revive the application under 37 CFR 1.137 if petitioner desires the application to proceed in its examination. Accordingly, petitioner must file a renewed petition under 37 CFR 1.137(a), along with payment of the petition fee within two months of the mailing of this decision.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Commissioner for Patents

United States Patent and Trademark Office

Box 1450

Alexandria, VA 22313-1450

By facsimile:

(571) 273-8300

Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Petitions Attorney Office of Petitions

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

RADA HIGGINS KEIZERSGRACHT 63 B AMSTERDAM 1015 CE NL NETHERLANDS

MAILED

DEC 202010

OFFICE OF PETITIONS

In re Application of

Higgins

Application No. 11/379,793

....,

**DECISION ON PETITION** 

Filed: April 23, 2006

Attorney Docket No. shaynemoira042306

This is a decision on the petition under 37 CFR 1.181(a) to withdraw the holding of abandonment, filed November 1, 2010.

The petition under 37 CFR 1.181(a) to withdraw the holding of abandonment is granted.

This application was held abandoned on May 17, 2010, after it was believed that no reply was received to the election/restriction requirement mailed March 11, 2010, which set a shortened period for reply of one month from its mailing date. A Notice of Abandonment was mailed on August 20, 2010, indicating that a reply was not received.

The instant petition maintains that a reply was timely filed on March 11, 2010, however; reply cited an incorrect application serial number. A review Office records reveals that reply was filed in application serial number 11/279,793 on March 11, 2010. The evidence is convincing that the response was timely received, albeit having been routed to the incorrect application. Because a response was filed with the Office prior to the expiration of the period for reply, the petition is granted and the holding of abandonment withdrawn.

The application file is being forwarded Technology Center 2100, GAU 2193, for further processing including consideration of response filed March 11, 2010.

Questions regarding this decision may be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Petitions Attorney Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

RADA HIGGINS KEIZERSGRACHT 63 B AMSTERDAM 1015 CE NL NETHERLANDS MAILED
MAR 1 2 2012

OFFICE OF PETITIONS

In re Application of

Higgins

Application No. 11/379,793

Filed: April 23, 2006

Attorney Docket No. SHAYNEMOIRA042306

ON PETITION

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment, filed on February 28, 2012.

### The petition is **DISMISSED**.

The record reflects that a Notice of Allowance and Issue Fee Due was mailed October 7, 2011, allowing a shortened period for reply of two months from its mailing date. The Notice required payment of the issue fee and publication fee and required corrected drawings to be filed. The Notice set a non-extendable period for reply of three months from its mailing date. A response was not noted prior to the expiration of the period for reply and the application became abandoned on January 8, 2011. A Notice of Abandonment was mailed February 2, 2012.

Petitioner maintains that delays with the postal delivery service in Amsterdam caused the delay in the USPTO receiving the issue fee and publication fee payments and the corrected drawings.

Section 711.03 of the *Manual of Patent Examining Procedure* provides guidance where, as in this case, petitioner is arguing that a timely response to the Office action was mailed and provides, in pertinent part, that:

37 CFR 1.10(c) through 1.10(e) and 1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 CFR 1.10(c), (d), (e), or (g) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of

# In re Application No. 11/379,793

abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 CFR 1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 CFR 1.8(b) and MPEP § 512. As stated in 37 CFR 1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 CFR 1.8).

37 CFR 1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 CFR 1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP § 512.

The above-cited section of the MPEP explains that in order for correspondence to receive a filing date as of the date of deposit with the United States Postal Service (USPS), the correspondence must either be mailed via USPS Express Mail, or the correspondence must contain a proper certificate of mailing pursuant to 37 CFR 1.8. Correspondence may also receive the date of the receipt with the USPTO if petitioner provides an itemized Office date-stamped postcard whereby the USPTO acknowledges receipt of the item mailed. There is no evidence that petitioner used the procedures provided in 37 CFR 1.8 and 1.10, which, if properly utilized, would allow a filing to be accorded a filing date as of the date mailed or deposited, respectively, rather than the date the filing was received by the Office. The certificate of mailing procedures under 37 CFR 1.8 allow for a filing date to be accorded as of the date the filing was mailed rather than the date the filing was received by the Office provided the procedures set out in 37 CFR 1.8 are followed and the filing is not excepted under 37 CFR 1.8(2)(i). The procedures under 37 CFR 1.10 allow correspondence deposited with the United States Postal Service Express Mail Service pursuant to 37 CFR 1.10 to be accorded a filing date as of the date-in shown on the Express Mail label rather than the date the filing was received by the Office. Filings made by any other mail service, i.e., first class postage, USPS certified mail, FEDEX, Priority Mail, will not receive the benefit of 37 CFR 1.10.

The holding of abandonment will not be withdrawn because petitioner has not provided *prima facie* evidence that the response was deposited with the USPS Express Mail Service within the period for reply, and has not provided a certificate of mailing pursuant to 37 CFR 1.8, or an USPTO date-stamped postcard showing that the response received and lost by the USPTO. It is noted that petitioner resides in The Netherlands and that petitioner would not be able to mail the response pursuant to 37 CFR 1.10 or making the required certificate of mailing under 37 CFR 1.8. Notwithstanding, petitioner remains responsible for ensuring that a timely response to all Office actions is received within the period set for reply whether the response is sent by mail or facsimile. Petitioner has not demonstrated that a timely response was mailed or received by the Office; it is, therefore, inappropriate to withdraw the holding of abandonment. The petition is dismissed accordingly.

Alternatively, petitioner may revive the application based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply, the required petition fee (\$1860.00 for a large entity and \$930.00 for a verified small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

In re Application No. 11/379,793

Further correspondence with respect to this matter should be addressed as follows:

United States Patent and Trademark Office

Box 1450

Alexandria, VA 22313-1450

By facsimile:

(571) 273-8300

Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Petitions Attorney Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Patent No. : 7,745,953 B2 Ser. No. : 11/380,043 B2 Inventor(s) : Puccetti et al.. Issued : Jun. 29, 2010

Title : ENERGY STORAGE SYSTEM FOR POWERING VEHICLE ELECTRIC

**USER DEVICES** 

Docket No. : TOR0109

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based solely on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing <u>incorrect or erroneous</u> assignment data, before issuance of a Certificate of Correction, under 37 CFR 1.323 (see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481). This procedure is required at any time after the issue fee is paid, including after issuance of the patent.

In view of the foregoing, your request, in this matter, is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

- A. the processing fee set forth in 37 CFR 1. 17(i) (currently \$130);
- B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
- <u>C.</u> a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail:

Mail Stop PETITIONS Commissioner for Patents Post Office Box 1450 Alexandria, VA 22313-1450 By hand:

Customer Service Window

Mail Stop Petitions Randolph Building 40l Dulany Street Alexandria, VA 22314

By fax:

(703) 872-9306

ATTN: Office of Petitions

If a fee (currently \$100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

# **Ennis Young**

For Mary Diggs
Decisions & Certificates
of Correction Branch
(571) 272-3435 or (703) 756-1814

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON VA 20190

**MAILED** 

APR 22 2011

OFFICE OF PETITIONS

In re Application of

XU, Ming

Application No. 11/380,064

NOTICE

Patent No. 7,560,912

Filed: April 25, 2006

Attorney Docket No. 01640552AA

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 March 28, 2011.

The Office no longer investigates or rejects original or reissue patent under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-2783.

/Tredelle D. Jackson/ Paralegal Specialist Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
BLDG. 082-1
LEXINGTON KY 40550-0999

MAILED

FEB 08 2011

OFFICE OF PETITIONS

In re Application of

COMBS, et al

Application No. 11/380,065

Filed: April 25, 2006

Attorney Docket No. 2001-0471.00

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 11, 2009, to revive the above-identified application.

# The petition is **GRANTED**.

The application became abandoned for failure to timely pay the issue and publication fees on or before February 17, 2009, as required by the Notice of Allowance and Fee(s) Due (Notice), mailed November 14, 2008, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on February 18, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of \$1510 and the publication fee of \$300; (2) the petition fee of \$1620; and (3) a statement of unintentional delay.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is **not** a correct reading of the statement appearing in the petition.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future

correspondence regarding this application, the appropriate power of attorney document must be submitted.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6735.

The application is being referred to the Office of Data Management for processing into a patent.

/Diane C. Goodwyn/ Diane C. Goodwyn Petitions Examiner Office of Petitions

# SPE RESPONSE FOR CERTIFICATE OF CORRECTION

		Раре	er No.:20100902			
DATE	: September 3, 2010					
TO SPE OF	OF: ART UNIT 1638					
SUBJECT	ECT: Request for Certificate of Correction on Patent No.: 7,476,784					
A response is	requested with respect to the accomp	panying request for a certificate of	correction.			
Please complete this form and return with file, within <b>7</b> days to: <b>Certificates of Correction Branch - PK 3-910</b> Palm location <b>7590</b> - Tel. No. 305-8201						
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.						
Thank You F	or Your Assistance	Certificates of Correction	n Branch			
The request for issuing the above-identified correction(s) is hereby:  Note your decision on the appropriate box.						
⊠ Ар	proved	All changes apply.				
□ Ар	proved in Part	Specify below which changes do	not apply.			
☐ De	nied	State the reasons for denial below	<i>v</i> .			
Comments:						
		SPE: Anne Marie Grunberg	Art Unit 1638			





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

POLSINELLI SHUGHART PC 700 W. 47TH STREET SUITE 1000 KANSAS CITY MO 64112-1802

MAILED

JAN 25 2011 OFFICE OF PETITIONS

In re Application of Wolter et al.

Application No. 11

Application No. 11/380,227

Filed: April 26, 2006

Attorney Docket No. 11/380,227

Title: ACTIVATORS FOR

OLIGONUCLEOTIDE AND

PHOSPHORAMIDITE SYNTHESIS

ON APPLICATION FOR

PATENT TERM ADJUSTMENT

This is a decision on the "STATEMENT OF FACTS UNDER 37 CFR  $\S1.705(b)(2)$ ," filed August 27, 2010. Applicants dispute the twenty-two (22) day reduction.

The application for patent term adjustment is GRANTED.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

On May 28, 2010, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicants were advised that the patent term adjustment to date is 558 days. In response, applicants timely filed the instant request for reconsideration of the patent term adjustment along with payment of the fee set forth in 37 C.F.R. § 1.18(e).

Applicants contend that the non-final Office action mailed on October 20, 2009 was vacated upon the mailing of the November 17, 2009 Office action. Thus, applicants contend the response filed on February 11, 2010 was submitted within three months of the shortened statutory period set in the November 18, 2009 Office action.

Applicants' argument is persuasive. A review of the record shows the time period was restarted upon the mailing of the November 18, 2009 Office action. Under the circumstances, applicants are correct that they did not fail to engage in reasonable efforts within the meaning of § 1.704(b). Instead, the response filed February 11, 2010, was received within three months after the mailing of the Office action as re-mailed on November 18, 2009. Accordingly, a period of reduction of 22 days will be removed.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is 580 days (580 - 0).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3215.

Charlema Grant

Attorney

Office of Petitions

Enclosure: Copy of REVISED PALM Screen



PTA/PTE Information

Application	Number*:	11380227

Search Explanation of PTA Calculation Explanation of PTE Calculation

# PTA Calculations for Application: 11380227

Application Filing Date 04/26/2006	OverLapping Days Between (A and B) or (A and C) 0
Issue Date of Patent	Non-Overlapping USPTO Delays: 580
A Delays 580	PTO Manual Adjustment 22
B Delays 0	Applicant Delay (APPL) 22
C Delays 0	Total PTA (days) 580

# \* - Sorted Column

# File Contents History

Θ

<u>Action</u> Number	Action Recorded Date	Action Due Date	Action Code	Action Description	Puration PTO	Duration APPL	Parent Action Numbe
55	01/23/2011		P028	Adjustment of PTA Calculation by PTO	22		0
54	05/28/2010		MN/=.	Mail Notice of Allowance			0
3	05/21/2010		IREV	Issue Revision Completed			0
2	05/21/2010		DVER	Document Verification			0
1	05/21/2010		N/=.	Notice of Allowance Data Verification Completed			0
0	05/21/2010		DOCK	Case Docketed to Examiner in GAU			0
19	05/21/2010		EX.A	Examiner's Amendment Communication			0
7	05/19/2010		CNTA	Notice of Allowability			0
18	05/12/2010		EXIN	Examiner Interview Summary Record (PTOL - 413)			0
6	03/11/2010		FWDX	Date Forwarded to Examiner			0
15	02/11/2010	01/20/2010	A	Response after Non-Final Action		22	41
14	02/11/2010		XT/G	Request for Extension of Time - Granted			0
3	11/18/2009	•	MM327	Mail Miscellaneous Communication to Applicant			0
2	11/17/2009		M327	Miscellaneous Communication to Applicant - No Action Count			0
1	10/20/2009	03/24/2009	MCTNF	Mail Non-Final Rejection	<u>210</u>		33
0	10/19/2009	•	CTNF	Non-Final Rejection			0
14	07/28/2009	•	FWDX	Date Forwarded to Examiner			0
13	11/24/2008		A	Response after Non-Final Action			0
12	10/30/2008		MCTMS	Mail Miscellaneous Communication to Applicant			0
31	10/27/2008		CTMS	Miscellaneous Action with SSP			0
26	08/25/2008		FWDX	Date Forwarded to Examiner			0
24	07/30/2008		PA	Change in Power of Attorney (May Include Associate POA)			0
25	07/29/2008		ELC.	Response to Election / Restriction Filed			0
23	07/29/2008		C.AD	Correspondence Address Change			0
22	06/30/2008	06/26/2007	MCTRS	Mail Restriction Requirement	370		-1
21	06/23/2008	,,	CTRS	Requirement for Restriction / Election			0
39	02/13/2008		IDSC	Information Disclosure Statement considered			0
19	02/13/2008		EIDS.	Electronic Information Disclosure Statement			0
18	02/13/2008		WIDS	Information Disclosure Statement (IDS) Filed			0
17	12/10/2007	•	DOCK	Case Docketed to Examiner in GAU			0
38	02/09/2007		IDSC	Information Disclosure Statement considered			0
16.7	02/09/2007		EIDS.	Electronic Information Disclosure Statement			0
6	02/09/2007		WIDS	Information Disclosure Statement (IDS) Filed			0
15	08/15/2006		TSSCOMP	IFW TSS Processing by Tech Center Complete			0
12	07/10/2006		OIPE	Application Dispatched from OIPE			0
11	07/10/2006		COMP	Application Is Now Complete			0
,	07/03/2006		CRFE	CRF Is Good Technically / Entered into Database			0
17	06/26/2006		IDSC	Information Disclosure Statement considered			0
4	06/26/2006		RCAP	Reference capture on IDS			0 .
13.7	06/26/2006		M844	Information Disclosure Statement (IDS) Filed			ō
13	06/26/2006		WIDS	Information Disclosure Statement (IDS) Filed			ò
0	06/20/2006			Additional Application Filing Fees			o
)	06/20/2006		SEQLIST	A set of symbols and procedures, provided to the PTO on a set of computer listings, that describe in			0
3	06/20/2006		OATHDECL	A statement by one or more inventors satisfying the requirement			0
5	05/12/2006		INCD	Notice MailedApplication IncompleteFiling Date Assigned	•		0
•	05/09/2006		L128	Cleared by L&R (LARS)			0
3 '	05/08/2006		L198	Referred to Level 2 (LARS) by OIPE CSR			0
2	05/03/2006		SCAN	IFW Scan & PACR Auto Security Review			0
1	04/26/2006		IEXX	Initial Exam Team nn			0

Export to: Excel

		R CERTIFICATE OF CORRECTION
DATE	: <u>July 30. 2010</u>	
TO SPE OF SUBJECT	: ART UNIT <u>1797</u> : Request for Certificate of Correction	on for Appl. No <u>/11/380239 /pat. /7745204</u>
Please resp 7 days.	oond to this request for a certif	ficate of correction within
FOR IFW F	ILES:	
the IFW ap	ew the requested changes/co plication image. No new matte the claims be changed.	rrections as shown in the <b>COCIN</b> document(s) in er should be introduced, nor should the scope or
	nplete the response (see below ment code COCX.	w) and forward the completed response to scann
FOR PAPE	R FILES:	
		rrections as shown in the attached certificate of ee below) and forward it with the file to:
correction. Certi Rand		ee below) and forward it with the file to:
correction. Certi Rand	Please complete this form (se ificates of Correction Branch dolph Square – 9D10-A	ee below) and forward it with the file to:  h (CofC)
correction. Certi Rand	Please complete this form (se ificates of Correction Branch dolph Square – 9D10-A	ee below) and forward it with the file to:
correction. Certi Rand	Please complete this form (se ificates of Correction Branch dolph Square – 9D10-A	ee below) and forward it with the file to:  h (CofC)  .  Magdalene Talle
correction. Certi Ranc Palm	Please complete this form (se ificates of Correction Branch dolph Square – 9D10-A	ee below) and forward it with the file to:  h (CofC)  Magdalene Talle  Certificates of Correction Branc
Correction. Certing Rand Palm Thank You	Please complete this form (seificates of Correction Branch dolph Square – 9D10-A n Location 7580	ee below) and forward it with the file to:  h (CofC)  Magdalene Tall  Certificates of Correction Branc
Certing Rand Palm  Thank You  The requese Note your decision	Please complete this form (selficates of Correction Branch dolph Square – 9D10-An Location 7580  For Your Assistance st for issuing the above-iden	ee below) and forward it with the file to:  h (CofC)  Magdalene Talle  Certificates of Correction Brance  571-272-0423
Correction. Certi Ranc Palm  Thank You The reques Note your decision	Please complete this form (selficates of Correction Branch dolph Square – 9D10-An Location 7580  For Your Assistance  St for issuing the above-ident on the appropriate box.	Magdalene Tall  Certificates of Correction Brance 571-272-0423  attified correction(s) is hereby:
Correction. Certi Ranc Palm  Thank You The reques Note your decision	Please complete this form (selficates of Correction Branch dolph Square – 9D10-An Location 7580  For Your Assistance  St for issuing the above-ident on the appropriate box.	Magdalene Talle  Certificates of Correction Brance  571-272-0423  All changes apply.
Correction. Certi Ranc Palm  Thank You The reques Note your decision	Please complete this form (selficates of Correction Branch dolph Square – 9D10-An Location 7580  For Your Assistance  If for issuing the above-ident on the appropriate box.  Approved  Approved  Approved in Part  Denied	Magdalene Talle Certificates of Correction Brance 571-272-0423  All changes apply.  Specify below which changes do not apply.
Thank You The reques Note your decisio	Please complete this form (selficates of Correction Branch dolph Square – 9D10-An Location 7580  For Your Assistance  St for issuing the above-ident on the appropriate box.  Approved Approved Approved in Part Denied  OK TO ENTER	Magdalene Talle Certificates of Correction Brance 571-272-0423  All changes apply. Specify below which changes do not apply. State the reasons for denial below.
Thank You The reques Note your decisio	Please complete this form (selficates of Correction Branch dolph Square – 9D10-An Location 7580  For Your Assistance  If for issuing the above-ident on the appropriate box.  Approved  Approved  Approved in Part  Denied	Magdalene Talle Certificates of Correction Brance 571-272-0423  All changes apply. Specify below which changes do not apply. State the reasons for denial below.

Michael Marcheschi

1775



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

RECHES PATENTS 211 North Union St. Suite 100 Alexandria, VA 22314 MAILED
DEC 0 6 2011
OFFICE OF PETITIONS

In re Application of

Oz, et al.

Application No. 11/380,363

Filed: April 26, 2006

Attorney Docket No. 71957-US

**DECISION ON PETITION** 

This is a decision on the petition under 37 CFR 1.137(b), filed November 15, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, April 22, 2011, which set a shortened statutory period for reply of three (3) months from its mailing date. No extension of time pursuant to 37 CFR 1.136(a) was obtained within the allowable period. Accordingly, the application became abandoned on July 23, 2011. A Notice of Abandonment was mailed November 14, 2011.

The amendment filed November 15, 2011, is noted.

The application is being forwarded to Technology Center 2400, GAU 2424 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Petitions Attorney Office of Petitions

# SPE RESPONSE FOR CERTIFICATE OF CORRECTION

	JF L IN	13FONSET ON CENTIFICATE OF CONNECTION
		Paper No.:20100902
DATE	: September 02, 20	10
TO SPE O	F : ART UNIT 1638	
SUBJECT	: Request for Certif	icate of Correction on Patent No.: 7,355,107
A response	is requested with respe	ct to the accompanying request for a certificate of correction.
Certificate	•	eturn with file, within <b>7</b> days to: 1 <b>ch - ST (South Tower) 9A22</b> 13) 305-8309
read as sho	• , ,	ested, correcting Office and/or Applicant's errors, should the patent orrection? No new matter should be introduced, nor should the scope or
Thank Yo	u For Your Assistand	Certificates of Correction Branch
•	est for issuing the about on the appropriated box.	ove-identified correction(s) is hereby:
$\boxtimes$	Approved	All changes apply.
	Approved in Part	Specify below which changes <b>do not</b> apply.
	Denied	State the reasons for denial below.
Comment The chang /EM/		proved given that the required documents have been provided.
		/Anne Marie Grunberg/ Supervisory Patent Examiner.Art Unit 1638



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Schultz & Associates, P.C. Suite 1200 5400 LBJ Freeway Dallas TX 75240 MAILED
AUG 3 0 2010
OFFICE OF PETITIONS

In re Application of

Jacquelin Grosser-Samuels et al.

Application No. 11/380,542

Filed: April 27, 2006

Attorney Docket No. P1028US00

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 13, 2010, to revive the above-identified application.

# The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the final Office action mailed, November 19, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on February 20, 2010. A Notice of Abandonment was mailed on June 3, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a continuing application under 37 CFR 1.53(b), (2) the petition fee of \$810 and (3) a proper statement of unintentional delay. Accordingly, the filing of a continuing application under 37 CFR 1.53(b) is accepted as being unintentionally delayed.

The application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the application, the application is again abandoned in favor of a continuing application under 37 CFR 1.53(b).

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

/Kimberly Inabinet/

Kimberly Inabinet Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

USPOLYRESEARCH 906 SPRUCE ST. ASHLAND PA 17921 MAILED

NOV 10 2010

**OFFICE OF PETITIONS** 

In re Application of

POLYAKOV, YURIY S.

Application No. 11/380,637

Filed: April 27, 2006

Title: HOLLOW FIBER MEMBRANE

ADSORBER AND PROCESS FOR THE USE

THEREOF

**DECISION ON PETITION** 

This is a decision on the petition under 37 CFR 1.137(b), filed August 12, 2010, to revive the above-identified application.

# The petition is **GRANTED**.

This application became abandoned for failure to submit a timely reply to the non-final Office action, mailed March 28, 2008, which set a three-month shortened statutory period to respond. As petitioner did not file a proper and timely reply to the non-final Office action, the application became abandoned by operation of law on June 29, 2008. The Office mailed a Notice of Abandonment on October 7, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply, (2) the petition fee, and (3) a proper statement of unintentional delay.

The Office notes that the grant of a petition under 37 CFR 1.137 is not a determination that any reply under 37 CFR 1.111 is complete. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect. See MPEP 711.03(c)(II)(A)(2)(a).

This application is being referred to Technology Center AU 1797 for appropriate action on the reply submitted July 21, 2009.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell Senior Petitions Attorney Office of Petitions

C. P. Donnell

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

KLEIN, O'NEILL & SINGH, LLP 18200 VON KARMAN AVENUE SUITE 725 IRVINE CA 92612 **MAILED** 

MAR 12 2012

OFFICE OF PETITIONS

In re Patent No. 8,134,993 Issued: March 13, 2012

Application No.: 11/380,654

Filed: April 28, 2006

Attorney Docket No: 1291-061.101

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Petitions Attorney Office of Petitions





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.usplo.gov

BANNER & WITCOFF, LTD AND ATTORNEYS FOR CLIENT NUMBER 011738 10 SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606

MAILED

APR 21 2011

OFFICE OF PETITIONS

In re Application of

OSORIO, Ivan et al.

Application No. 11/380,752

Filed: April 28, 2006

Attorney Docket No. 539.3178.1

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 05, 2011.

The request is **MOOT** because a revocation of power of attorney has been previously filed.

A review of the file record indicates that the power of attorney to BANNER & WITCOFF, LTD has been revoked by the assignee of the patent application on April 07, 2011. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

/Tredelle D. Jackson/ Paralegal Specialist Office of Petitions

cc: FREDRIKSON & BYRON, P.A.

INTELLECTUAL PROPERTY GROUP, MDT PATENTS

200 SOUTH SIXTH STREET, SUITE 4000

**MINNEAPOLIS MN 55402** 

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

SCHLUMBERGER OILFIELD SERVICES 200 GILLINGHAM LANE MD 200-9 SUGAR LAND, TX 77478

MAILED

JAN 14 2011

OFFICE OF PETITIONS

In re Application of Christian Menger

Application No. 11/380,756

Filed: April 28, 2006

Attorney Docket No. 92.1033

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed November 29, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed May 12, 2010, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on August 13, 2010.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 3672 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Jeremy P. Welch

Schlumberger, Brunel Way Stroudwater Business Park

Stonehouse, Gloucester GL 10 3SX

United Kingdom



ANTONIA CARACTERISTICS

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SCHLUMBERGER OILFIELD SERVICES 10001 RICHMOND AVENUE IP ADMINISTRATION CENTER OF EXCELLENCE HOUSTON TX 77042

MAILED
FEB 0.7 2012
OFFICE OF PETITIONS

In re Application of

Christian Menger Application No. 11/380,756

Filed: April 28, 2006

Attorney Docket No. 92.1033

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed January 29, 2012, to revive the above-identified application.

The petition is GRANTED.

The above-identified application became abandoned for failure to reply in a timely manner to the Office communication mailed March 23, 2011, which set a period for reply of one (1) month or thirty (30) days (whichever is later). Accordingly, the above-identified application became abandoned on April 24, 2011.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 3672 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Jere

Jeremy P. Welch Stroudwater Business Park Stonehouse, Gloucestershire GL10 3SX United Kingdom



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

FITCH EVEN TABIN & FLANNERY 120 SOUTHLASALLE STREET SUITE 1600 CHICAGO IL 60603-3406

MAR 04 2011

OFFICE OF PETITIONS

In re Application of

Fumitake Yodo et al

Application No. 11/380,890

Filed: April 28, 2006

Attorney Docket No. 86288 |FSC05002US|

: DECISION GRANTING PETITION

: UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed March 3, 2011, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on February 18, 2011 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 2173 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

/Karen Creasy/ Karen Creasy Petitions Examiner Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

**MERCHANT & GOULD PC** P.O. BOX 2903 **MINNEAPOLIS MN 55402-0903**  MAILED

OCT 1 2 2010

OFFICE OF PETITIONS

In re Application of

David M. Webb, et al.

Application No. 11/381,010 **DECISION ON PETITION** 

Filed: May 1, 2006

Attorney Docket No. 758.1820USI1

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 28, 2010, to revive the above-identified application.

# The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Restriction Requirement, mailed May 19, 2009, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on June 20, 2010. The Notice of Abandonment was mailed November 24, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an election, (2) the petition fee of \$1,620, and (3) a proper statement of unintentional delay.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney document must be submitted. While a courtesy copy of this decision is being mailed to the person signing the petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the \$2,350 extension of time fee submitted with the petition on September 28, 2010 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

Telephone inquiries concerning this decision should be directed to Terri Johnson at (571) 272-2991.

This application is being referred to Technology Center AU 1797 for appropriate action by the Examiner in the normal course of business on the reply received.

/Terri Johnson/ Terri Johnson Petitions Examiner Office of Petitions

cc: MARK DIPIETRO
PLAZA VII, SUITE 3000
45 S. SEVENTH STREET
MINNEAPOLIS, MN 55402-1630



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FAEGRE & BENSON LLP
PATENT DOCKETING - INTELLECTUAL PROPERTY (32469)
2200 WELLS FARGO CENTER
90 SOUTH SEVENTH STREET
MINNEAPOLIS MN 55402-3901

MAILED

JAN 04 2011

OFFICE OF PETITIONS

In re Patent No. 7,689,291

Issue Date: March 30, 2010

Application No. 11/381,018

Filed: May 1, 2006

Attorney Docket No. 279.C27US1

**DECISION ON PETITION** 

This is a decision on the petition filed September 17, 2010, requesting issuance of a duplicate Letters Patent for the above-identified patent that is being considered under 37 CFR 1.182.

# The petition is **DISMISSED**.

Petitioner states in the instant petition that "Applicants respectfully request a copy of the Ribbon Patent". However, petitioner must indicate the reason for the request (i.e., lost, stolen, destroyed, or never been received). If petitioner implicates that the Ribbon Patent was never received, petitioner must follow the guidelines listed below.

The Office follows the guidelines set forth in MPEP § 711.03(c) (see also "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993), which sets forth that, in the absence of any irregularity in the mailing of an Office action (in this case, the Letters Patent), there is a strong presumption that the Office action (Letters Patent) was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Letters Patent was not in fact received. In this regard, the showing required to establish the failure to receive the Letters Patent must consist of the following:

- 1. a statement from practitioner stating that the Letters Patent was not received by the practitioner;
- 2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Letters Patent was not received; and
- 3. a copy of the docket record where the non-received Letters Patent would have been entered had it been received must be attached to and referenced in the practitioner's statement.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

Mail Stop PETITION

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

By facsimile:

(571) 273-8300

Attn: Office of Petitions

By hand:

U. S. Patent and Trademark Office

Customer Service Window, Mail Stop Petitions

Randolph Building 401 Dulany Street Alexandria, VA 22314

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-2991.

/Terri Johnson/ Terri Johnson Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Kutak Rock LLP 1010 Grand Boulevard, Suite 500 Kansas City MO 64106

MAILED
MAY 3 1 2011
OFFICE OF PETITIONS

In re Application of

Robert David Sager

Application No. 11/381,099

Filed: May 1, 2006

Attorney Docket No. 70027210-0011

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 2, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the final Office action mailed, July 21, 2010, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on October 22, 2010. A Notice of Abandonment was mailed on February 2, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a RCE (Request for Continued Examination, with the required fee of \$405, (2) the petition fee of \$810, and (3) a proper statement of unintentional delay. Accordingly, the RCE is accepted as being unintentionally delayed.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to Technology Center AU 3687 for appropriate action by the Examiner in the normal course of business on the reply received May 2, 2011.

/Kimberly Inabinet/

Kimberly Inabinet Petitions Examiner Office of Petitions

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

STEPTOE & JOHNSON, PLLC 400 White Oaks Boulevard Bridgeport, WV 26330

**MAILED** 

OCT 01 2010

OFFICE OF PETITIONS

In re Application of Shreeniwas R. Jawalekar Application No. 11/381,126 Filed: May 1, 2006 Attorney Docket No. 449660/00001A

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the renewed request to withdraw as attorney or agent of record under 37 CFR §§ 1.36(b), or 10.40 filed July 29, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others.

The request was signed by Michael B. Pallay on behalf of himself. Therefore, Michael B. Pallay has been withdrawn as attorney or agent and all other attorneys/agents remain of record.

The correspondence address of record remains unchanged.

This application is being referred to Technology Center Art Unit 3711 for review of the response filed on September 14, 2010.

Telephone inquiries concerning this decision should be directed to the undersigned at (671) 272-3226. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

Andrea Smith
Petitions Examiner
Office of Petitions

cc: Steptoe & Johnson, PLLC P.O. Box 2190 Clarksburg, WV 26302 PTO/SB/66 (03-09)

Approved for use through 03/31/2012. OMB 0651-0016

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

	Issue Date		ATENT (37 CF	T 1.07.0(0))
Patent Number	(YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
7,326,885	2008-02-05	11/381,228	2006-05-02	TFLED-609US
				e(s) is/are associated with the correct patent. 37 CFR
	ims, or has previously	claimed, small en	tity status. See 37 C	FR 1.27.
	EMENT TO SMALL EN TO longer entitled to sm		See 37 CFR 1.27(g)	
NOT Small Entity			Small Entity	
Fee ● 3½ year	Code (1551)		Fee 3 ½ year	Code (2551)
7 ½ year	(1552)		7 ½ year	(2552)
11 ½ year	` ,		11 ½ year	(2553)
SURCHARGE The surcharge req of the maintenance		i)(2) (Fee Code 1	558) must be paid a	s a condition of accepting unintentionally delayed payment
	EE (37 CFR 1.20(e)-(ç aintenance fee must b		his petition.	
STATEMENT THE UNDERSIGN UNINTENTIONAL	IED CERTIFIES THAT	THE DELAY IN	PAYMENT OF THE	MAINTENANCE FEE TO THIS PATENT WAS
PETITIONER(S) R REINSTATED	REQUEST THAT THE	DELAYED PAYM	ENT OF THE MAINT	ENANCE FEE BE ACCEPTED AND THE PATENT
THIS PORTION M	UST BE COMPLETED	BY THE SIGNA	TORY OR SIGNATO	RIES
	tates: "Any petition unfice, or by the patentee			attorney or agent registered to practice before the Patent st."
I certify, in accorda	ance with 37 CFR 1.4(	d)(4) that I am		
An attorney	or agent registered to	practice before the	e Patent and Traden	ark Office
A sole pater	ntee			
A joint pater	ntee; I certify that I am	authorized to sign	this submission on	behalf of all the other patentees.
A joint pater	ntee; all of whom are s	igning this e-petiti	on	
The assignee of record of the entire interest				

Approved for use through 03/31/2012. OMB 0651-0016 U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner					
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature					
Signature	/David H. Brinkman/	Date (YYYY-MM-DD)	2012-04-11		
Name	David H. Brinkman	Registration Number	40532		

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.

## **Privacy Act Statement**

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

- 1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.
- A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
- 3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
- 4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
- 5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
- 6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
- 7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
- 8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
- 9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



## UNITED STATES PATENT AND TRADEMARK OFFICE

**Commissioner for Patents** United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

In re Patent No. 7326885

Issue Date:

February 5,2008

Application No. 11381228

Filed:

May 2,2006

:DECISION GRANTING PETITION

:UNDER 37 CFR 1.378(c)

Attorney Docket No. TFLED-609US

April 11,2012 This is a decision on the electronic petition, filed ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

April 11,2012 The maintenance fee is accepted, and the above-identified patent reinstated as of This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
11/381,238	05/02/2006	Roger Hastings	279.J07US1	4010	
45458 SCHWEGMA	7590 08/08/2011 N, LUNDBERG & WOI	EXAM	EXAMINER		
PO BOX 2938		BERTRAM	BERTRAM, ERIC D		
MINNEAPOLIS, MN 55402			ART UNIT	PAPER NUMBER	
			3766		
•			NOTIFICATION DATE	DELIVERY MODE	
			08/08/2011	ELECTRONIC	

## Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@slwip.com request@slwip.com



## UNITED STATES DEPARTMENT OF COMMERCE U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
11/381.238	02 May 2006	HASTINGS ET AI	279 I07US1

SCHWEGMAN, LUNDBERG & WOESSNER/BSC-CRM PO BOX 2938 MINNEAPOLIS, MN 55402

Eric D. Bertram **ART UNIT PAPER** 

**EXAMINER** 

3766

20110804

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

#### **Commissioner for Patents**

In view of the papers filed 11/16/2006, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding inventor ANUPAMA SADASIVA.

In a telephone convseration on 8/4/2011 with Kate Gannon, permission was given to charge the \$130 fee under 37 CFR 1.17(i) to correct the inventorship. Please charge the fee to deposit account 19-0743.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

> /Eric D. Bertram/ Primary Examiner, Art Unit 3766



## UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Paper No.

MANYWORLDS, INC. 510 BERING DRIVE SUITE 470 (IP DEPARTMENT) HOUSTON TX 77057

MAILED

JAN 25 2012 OFFICE OF PETITIONS

In re Application of

Flinn et al.

DECISION ON PETITION

Application No. 11/381,314

Filed: May 2, 2006

Atty Docket No. MW-30

This is a decision on the PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b) filed December 29, 2011.

The above-identified application became abandoned for failure to file a reply to the final Office action mailed July 1, 2010. The Office action set a three (3) month shortened statutory period for reply, with extensions of time obtainable under 37 CFR 1.136(a). No reply having been received and no extensions of time obtained, the above-identified application became abandoned on October 2, 2010. A courtesy Notice of Abandonment was mailed on February 3, 2011.

Petitioner seeks revival solely for continuity purposes.

The petition is GRANTED.

The above-identified application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the application, the application is again abandoned in favor of the continuation application (No. 12/978,124), filed December 23, 2010.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3219.

Nahcy Johnson

Senior Petitions Attorney

Office of Petitions



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/06/2010

COMPUTER PATENT ANNUITIES 225 REINEKERS LANE SUITE 400 ALEXANDRIA, VA 22314

Applicant : Peter Stanley Nicola Rowe : DECISION ON REQUEST FOR Patent Number : 7655760

: RECALCULATION of PATENT Issue Date : 02/02/2010 : TERM ADJUSTMENT IN VIEW

**Application No:** 11/381,470 : OF WYETH AND NOTICE OF INTENT TO Filed : 05/03/2006 : ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

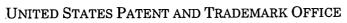
The patent term adjustment has been determined to be 634 days. The USPTO will sua sponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

IP GROUP OF DLA PIPER LLP (US) ONE LIBERTY PLACE 1650 MARKET ST, SUITE 4900 PHILADELPHIA PA 19103

MAILED
SEP 2 3 2010
OFFICE OF PETITIONS

In re Application of:

Paul Sharad TUSCANO et al.

Application No. 11/381,480 Filing Date: May 3, 2006

Attorney Docket No.: VWN-07-1429

**DECISION DISMISSING** 

PETITION UNDER

37 CFR § 1.183

This Decision is in response to the "Petition Under 37 C.F.R. § 1.183, filed December 15, 2009, to waive of the requirements of 37 CFR 1.131 to the extent that it requires that all of the named inventors execute the declaration filed there under.

## The petition is **dismissed**.

The application as-filed identified two inventors as the inventive entity: Paul Sharad Tuscano (Tuscano) and Jesse Elliott Money (Money). Applicant filed a Combined Declaration of Joint Inventors Under 37 CFR 1.131, executed by only Tuscano.

Applicant files the present petition and states that the inventor Money is unavailable to sign the Declaration under 37 CFR 1.131.

MPEP 715.04, Swearing back of Reference, Affidavit or Declarant Under 37 CFR 1.131, provides

The following parties may make an affidavit or declaration under 37 CFR 1.131: (A) All the inventors of the subject matter claimed.

- (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.
- (C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.
- (D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. Ex parte Foster, 1903 C.D. 213,

105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims.

Where one or more of the named inventors of the subject matter of the rejected claim(s) (who had originally signed the oath or declaration for patent application under 37 CFR 1.63) is now unavailable to sign an affidavit or declaration under 37 CFR 1.131, the affidavit or declaration under 37 CFR 1.131 may be signed by the remaining joint inventors provided a petition under 37 CFR 1.183 requesting waiver of the signature of the unavailable inventor be submitted with the affidavit or declaration under 37 CFR 1.131. Proof that the non-signing inventor is unavailable or cannot be found similar to the proof required for a petition under 37 CFR 1.47 must be submitted with the petition under 37 CFR 1.183 (see MPEP § 409.03(d)). Petitions under 37 CFR 1.183 are decided by the Office of Petitions (see MPEP § 1002.02(b)).

## MPEP 409.03(d) states:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See MPEP § 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

In discussing waiver requirements under 37 CFR 1.183, the Office is guided by proof similar to that required when an Applicant is unavailable. See MPEP 409.03(d), *supra*. In this instance, petitioner asserts that inventor Money is unavailable. However, the applicable statute (35 U.S.C.§ 116) requires that a "diligent effort" have been expended in attempting to find or reach the non-signing inventor. See MPEP 409.03(a). The showing currently fails to demonstrate, with

a documented showing, that a diligent effort was made to find or locate non-signing inventor Money, such that the declaration can be accepted. Where inability to find or locate a named inventor(s) is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made to locate the inventor.

Petitioner has not demonstrated that all efforts were expended in trying to locate inventor nonsigning Money. In this regard, petitioner should, at the very least, conduct a search of the regional or national registry(s). The results of such search should be made in any future petition for reconsideration. See MPEP 409.03(d). Additionally, petitioner should state whether he has access to inventor Money's personnel records and, if so, what does inspection of the records reveal as to a current address, forwarding address, or an address of the nearest living relative? What does inspection of the phone directories for those address locations reveal? Further, the petition fails to indicate that correspondence was ever mailed unsuccessfully to the inventor's last known address. Therefore, at the very least, petitioner should mail correspondence to the inventor's last known address, return receipt and/or forwarding address requested. If a forwarding address is provided, petitioner should then mail a complete copy of the application papers (specification, claims, drawings, oath, etc.) to Mr. Money's address, return receipt requested, along with a cover letter of instructions which includes a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. If the papers are returned and all other attempts to locate or reach the inventor, e.g., through personnel records, co-workers, E-mail, the Internet or the telephone, etc., continue to fail, then applicant will have established that the inventor cannot be reached after diligent effort or has refused to join in the application. The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein and should be accompanied by documentary evidence in support of the statement of facts. It is important that the forthcoming communication contain statements of fact as opposed to conclusions.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petition

Director for Patents P.O. Box 1450

Alexandria, VA 22313-1450

By FAX:

(571)273-8300

Attn: Office of Petitions

By hand:

**Customer Service Window** 

Mail Stop Petition Randolph Building 401 Dulany Street Alexandria, VA 22314 Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-7099.

Petitions Examiner
Office of Petitions

l

## UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

IP GROUP OF DLA PIPER LLP (US) ONE LIBERTY PLACE 1650 MARKET ST, SUITE 4900 PHILADELPHIA PA 19103 MAILED
AUG 0.4 2011
OFFICE OF PETITIONS

In re Application of

Paul Sharad TUSCANO, et al.

Application No. 11/381,480

Filed: May 3, 2006

Attorney Docket No. VWN-07-1429

**ON PETITION** 

This is in response to the renewed petition under 37 CFR 1.183, filed December 20, 2010, requesting waiver of the requirements of 37 CFR 1.131 to the extent that it requires that all of the named inventors execute the declaration filed thereunder.

The petition is granted to the extent infra.

Petitioner asserts that, while all of the named inventors contributed to the conception of the claimed invention which is under rejection, only Paul Sharad Tuscano has agreed to execute the declaration under 37 CFR 1.131 in support of establishing conception of the claimed invention prior to December 1, 2000.

As noted in MPEP 715.04, an adequate showing may lead to acceptance of a declaration under 37 CFR 1.131 executed by less than all of the named inventors of the claimed subject matter in question. Under the facts presented, it is agreed that justice requires waiver of the rules to the extent that they require Jessie Elliott Money to declare. However, the favorable decision herein does not relieve applicants from their burden to establish that the invention was completed before the date of the reference and that the claimed invention was the product of the joint inventors. See In re Carlson, 79 F.2d. 900, 27 USPQ 400 (CCPA 1935).

This application is being referred to Technology Center AU 1644 for further examination on the merits.

Telephone inquiries regarding this decision should be directed the undersigned at (571) 272-7099.

David Bucci Petitions Examiner Office of Petitions



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Paper No.

QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO CA 92121

MAILED

AUG 23 2011 OFFICE OF DE

In re Patent No. 7,962,725

Smith et al.

Application No. 11/381,545

Issue Date: June 14, 2011

Filed: May 4, 2006

Atty Docket No. 060207

: LETTER REGARDING

: PATENT TERM ADJUSTMENT

:

This decision is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed August 10, 2011, requesting that the patent term adjustment determination for the above-identified patent be changed from six (6) days to one hundred and twenty (120) days.

:

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one hundred and twenty (120) days is **DISMISSED**.

#### **BACKGROUND**

On June 14, 2011, the above-identified application matured into US Patent No. 7,962,725 with a patent term adjustment of 6 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent on August 10, 2011.

Patentee has indicated that this patent is not subject to a terminal disclaimer. 1

With this petition, Patentee argues that an additional 114 days of patent term adjustment is warranted; namely the period of time between the commencement of the over three-year period on May 4, 2009 (the over three-year period commences on May 5,

<sup>1</sup> Petition, page 2.

2009) and the filing of a notice of appeal on June 8, 2009 (35 days) and the period of time between the mailing of a notice of allowance on May 18, 2010 and the filing of a Request for Continued Examination (RCE) on August 6, 2010 (80 days). It is noted that this period of time totals 115 days, and not 114 days (perhaps Patentee did not mean to include the date on which the notice of appeal was filed?)

#### **OPINION**

Patentee's argument has been considered, and has been deemed to be unpersuasive.

A notice of appeal was filed on May 7, 2008, and a non-final Office action was mailed on September 22, 2008. The 139 days of the over three year period consumed by appellate review, beginning on May 7, 2008 and ending on September 22, 2008, is not included in the B delay. See 35 U.S.C. § 154(b)(1)(B)(ii). Similarly, a second notice of appeal was filed on June 8, 2009, and a notice of allowance was mailed on May 17, 2010. The 344 days of the over three year period consumed by appellate review, beginning on June 8, 2009 and ending on May 17, 2010, is not included in the B delay. It follows that the total appellate excluded period totals 483 (139 + 344) days.

As such, the patent term adjustment is increased by 6 (22 days of examination delay plus 0 "B-delay" (458 over three years minus the aforementioned excluded 483 days) minus 16 days of Applicant delay) days, not 120 days.

#### Conclusion

In view thereof, no adjustment to the patent term will be made. It follows that a certificate of correction is not required.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. § 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. § 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3225.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

<sup>&</sup>lt;sup>2</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

SMITH HOPEN, PA 180 PINE AVENUE NORTH OLDSMAR FL 34677

In re application of
Franca et al
Application No. 11/381,655
Filed: May 4, 2006
Attorney Docket No. 1673.03

**MAILED** 

AUG 1 9 2010
OFFICE OF PETITIONS

**NOTICE** 

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 on May 24, 2010.

The Office no longer investigates or rejects original or reissue patent under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3208.

/KOC/ Karen Creasy Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

MCKENNA LONG & ALDRIDGE LLP 1900 K STREET, NW WASHINGTON, DC 20006

MAILED

SEP 09 2010

OFFICE OF PETITIONS

In re Application of

Yuan-Sheng Tyan, et al.

Application No. 11/381,757

Filed: May 5, 2006 Attorney Docket No. 32200.91937.00 **DECISION GRANTING PETITION** 

UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed September 8, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on August 25, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.\(^1\)

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 2889 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement

/AMW/ April M. Wise Petitions Examiner Office of Petitions

<sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 2231-1450

COZEN O'CONNOR, P.C. 1900 MARKET STREET PHILADELPHIA PA 19103-3508

# **MAILED**

SEP 07 2010

In re Application of

OFFICE OF PETITIONS

Henning, et al.

.

Application No. 11/381,841

**DECISION ON PETITION** 

Filed/Deposited: 26 February, 2008

Attorney Docket No. 166034 SAR 605A

This is a decision on the petition (renewed) filed on 14 October, 2009, alternatively pursuant to the provisions of 37 C.F.R. §1.181 and 37 C.F.R. §1.182—and properly considered as a petition requesting that the instant application be accorded a filing date of 5 May, 2006, pursuant to/in view of the regulations at 37 C.F.R. §1.53; and finally, also seeking waiver of the rules under 37 C.F.R. §1.183.

The petition pursuant to the regulations at 37 C.F.R.:

- §1.181 for invocation of the supervisory authority of the Director is **DISMISSED**;
- §1.182, in view of the regulations at §1.53 is **DISMISSED**; and
- §1.183 for waiver of the regulations is **DISMISSED**.

The written record provides a clarity of events with greater particularity than might be obtained in colloquy. Thus, Interview is neither required nor authorized.

Petitioner is given TWO (2) MONTHS from the mail date of this decision to seek review. Any reply should be entitled "Request for Reconsideration of Petition Pursuant to 37 C.F.R. §1.182 (and/or §1.181 and/or §1.183) and §1.53."

In view of this third decision on petition, no extension of time will be available.

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

#### **BACKGROUND**

## The record reveals that:

- The submission on behalf of or by Petitioner toward the instant "application" was deposited on 5 May, 2006, at which time the Office issued an Electronic Acknowledgment Receipt reflecting receipt by the Office of a single document—a two-(2-) page Fee Worksheet—and fees.
- On 1 November, 2006, Petitioner filed into the record an information disclosure statement (IDS).
- On 26 February, 2008—twenty-one (21) months after the original to- (2-) page submission—Petitioner filed into the record: a two-page Power of Attorney; a two-page oath/declaration; 13 pages of specification, including therein one page of claims (composition) and a one-page abstract.
- On 28 February, 2008, the Office of Patent Application Processing (OPAP) mailed a Notice of Incomplete Application (the Notice) and indicated therein that the application as deposited on 5 May, 2006, had not been accorded a filing date (to wit: "the specification is missing \*\*\* the specification does not include at least one claim. A complete specification as prescribed by 35 U.S.C. §112 is required."). (The Notice also indicated that no fully executed oath/declaration was present on filing—however, this element was a "missing part" of the application and not controlling as to a filing date.) OPAP indicated that Petitioner might: contend via petition that the application was complete upon deposit, and so evidence that condition with the proper supporting documentation (i.e., a date stamped receipt card (see: MPEP §503; also: an acknowledgment receipt is a legal equivalent of a post card receipt described in the Manual of Patent Examining Procedure (MPEP), Section 503. See: 1315 OG 57; 72 Fed. Reg. 2770 (23 Jan 2007)) along with a copy of specification/claim(s)/drawings/figures; or submit a copy of the specification/claim(s)/drawings/figures and accept the date of that submission as the filing date. OIPE set a two- (2-) month period for reply
- On 29 February, 2008, the Office mailed a filing receipt according a filing date of 26 February, 2008, to the instant application.
- Thus, the application had not been accorded a filing date as 26 February, 2008—not of 5 May, 2006.
- On 3 March, 2008, Petitioner submitted a petition pursuant to the regulations at 37 C.F.R. §1.181, §1.182 and seeking waiver pursuant to 37 C.F.R. §1.183, including therewith, inter alia, an averment that the entire application was prepared by Petitioner and he directed his then-assistant (from whom there was no statement) to file the application. Petitioner acknowledged that he received a from the Office on 5 May, 2006, a two- (2-) page Electronic Acknowledgment Receipt that set forth an application number, statement

of fees received in the amount of \$1,000.00, and indication of a single file received identified as fee-info.pdf in a file size totaling but 8403 bytes and only two pages in length. The petition was dismissed on 30 September, 2008, for the reasons set forth in that decision.

• On 18 December, 2008, Petitioner resubmitted the petition pursuant to the regulations at 37 C.F.R. §1.181, §1.182 and seeking waiver pursuant to 37 C.F.R. §1.183, and two months later, on 3 February, 2009, Petitioner "supplemented" his petition with 38 pages of documents (including a three- (3-) page cover/transmittal letter and thirty-five (35) pages of documents) averred to have been obtained pursuant to a Freedom of Information Act (FIOA) (5 U.S.C. §552) request, and with Petitioner's averment that:

\*\*\*

the withheld documents may support applicants' position set forth in their Renewed Petition and Request for Reconsideration and it is hereby requested that the Office of Petitions obtain said withheld documents and redacted sections of the produced documents ....(sic)<sup>1</sup> (Emphasis supplied.)

\*\*\*

Thus, Petitioner—who had notice by virtue of the 5 May, 2006, Electronic Acknowledgement Receipt that he had submitted that date only a single two- (2-) page document, and had on 28 February, 2008, further notice of the incompleteness of the 5 May, 2006, submission—apparently delayed again until 18 December, 2008, to file a FIOA request, and when that dilatory request failed to produce any materials supportive of his contentions, Petitioner sought to place that responsibility upon the Office of Petitions. The petition was dismissed on 29 September, 2009, for the reasons set forth in that decision.

• On 14 October, 2009, Petitioner renewed for a second time his petition pursuant to the regulations at 37 C.F.R. §1.181, §1.182—again seeking waiver pursuant to 37 C.F.R. §1.183.

#### **ANALYSIS**

As becomes clear when one moves through a review of this matter, Petitioner's 14 October, 2009, 2 seven- (7-) page petition:

- First presented characterizations/representations of events and Office observations, and
- Then attempted to attack these Petitioner-constructed characterizations/representations.

The Supplement of 3 February, 2009, at page 2, second paragraph.

The petition of 14 October, 2009, carries with it four (4) pages of attachments.

Thus, Petitioner first constructed a series of straw men, and thereafter sought to knock them down.

## Item 1

To begin:

As to the 29 September, 2009, decision, Petitioner claimed in his 14 October, 2009, petition that:

I. The relevance of the documents submitted with the Supplemental Renewed Petition were (sic) not sufficiency (sic) explained.<sup>3</sup>

The record does not support the claim.

Petitioner's 18 December, 2008, petition itemized ten (10) arguments, and the Office responded to those ten (10) arguments.  $^4$  Specifically, the deficiencies in/failures of Petitioner's arguments were discussed and detailed at pages 6-15 of the 29 September, 2009, decision.

Certainly, it was of no support to Petitioner that he delayed for months, even years, in his FOIA inquiry, and then called upon the Office of Petitions to do his work for him.<sup>5</sup>

However, the Office observed at pages 2-3 of the 29 September, 2009, decision that:

- Petitioner's use of sarcasm in his 18 December, 2008, petition was inappropriate.
- Petitioner's 3 February, 2009, supplement with dozens of pages of piecemeal documents—obtained in his dilatory 28 October, 2008, FOIA inquiry and some of which regarded occurrences months away from Petitioner's March 2006 submission—was of no support to his arguments.

Thus, the determination was that the FOIA submission did nothing to assist Petitioner in his efforts—not that Petitioner's FOIA submission was unexplained.

Thus—in the first of Petitioner's straw men—what Petitioner said and what the record reflected were not the same.

The withheld documents may support applicants' position set forth in their Renewed Petition and Request for Reconsideration and it is hereby requested that the Office of Petitions obtain said withheld documents and redacted section of the produced documents, review them *in camera* and consider them in deciding the Renewed Petition and Request for Reconsideration.

Petition of 14 October, 2009, at page 2.

 $<sup>^4</sup>$  Decision of 29 September, 2009, inter alia, pages 6-15.

<sup>&</sup>lt;sup>5</sup> See: Supplement of 3 February, 2009, at page 2, last paragraph, to the Petition of 18 December, 2008, which states in pertinent part:

## Item 2

Again as to the 29 September, 2009, decision, Petitioner claimed in his in his 14 October, 2009, petition that:

II. Ms. Andress's narrative as to the events of 5 May 2006 or its absence was not sufficiently explained.<sup>6</sup>

The record demonstrates otherwise.

Petitioner's original petition, submitted on 3 March, 2008, stated:

Carolyn Andress, my assistant at the time \*\*\* was instructed by me on May 5, 2006 to file a new patent application via EFS \*\*\* .7

(Petitioner further averred that Ms. Andress was no longer with his firm.<sup>8</sup>)

The plain reading of the guidance as to compliance with Rules of Practice, inter alia, the regulations at 37 C.F.R. §1.181, §1.182 and §1.183 pursuant to which Petitioner sought relief. require the first person statements of those involved in events. (See: generally the showing requirements set forth at, inter alia, MPEP §1002, also as to rules seeking the review of the Director MPEP §711.03(c).)

Nonetheless, Petitioner's submissions of 18 December, 2008, and 14 October, 2009, suggested that surprise, consternation the statement of Ms. Andress was required and/or that any greater showing other than Petitioner's own statement was to be submitted. The record reflects that Petitioner provided no showing in this regard either:

- In his first petition submitted on 3 March, 2008; or
- In his second petition submitted on 18 December, 2008—even after being reminded at page 5 of the 30 September 2008, decision 10 as to the gap in his showing.

Petitioner provides no statement from Ms. Andress (whom Petitioner avers is the individual that performed the process under Petitioner's direction), who is the person with first-hand knowledge of the events/process in question.

Petition of 14 October, 2009, at page 2.

Petition of 3 March, 2008, at page 1, item 1.

<sup>&</sup>lt;sup>8</sup> Petition of 3 March, 2008, at page 1, item 1.

Petition of 18 December, 2008, at page 5, item 4.

<sup>&</sup>lt;sup>10</sup> The 30 September, 2008, decision stated at page 5:

Notably, the papers submitted with the most recent petition evidence that Petitioner failed to seek a statement from Ms. Andress until on or about 17 December, 2008—more than 31 months after Petitioner's 5 May, 2006, submission and more than two (2) months after the 30 September, 2008, decision on petition. Even then Petitioner did not make this request directly, but through his assistant.<sup>11</sup>

By contrast, Ms. Andress did not delay, but, rather, responded to the 17 December, 2008, request within two (2) hours, and stated (in pertinent part):

\*\*\*

I'm not sure that my signature would mean anything. I am not positive of the exact date I was assigned to Mike, do not know if I was actually working for him when this electronic mishap occurred (Dolly was assigned to him for a while, I believe), and I am not clear how my signature on a petition would help. <u>I do not remember filing anything for him electronically.</u> (Emphasis supplied.)

\*\*\*

Petitioner's 14 October, 2009, submissions demonstrate that it was another ten (10) months after his December 2008 inquiry to Ms. Andress before Petitioner contacted Ms. Andress again. Petitioner's submission evidences that he sent a message to her on 9 October, 2009.

Ms. Andress replied (*via* Petitioner's assistant) at 2:04 p.m to Petitioner's 1:04 p.m. 9 October, 2009, Email (her reply *in extenso*) that:

\*\*\*

Hi Pam:

Mr. Fein sent me another email today, text below

I am not running up my long-distance phone bill. There is nothing more to discuss.

I do not want him to call me. There is nothing more to discuss.

I have previously responded, <u>in detail</u>, to Mr. Fein's initial email. There is nothing more to discuss.

I do not understand why Mr. Fein continues to contact me about this matter. There is nothing more to discuss.

I do not have access to Cozen's patent docket or the hard copy files, and do not have access to any records to research for an answer.

<sup>11</sup> Pages 3 and 4 (of 4 pages) of attachment to the Petition of 14 October, 2009.

<sup>12</sup> Pages 3 and 4 (of 4 pages) of attachment to the Petition of 14 October, 2009.

I do not know what patent or client he is referencing.

I do not have access to the USPTO records.

I cannot help him. 13 /s/Carolyn (Emphasis supplied.)

\*\*\*

## Notably:

- Petitioner did not provide to the record/the Office a copy of Ms. Andress's detailed response, referenced by her, above. 14
- Over time Petitioner presented various statements as to events he averred involved Ms.
   Andress in this matter:
  - —Petitioner's first petition, submitted on 3 March, 2008, stated that: "Carolyn Andress, my assistant at the time \*\*\* was instructed by me on May 5, 2006 to file a new patent application via EFS \*\*\*. [Emphasis supplied.]
  - —Petitioner's statement in support of the 18 December, 2008, petition recalls the matter differently in that Petitioner states: "On May 5, 2006, <u>I supervised</u> my assistant Carolyn Andress regarding filing a new patent application, serial number 11/381,841, via the EFS \*\*\*. I recall actively participating in the filing process because I was training Ms. Andress \*\*\*." (Emphasis supplied.)
  - —Petitioner's 18 December, 2008, petition states that: "Mr. Fein supervised Ms. Andress and actively participated in the filing of the patent application serial number 11/381,841 via the EFS \*\*\*."
  - —Petitioner's 18 December, 2008, Email to Ms. Andress states (in pertinent part):

\*\*\*

I had previously done some experimentation and tried to learn the ins and outs of how to file applications, amendments, and assignments and then

<sup>13</sup> Page 1 (of 4 pages) of attachment to the Petition of 14 October, 2009.

Petitioners always are reminded that those registered to practice <u>must</u> inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose. <u>See</u> supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. <u>See Changes to Patent Practice and Procedure, 62 Fed. Reg.</u> at 53160 and 53178, 1203 <u>Off. Gaz. Pat. Office</u> at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Petition of 3 March, 2008, at page 1, item 1.

<sup>16</sup> Declaration of Michael B. Fein submitted in support of the 18 December, 2008, petition—at declaration page 1, item 3.

<sup>17</sup> Petition of 18 December, 2008, petition, page 5, item 4.

tried to pass on my knowledge to others, including you. This may have been one of the first applications we tried to file.

I'm not asking you to take the blame for this but would appreciate our being able to say you recall working together with me on filing applications using the new PTO electronic filing systems. \*\*\* I myself am not 100% sure of the specifics, but I do recall at least the part about me sitting in a chair right next to you or behind you while you were using your computer. 18 (Emphasis supplied.)

\*\*\*

• However, as noted above, when contacted in December 2008 about providing a statement, Ms. Andress responded that: "I am not positive of the exact date I was assigned to Mike, do not know if I was actually working for him when this electronic mishap occurred (Dolly was assigned to him for a while, I believe), and I am not clear how my signature on a petition would help. I do not remember filing anything for him electronically." (Emphasis supplied.)

Ms. Andress's 9 October, 2009, message makes clear her view that: "There is nothing more to discuss. I have previously responded, <u>in detail</u>, to Mr. Fein's initial email. There is nothing more to discuss."<sup>20</sup> (Emphasis supplied.)

While Petitioner asserts: "Ms. Andress's narrative as to the events of 5 May 2006 or its absence was not sufficiently explained[,]" the Office found in the earlier decisions that Petitioner provided:

- Neither a reasonable explanation for the historical absence of a statement by Ms. Andress
  in Petitioner's submissions of 3 March, 2008, and 18 December, 2008, in view of the
  Rules of Practice,
- Nor a reasonable and credible alternative to those statements in view of the variances and/or conflicts in the materials actually submitted.

Thus, the absence of the statements was <u>unsupported</u>—not insufficiently explained.

Complicating the matter for Petitioner was that his record of delay carried into most if not all of his actions with regard to the attentions to this matter between:

• The 5 May, 2006, submission, and

<sup>18</sup> Attachment to Petition of 18 December, 2008, at page 3 of 4.

Pages 3 and 4 (of 4 pages) of attachment to the Petition of 14 October, 2009.

Page 1 (of 4 pages) of attachment to the Petition of 14 October, 2009.

 At least Petitioner's 28 October, 2008, FIOA request and his 17 December, 2008, request to Ms. Andress.

Further—and more problematic for Petitioner—the documents finally made of record by Petitioner conflicted with Petitioner's statements such that Petitioner's filings revealed in each iteration stories and facts presented differing from that which went before.

Therefore—in the second of Petitioner's straw men—what Petitioner said and what the record reflected were not the same.

#### Item 3

Further as to the 29 September, 2009, decision, Petitioner claimed in his in his 14 October, 2009, petition that:

III. The delay in requesting, obtaining and submitting the FOIA documents was not sufficiently explained.<sup>21</sup>

The record does not support Petitioner's claim.

Petitioner stated that "Petitioner filed its (sic) FOIA request within one month of the September 30, 2008, dismissal of its (sic) petition. \*\*\* Petitioner did not know the original petition was insufficient and needed further support \*\*\*\*, 22

Contrary to Petitioner's statement, the decision of 29 September, 2009, was <u>not</u> founded upon Petitioner's clear delay in seeking to obtain evidentiary/documentary support for his submission, and the decision sought/required no explanation thereof.

Rather, the decision of 29 September, 2009, considered:

- The history (discussed above) of Petitioner's record of attention to this matter; and
- Petitioner's attempt to use results of his much-delayed FOIA request, which Petitioner sought to place of record to bolster his many unsupported statements.<sup>23</sup>

Thereafter Petitioner presented:

- unsupported suppositions as possible showings by documents redacted pursuant to statutory exclusions;
- unsupported statements that:

—un-redacted materials "support [Petitioner's] position that problem with the EFS system (sic) significantly contributed to the situation from which applicants petitioned";

Petition of 14 October, 2009, at page 2.

<sup>&</sup>lt;sup>22</sup> Petition of 14 October, 2009, at page 4.

<sup>&</sup>lt;sup>23</sup> The decision of 29 September, 2009, at pages 12 – 13, stated:

The decision of 29 September, 2009, considered these matters and the balance of the record, and found no support for Petitioner's statements with or without the FOIA submission(s).

The decision of 29 September, 2009, stated that:

\*\*\*

Petitioner either fails to provide a factual and a legal foundation and/or Petitioner speaks in generalities about events unrelated to his 5 May, 2006, submission in both time and context."<sup>24</sup>

\*\*\*

The decision also noted that:

\*\*\*

The documents submitted by Petitioner and averred to have been obtained pursuant to his 28 October, 2008, FOIA request address a group of some six applications that appear to have been filed together in October 2006—some five (5) months after Petitioner's incomplete filing."<sup>25</sup>

\*\*\*

Thus, even in view of Petitioner's submissions, what the record evidenced is that <u>after</u> 5 May, 2006, the date on which Petition averred he attempted to deposit the instant application, Petitioner failed to:

- Reasonably, timely and properly review the Electronic Acknowledgment Record;
- Look back upon that attempted deposit until at least late February 2008; and
- Satisfy the requirements of the Rules of Practice that an Applicant/Petitioner/Practitioner must provide documentary support for averments made.

Therefore, the evidence of record was/is that Petitioner—whose application this is:

<sup>—&</sup>quot;[t]here were enhancements made to the EFS-Web following the requested filing date of the present application

<sup>—&</sup>quot;Applicants believe that Exhibit A [the FOIA documents], the above discussion, and review of documents and redacted portions of documents withheld \*\*\*\* should be helpful to the Office of Petitions upon reconsideration of its dismissal of applicants' petition to assign [a 5 May, 2006,] filing date to their application."

The decision of 29 September, 2009, at pages 12 – 13.

The decision of 29 September, 2009, at pages 13.

- Did nothing of record with regard to this application between 5 May, 2006, and 26 February, 2008, save file an Information Disclosure Statement (IDS) on 1 November, 2006; and
- Even after filing a petition on 3 March, 2008, delayed almost eight (8) more months—until 28 October, 2008—to submit his FIOA request.

Now in the third of Petitioner's straw men, what Petitioner said and what the record reflected were not the same.

#### Item 4

Also, as to the 29 September, 2009, decision, Petitioner claimed in his 14 October, 2009, petition that:

IV. The failure to act when neither a Notice of Incomplete Application nor a Notice of Missing Parts was received from the USPTO ("Office") within the normal one to two weeks time from submitting an application which is incomplete or has missing parts was not sufficiently explained.<sup>26</sup>

The record does not support the claim.

#### Petitioner:

- By his own statement(s)—e.g., "\*\*\* neither a Notice of Incomplete Application nor a Notice of Missing Parts was received from the USPTO ('Office') within the normal one to two weeks time \*\*\*", 27 and
- As one registered to practice before the Office,

knew and/or determined and/or expected that he should receive from the Office a Notice, whether as to a Notice of Missing Parts and/or Incomplete Application, and/or a Filing Receipt within a short period after his 5 May, 2006, deposit. Nonetheless, Petitioner—whatever his reasons—ignored what he knew, determined and expected to be "the normal" process as to his application, the instant application.

The Office required of Petitioner no further explanation of his delay in attending to his application from 5 May, 2006, until 26 February 2008.

The utter silence of the record spoke and speaks to Petitioner's actions/inactions.

Petition of 14 October, 2009, at page 2.

Petition of 14 October, 2009, at page 2.

Thus, rather than a deficiency in Petitioner's showing in this matter, Petitioner quite simply made no showing.

As before, and in the fourth of Petitioner's straw men: What Petitioner said and what the record reflected were not the same.

## Item 5

With regard to the 29 September, 2009, decision, Petitioner further claimed in his in his 14 October, 2009, petition that:

V. Why the Electronic Application Receipt ("EAR") did not clearly suggest or infer no filing date was accorded was not sufficiently explained.<sup>28</sup>

The record does not support the claim.

Petitioner's argument is that he "did not prepare or file [the] fee document" reflected of record as his sole submission on 5 May, 2006.

That Petitioner did not formulate the page structure or content of the fee document <u>never</u> was at issue, and so controlling, in this matter.

From the outset what has been at issue and controlling is that—as Petitioner expressly acknowledges:

- "upon [his] authorization to charge [his] deposit account,"<sup>29</sup> the fee document was generated in the EFS system; and
- Petitioner received the Electronic Acknowledgement Receipt (EAR) that reflects only the submission of that fee document by Petitioner on 5 May, 2006.

In a pattern now familiar across the history of the matter and in its fifth iteration in the 14 October, 2009, petition, Petitioner made another claim—here that "the Office has effectively admitted" a defect occurring in and at the time of Petitioner's 5 May, 2006, submission.

As in the prior items—in the fifth of Petitioner's straw men--what Petitioner said and what the record reflected were not the same.

Petition of 14 October, 2009, at page 2.

Petition of 14 October, 2009, at page 5.

Petition of 14 October, 2009, at page 5.

## Item 6

With regard to the 29 September, 2009, decision, Petitioner further claimed in his in his 14 October, 2009, petition that:

VI. The reason why the admission of Office error by Ms. Stevens of OPAP must be accepted as true and controlling was not sufficiently explained.<sup>31</sup>

Once more, the record does not support the claim.

Petitioner claimed that "Ms. Margaret Stevens [(Ms. Stevens)] of the Office of Patent Processing \*\*\* called Petitioner and apologized for the USPTO's error in not mailing a Notice of Incomplete Application \*\*\*."<sup>32</sup>

#### It is noted that:

- In the first iteration of this story, Petitioner remembered/reported events only as a "conversation with Ms. Margaret Stevens of the USPTO Office of Patent Processing \*\*\*." —and Petitioner did not state at that time who was supposed to have had the conversation with Ms. Stevens; and
- In another telling of events, Petitioner reported a conversation with Ms. Stevens as "an admission an officer of the PTO \*\*\* ."<sup>34</sup> (Emphasis supplied.)

In his most recent iteration of the story, Petitioner asserts that "[i]f the Office of Petitions would contact [Ms. Stevens], Petitioner believes she would confirm that failure to mail a Notice of Incomplete Application."<sup>35</sup>

In that single sentence, Petitioner misperceives:

- Not only what elements <u>are and are not</u> in question in this matter;<sup>36</sup>
- But also <u>his</u> responsibility—as one registered to practice before the Office—to timely and properly inquire, and then to present to the Office the results of that inquiry.<sup>37</sup>

Whether or not a Notice was mailed on or until some date is <u>not</u> in question in this matter—the record evidences what papers were and were not mailed and when.

Petition of 14 October, 2009, at page 3.

Petition of 18 December, 2008, at page 3, second paragraph.

Petition of 3 March, 2008, at page 3, Item 8.

Petition of 18 December, 2008, at page 6, Item 8.

Petition of 14 October, 2009, at page 6, last paragraph.

Petition of 14 October, 2009, at page 6, last paragraph.

Petition of 14 October, 2009, at page 6, last paragraph.

Nor is it the responsibility of the Office to undertake Petitioner's duties of:

- Timely and proper inquiry; and
- Candor in reporting.

The record reflects that, save for his own statement(s), Petitioner failed to present in each of his three petitions a first-person statement of anyone averred to have been involved in this matter.

Moreover, save for the much-delayed inquiries—in December 2008 and October 2009—to Ms. Andress, Petitioner never reported or demonstrated the effort to obtain any first-person statements.

Yet the record reflects that Petitioner averred conversations to have taken place months or even years earlier—and without benefit of a single supporting statement—not only with Ms. Stevens, but also with Messrs. Tony Uranga, Koontz (no first name given) and Jeffrey Wong.<sup>38</sup>

In conflict with the title that Petitioner's set forth for the subject area<sup>39</sup> of this element of his 14 October, 2009, petition <u>and</u> in contrast with his argument,<sup>40</sup> the review of the record evidences that Petitioner's effort in this element of his petition was not to argue "why the admission of Office error by Ms. Stevens of OPAP must be accepted as true and controlling was not sufficiently explained."<sup>41</sup>

Rather, what Petitioner demanded in his papers was that the Office accept that:

- Petitioner's version of someone's conversation with a third party—here, Ms. Stevens—be a controlling fact in a determination of this matter;<sup>42</sup> and
- The latest version of Petitioner's telling of such otherwise undocumented conversation must be controlling in determining the facts of this matter<sup>43</sup>—notwithstanding the conflicts and/or embellishments in versions/iterations of those reported conversations and/or between versions/iterations of reported conversations and documents placed of record by Petitioner.

Petitioner well knows that his demand is not appropriate. Petitioner, as one registered to practice before the Office is aware that:

Declaration of Michael B. Fein, pages 3 – 4, Items 11 – 13, accompanying Petition of 18 December, 2008.

<sup>39</sup> Petition of 14 October, 2009, at page 3.

<sup>40</sup> Petition of 14 October, 2009, at page 6 - 7.

Petition of 14 October, 2009, at page 3.

Petition of 14 October, 2009, at page 6 - 7.

Petition of 14 October, 2009, at page 6 - 7.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.<sup>44</sup>

This is the <u>substance</u> of the regulations at 37 C.F.R. §1.4.

If Petitioner held conversations with Office personnel in lieu of written communications, it was incumbent upon Petitioner to ensure a timely recording of the date, time, parties to and substance of such conversations. (See: inter alia, MPEP §713.04.)

Once again, the utter silence of the record in this regard spoke and speaks to Petitioner's actions/inactions—*e,g.*, Petitioner's compliance, or not, with the Rules of Practice and the guidance in the Commentary in the Manual of Patent Examining Procedure (MPEP) (*e.g.*, at MPEP §713.04).

The Rules of Practice e.g., 37 C.F.R. §1.2 and the guidance in the Commentary in the MPEP provide protections and benefits for applicants and practitioners. However, those protections and benefits are not available when applicants and practitioners do not comply with/follow those rules.

Thus, as before, in the sixth of Petitioner's straw men what Petitioner said and what the record reflected were not the same.

## As to Waiver

The regulations at 37 C.F.R. §1.183 are clear as to the conditions required for their invocation:

## §1.183 Suspension of rules.

<u>In an extraordinary situation</u>, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in §1.17(f). (Emphasis supplied.)

The regulations at 37 C.F.R. §1.2 provide:1

<sup>§1.2</sup> Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

Petitioner's failure to: (a) review the Electronic Acknowledgment Receipt when received on 5 May, 2006, and (b) inquire into the matter for some twenty-two (22) months does not create an "extraordinary situation."

It would be easy, even if accurate, to suggest that Petitioner's successive submissions in this matter—from that of 5 May, 2006, through the successive petitions of 3 March, 2008, then 12 December, 2008 (with the Supplement of 3 February, 2009), and that of 14 October, 2009—have carried with them the undeniable, even if not explicit, statement that the statutes (35 U.S.C.), the Rules of Practice (37 C.F.R.) and the policy/guidance in the Commentary of the Manual of Patent Examining Procedure (MPEP) applied to all ... save Petitioner.

However, as demonstrated above the record herein provides far more than simplistic—if accurate—statements to support a conclusion in this matter.

A petition to the Director under 37 C.F.R. §1.181<sup>45</sup> is available for review of an action and/or requirement where a statute/rule specify that the Director is to determine the matter, <u>or</u> to invoke the supervisory authority of the Director.

A petition under 37 C.F.R. §1.182<sup>46</sup> is appropriate in the absence of relief available under other regulatory provision—such as a petition under 37 C.F.R. §1.53 or alternatives as indicated in the 28 February, 2008, Notice.

#### § 1.181 Petition to the Director.

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
- (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.
- (b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.
- (c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.
- (d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.
- (e) Oral hearing will not be granted except when considered necessary by the Director.

2003, effective May 1, 2003; para. (a)(3) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.
(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions. [24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; paras. (d) and (g), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; paras. (a), (a)(2)-(3), (c)-(e) & (g) revised, 68 FR 14332, Mar. 25,

46 The regulations at 37 C.F.R. §1.182 provide:

#### § 1.182 Questions not specifically provided for.

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be

<sup>&</sup>lt;sup>45</sup> The regulations at 37 C.F.R. §1.181 provide:

The regulations at 37 C.F.R. §1.183 are clear and unambiguous as to the conditions required for their invocation to suspend the rules, to wit: "an extraordinary situation, when justice requires."

The record evidences that Petitioner:

- Has neither complied with the regulations, nor followed the guidance in the Commentary in the MPEP.
- Was dilatory in his attention to the instant application and in whatever efforts he did make to inquire.
- Has made showings that were/are inconsistent and/or conflicting.

Therefore, for the third time Petitioner has provided no authority for:

- Relief pursuant to the regulations at 37 C.F.R. §1.181; or
- Relief pursuant to the regulations at 37 C.F.R. §1.182 in view of the regulations at §1.53;
   and/or
- Waiver of regulations pursuant to the regulations at 37 C.F.R. §1.183.

Thus, as of this writing, the Notice mailed on 28 February, 2008, is not determined to be in error and will not be disturbed.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.<sup>47</sup>

communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). [47 FR 41278, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

<sup>47 &</sup>lt;u>See</u> supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. <u>See Changes to Patent Practice and Procedure</u>, 62 <u>Fed. Reg.</u> at 53160 and 53178, 1203 <u>Off. Gaz. Pat. Office</u> at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

#### CONCLUSION

Accordingly, the petition pursuant to the regulations at 37 C.F.R.:

- §1.181 for invocation of the supervisory authority of the Director is dismissed;
- §1.182 in view of the regulations at 37 C.F.R. §1.53 is dismissed; and
- §1.183 for waiver of the regulations is **dismissed**.

For a third time, this application is released to OPAP for further processing consistent with this decision, including the designation of 26 February, 2008 (the date of Petitioner's acknowledged deposit of the specification (description, claims and abstract), as the filing date of the application—and thereafter released to the Technology Center for further processing in due course.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2<sup>48</sup>) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's/Caller's action(s).

/John J. Gillon, Jr/.

John J. Gillon, Jr.

Senior Attorney

Office of Petitions

The regulations at 37 C.F.R. §1.2 provide:1

<sup>§1.2</sup> Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.



#### UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

COZEN O'CONNOR, P.C. 1900 MARKET STREET PHILADELPHIA PA 19103-3508 MAILED
AUG 2 3 2011
OFFICE OF PETITIONS

In re Application of

Henning, et al.

mulication No. 11/201 041

Application No. 11/381,841

Filed/Deposited: 26 February 2008

Attorney Docket No. 166034 SAR 605A

DECISION ON PETITION

This is a decision on the petition (thrice renewed) filed on 4 November 2010, alternatively pursuant to the provisions of 37 CFR §1.181 and 37 CFR §1.182—and properly considered as a petition requesting that the instant application be accorded a filing date of 5 May 2006, in view of the regulations at 37 CFR §1.53; and finally, also seeking waiver of the rules under 37 CFR §1.183.

The petition under 37 CFR §1.181 for invocation of the supervisory authority of the Director is **granted to the extent indicated** in that a review has been made of the file. However, petitioners' request for an earlier filing date under 37 CFR 1.53 is **DENIED**;

The petition under 37 CFR §1.182 is **DENIED**; and

The petition under 37 CFR §1.183 is **DENIED**.

This is a **final agency action** within the meaning of 5 USC §704.

#### **BACKGROUND**

#### The record herein reveals:

Petitioners acknowledged that on 5 May 2006, a single document (a two-page, Fee Worksheet) and corresponding fees were deposited with the United States Patent and Trademark Office (the Office) via the Office's electronic filing system (referred to herein as EFS or EFS web). At that time, the Office issued an Electronic Acknowledgment Receipt that reflected receipt by the Office of that document and the associated fees.

Petitioners took no action until 1 November 2006, at which time Petitioners filed into the record an information disclosure statement (IDS). On 26 February 2008, twenty-one (21) months after the original two-page submission, Petitioners filed into the record: a two-page Power of Attorney; a two-page oath/declaration; 13 pages of specification, including therein one page of claims and a one-page abstract.

On 28 February 2008, the Office of Patent Application Processing (OPAP) mailed a Notice of Incomplete Application (the Notice) and indicated therein that the papers as deposited on 5 May 2006, had not been accorded a filing date (to wit: "the specification is missing \*\*\* the specification does not include at least one claim. A complete specification as prescribed by 35 USC §112 is required."). (The Notice also indicated that no fully executed oath/declaration was present on filing—however, this element was a "missing part" of the application and not controlling as to a filing date.) OPAP indicated that Petitioners might:

- 1) Accept February 26, 2008 as the filing date of the application;
- 2) Petition that the items necessary to accord a filing date were previously submitted; or
- 3) Petition for an earlier filing date by relying upon an incorporation by reference to a previously filed copending application under 37 CFR 1.57.

OPAP set a two-month period for reply.

On 29 February 2008, the Office mailed a filing receipt according a filing date of 26 February 2008, to the instant application. Thus, the application had been accorded a filing date as 26 February 2008—not of 5 May 2006.

On 3 March 2008, Petitioners submitted a petition pursuant to the regulations at 37 CFR §1.181, §1.182 and seeking waiver pursuant to 37 CFR §1.183, including therewith, *inter alia*, an averment that the entire application was prepared by the attorney of record and he directed his then-assistant to file the application. Petitioners' attorney acknowledged that he received from the Office on 5 May 2006, a two-page Electronic Acknowledgment Receipt that set forth an application number, statement of fees received in the amount of \$1,000.00, and indication of a single file received identified as fee-info.pdf in a file size totaling but 8403 bytes and only two pages in length.

The petition was dismissed on 30 September 2008, for failing to make the showings required.

On 18 December 2008, Petitioners resubmitted a petition pursuant to the regulations at 37 CFR §1.181, §1.182 and sought waiver pursuant to 37 CFR §1.183. The petition was dismissed on 29 September 2009, for failing to make the showings required.

On 14 October 2009, Petitioners renewed the petition pursuant to the regulations at 37 CFR §1.181 and §1.182, and also sought waiver pursuant to 37 CFR §1.183. However, Petitioners made no new showing in any of these regards. The petition was dismissed on 7 September 2010, for failing to make the showings required.

Petitioners renewed the petition on 4 November 2010, and presented the following four (4) arguments:

- 1. "THE OFFICE FAILED TO FOLLOW ITS OWN RULES AT A CRUCIAL PHASE"
- 2. "A DESIGN FLAW IN THE ELECTRONIC FILING SYSTEM WAS A FACTOR CAUSING APPLICANTS' ATTORNEY TO BE MISLED."
- 3. "ACCEPTANCE OF DOCUMENTS FILED SUBSEQUENT TO ORIGINAL FILING DATE VIA EFS IMPLIED TO APPLICANTS' ATTORNEY THAT ORIGINAL FILING DATE WAS VALID."
- 4. "APPLICANTS WERE DILIGENT IN PETITIONING FOR THE FILING DATE AND AT ALL TIMES DURING THE PETIITON PROCESS."

# STATUTE, RULES AND PROCEDURE

# 35 USC 111(a)(4)

(4) FAILURE TO SUBMIT.—Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

# 37 CFR 1.53(a) and (b)

- (a) Application number. Any papers received in the Patent and Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes.
- (b) Application filing requirements Nonprovisional application. The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 USC 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a

continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 USC 120, 121 or 365(c) and § 1.78(a).

# 37 CFR 1.181(a)(1)

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court

# 37 CFR 1.182

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

# 37 CFR 1.183

In an extraordinary situation, when justice re-quires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

#### 1286 Official Gazette 113, September 17, 2004

C. At the USPTO, the electronic files are checked for technical compliance, virus infection and integrity. Under normal circumstances, the digital signature (part of the public key infrastructure (PKI)) on the document package will prove valid, thus assuring that the files were not altered from the time they were signed. An electronic Acknowledgement Receipt including the Application Number and a Confirmation Number will be produced and sent securely to the applicant as proof of a successful submission. The Acknowledgement Receipt also lists the files received by the USPTO with the name and the size of each file, and includes a unique Message Digest code that is derived from the submission. The applicant will retain this Acknowledgement Receipt as clear evidence that on the date noted the files were successfully received by the USPTO. The Acknowledgement Receipt serves as an "Electronic Post Card" and is assurance to the applicant in the event evidence of filing is ever needed.

An electronic Acknowledgement Receipt, however, does not guarantee that the application meets all the USPTO requirements for a filing date. For example, if a non-provisional application submission does not include required claims, the filing date will be granted when this omission is corrected by applicant.

. . .

What is the force and effect of the Acknowledgement Receipt sent by the USPTO under the EFS?

The electronic Acknowledgement Receipt is not the official filing receipt for the application. The paper Filing Receipt (37 CFR Sec. 1.54), PTO Form-103X, is sent after printing the application in step 8 in Attachment 1 below, and reviewing the submitted application parts for compliance with 35 USC Sec. 111 filing date requirements and will indicate the official filing date. However, the Acknowledgement Receipt establishes the date of successful submission of the associated documents, and is thus a crucial part of the application process in establishing the applicant's filing date.

What is the value of the Acknowledgement Receipt if a problem occurs?

If the printed version of any document received by the EFS is unreadable, and if it cannot be recovered from the stored files received by electronic submission, then the applicant will be promptly notified by phone, fax or e-mail as indicated in the EFS instructions. Even with prompt processing, if the volume of submissions is high the Office review may take place a few days or weeks later. If an error occurs and the application cannot be reconstructed, the applicant may have to resubmit the application and petition for the original filing date. Such events are expected to be rare. Under this scenario, the applicant would present 1) the Acknowledgement Receipt, 2) a paper version and an electronic version (on floppy disk or CD-R) of the files as submitted and 3) a petition verifying that the attached files are the same as mentioned in the Acknowledgement Receipt for that application number. The Acknowledgement Receipt will establish that the resubmitted documents were exactly those submitted on the date of receipt.

What is the date of receipt of an application received under the EFS?

The application's "date of receipt" is the date that it is fully and successfully received at the USPTO, as shown on the Acknowledgement Receipt. The date at the USPTO is controlling for the purposes of original patent applications. There is no "certificate of transmission" practice for non-provisional or provisional application e-filings (37 CFR 1.8). However, because of the automated processes involved, applicants can usually "see" their submissions over the Internet in the

Private PAIR (Patent Application Information Retrieval) system a short time after submission, which is a significant reassurance of successful receipt.

### **DECISION**

# 37 CFR 1.181 and 37 CFR 1.53

As to Petitioners' contention that the office failed to follow its own rules at a crucial phase is not supported by the record.

The record is clear—and Petitioners do not dispute—that immediately upon the 5 May 2006, deposit of the single a two- page Fee Worksheet and fees, the Office issued and Petitioners received an Electronic Acknowledgment Receipt reflecting receipt by the Office of the Fee Worksheet and the fees. No other items were deposited and no other items were listed on the Electronic Acknowledgment Receipt.

Notwithstanding the attempt, Petitioners cannot burden the Office with their own failure to consider the content of the 5 May 2006, Electronic Acknowledgement Receipt, which stated Petitioners' payment of \$1,000.00 and specified only one document received by the Office from Petitioners as follows:

Document	Document	File	File Size	Multi	
Number	Description	Name	(Bytes)	Part	<u>Pages</u>
1	Fee Worksheet (PTO-875)	fee-info.pdf	8403	no	2

Having already indicated that Petitioners received the Electronic Acknowledgment Receipt on 5 May 2006, Petitioners nonetheless complain that the failure to receive further Notice from the Office was prejudicial and that they "did not have a timely opportunity to correct the problem of missing specification and claims". This is a complaint with which Petitioners persisted across the years, though it was Petitioners and not the Office that failed to attend properly from 5 May 2006, and thereafter to the submission of application materials on 26 February 2008. Whether a Notice of Incomplete Application is normally mailed within 4 – 6 weeks is irrelevant since a receipt was given to petitioners upon submission of the documents on 5 May 2006.

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).

Petitioners contend that a design flaw existed in the electronic filing system and was a factor causing applicants' attorney to be misled. The record does not support this claim. Applicants received a receipt that indicated what documents were received. Further, petitioners had access to private PAIR and thus could review the contents of the file wrapper at any time electronically. Petitioners' failure to review the receipt or to access private PAIR does not relieve petitioners of the legal requirement of submitting the application (specification, claims and drawing if necessary to understand the invention) to the US Patent and Trademark Office. As is clear from the record, no actions were taken by the Office to misled applicants as to the true nature of this case.

# Petitioners argue that:

The electronic filing system (EFS) was in its infancy at the time this application was filed and the USPTO was trying to encourage applicants to use it rather than the "legacy" system of Express Mailing a patent application with a postcard listing the documents which were Express Mailed. Attorneys were trying to learn how the ES system worked and could be used at the time, and were also trying to train staff to use the system and it worked.

This argument is without merit. At the time the original document was submitted, the procedure for filing via EFS web was set forth in the Official Gazette at 1286 *Off. Gaz. Pat. Office* 113 (17 September 2004):

An electronic Acknowledgement Receipt including the Application Number and a Confirmation Number will be produced and sent securely to the applicant as proof of a successful submission. The Acknowledgement Receipt also lists the files received by the USPTO with the name and the size of each file, and includes a unique Message Digest code that is derived from the submission. The applicant will retain this Acknowledgement Receipt as clear evidence that on the date noted the files were successfully received by the USPTO. The Acknowledgement Receipt serves as an "Electronic Post Card" and is assurance to the applicant in the event evidence of filing is ever needed.

An electronic Acknowledgement Receipt, however, does not guarantee that the application meets all the USPTO requirements for a filing date. For example, if a non-provisional application submission does not include required claims, the filing date will be granted when this omission is corrected by applicant. (Underlining added).

From the inception of the EFS filing system, applicants were instructed to review the acknowledgement receipt received when submitting documents via EFS web. Further, a filing date for applications submitted via EFS web can only be accorded as of the date all requirements of 35 USC 111(a)(4) have been met. In this instance the filing requirements of 35 USC 111(a)(4) were met 26 February 2008.

Petitioners contend that acceptance of documents filed subsequent to original filing date via EFS implied to applicants' attorney that the original filing date was valid. The record does not support this claim.

# Petitioners argued:

An additional error on the part of the EFS was to have accepted subsequent papers filed under the assigned serial number, namely an assignment was recorded and an IDS was filed and accepted. Petitioners respectfully suggest that it was reasonable to rely on the fact that subsequent papers were accepted for the belief that the application was properly filed.

In answer to this argument, first, an assignment is properly filed with the Assignment Branch and is not part of the patent application. Thus the fact that an assignment document was accepted has no bearing on the filing requirements of a patent application. The recording of an assignment document is a ministerial act, see Manual of Patent Examining Procedure (MPEP) 301(V), and such assignments are not placed in the application file, MPEP 318. Thus acceptance of an assignment does not prove the filing of an application.

Moreover, whether an application number is assigned to the papers is not indicative of whether the papers are in fact an application. In accordance with 37 CFR 1.53(a), "Any papers received in the Patent and Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes." Thus the assignment of an application number is not demonstrative of an application having been filed.

Finally, it is not necessary to address the question of diligence in this matter given the basis for this decision.

#### 37 CFR 1.182

A petition under 37 CFR §1.182 is appropriate in the absence of relief being available under another regulatory provision—such as a petition under 37 CFR §1.53 or alternatives as indicated in the Notice mailed 28 February 2008. Accordingly, the petition under 37 CFR 1.182 is denied.

# 37 CFR 1.183

In order to submit a grantable petition pursuant to 37 CFR § 1.183, Petitioners must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985). Petitioners have not established, *or even asserted*, that either condition exists in this case. The circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rules. Moreover, Petitioners have not set forth which Rule they wishes suspended. In fact, it is not a rule that would be required to be suspended but 35 USC 111(a), the statute. The USPTO is without authority to waive the statute.

The regulations at 37 CFR §1.183 is clear and unambiguous as to the conditions required for their invocation to suspend the rules, to wit: "an extraordinary situation, when justice requires." Petitioners' failure to: (a) review the Electronic Acknowledgment Receipt when received on 5 May 2006, and (b) inquire into the matter for some twenty-two (22) months does not create an "extraordinary situation."

Assuming for arguments sake <u>only</u> that the USPTO could suspend the requirement, it should not relax the requirements of established practice to save an applicant from the consequences of his delay. See *Ex Parte Sassin*, 1906 Dec. Comm'r. Pat 205, 206 (Comm'r Pat. 1906) and <u>compare Ziegler v. Baxter v. Natta</u>, 159 USPQ 378, 379 (Comm'r Pat. 1968). Circumstances resulting from applicant's or applicant's counsel's failure to exercise due care or to properly apply the patent statutes or rules of practice are not extraordinary circumstances where the interest of justice require the granting of relief. See *In re Tetraflour, Inc.*, 17 USPQ2d 1160, 1162 (Comm'r Pat. 1990). Accordingly, petitioners have not provided an adequate showing of "an extraordinary situation" in which "justice requires" suspension of the requirement for a complete application upon filing. See generally *Nitto Chem. Indus. Co. v. Comer*, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers).

#### CONCLUSION

The petition under 37 CFR §1.181 for invocation of the supervisory authority of the Director is **granted to the extent indicated** in that a review has been made of the file. However, petitioners' request for an earlier filing date under 37 CFR 1.53 is **DENIED**;

The petition under 37 CFR §1.182 is **DENIED**; and

The petition under 37 CFR §1.183 is **DENIED**.

This decision is a final agency action within the meaning of 5 USC §704 for purposes of seeking judicial review. Telephone inquiries regarding this decision may be directed to John J. Gillon, Jr. at (571) 272-3214.

This application is released to the Technology Center for further processing in due course.

Anthony Knigh Director

Office of Petition

# SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 20110318

**DATE** : 3/14/11

TO SPE OF : ART UNIT 2628

SUBJECT : Request for Certificate of Correction for Appl. No.: 11381853 Patent No.: 7868898

CofC mailroom date: 03/03/11

Please respond to this request for a certificate of correction within 7 days.

#### **FOR IFW FILES:**

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

#### **FOR PAPER FILES:**

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC) Randolph Square – 9D10-A Palm Location 7580

You can lax the Directors SPE response to 571-270-9990

Lamonte Newsome

Certificates of Correction Branch

<u>571-272-3421</u>

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

Denied

Approved All changes apply.

Approved in Part Specify below which changes do not apply.

Comments: \_\_\_\_\_\_ The request for correction is actually just putting claim 13

in the form that was agreed upon as being allowable. See claim 8 of the claim set submitted 4/14/10

and claim 8 of the Examiner's amendment mailed 7/12/10. Published claim 13 should not have included

the language 'image data including pixels having' in the first place,

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

State the reasons for denial below.

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SPE RESPON	NSE FOR CERTIFICATE OF CORRECTION	
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PTOL-306 (REV. 7/03)	SPE Ar U.S. DEPARTMENT OF COMMERCE Patent and	t Unit Trademark Office



#### SPE RESPONSE FOR CERTIFICATE OF CORRECTION

	SEL RESPONSE FOR CEI	THE TOTAL CONTROL OF THE TOTAL
DATE	: <u>12/21/10</u>	Paper No.:
TO SPE OF	: ART UNIT	
SUBJECT	: Request for Certificate of Correction for	Appl. No.: 11/381.970 Patent No.: 7,798,096
		CofC mailroom date: 12/15/10
Please resp	pond to this request for a certificate	e of correction within 7 days.
FOR IFW F	FILES:	
the IFW ap	ew the requested changes/correct plication image. No new matter sh the claims be changed.	ons as shown in the <b>COCIN</b> document(s) in could be introduced, nor should the scope or
Please con using docu	nplete the response (see below) arment code <b>COCX</b> .	d forward the completed response to scanning
FOR PAPE	R FILES:	
Please revi correction.	ew the requested changes/correcti Please complete this form (see be	ons as shown in the attached certificate of elow) and forward it with the file to:
•		
Rand	ificates of Correction Branch (Co dolph Square – 9D10-A n Location 7580	ofC)
Rand	dolph Square – 9D10-A	RoChaun Johnson
Rand	dolph Square – 9D10-A	RoChaun Johnson Certificates of Correction Branch
Rand Palm	dolph Square – 9D10-A n Location 7580	RoChaun Johnson
Rand Pain Thank You The reques	dolph Square – 9D10-A	RoChaun Johnson Certificates of Correction Branch 703-756-1580
Thank You  The reques	dolph Square – 9D10-A n Location 7580 For Your Assistance st for issuing the above-identified	RoChaun Johnson Certificates of Correction Branch 703-756-1580
Thank You The reques	dolph Square – 9D10-A n Location 7580  For Your Assistance st for issuing the above-identified on on the appropriate box.	RoChaun Johnson Certificates of Correction Branch 703-756-1580 d correction(s) is hereby:
Thank You The reques Note your decision	dolph Square – 9D10-A n Location 7580  For Your Assistance st for issuing the above-identified on on the appropriate box.	RoChaun Johnson Certificates of Correction Branch 703-756-1580  d correction(s) is hereby: All changes apply.
Thank You The reques Note your decision	dolph Square – 9D10-A n Location 7580  For Your Assistance st for issuing the above-identified on on the appropriate box.  Approved Approved in Part Denied	RoChaun Johnson Certificates of Correction Branch 703-756-1580  d correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.
Thank You The reques Note your decision X Comments	dolph Square – 9D10-A n Location 7580  For Your Assistance St for issuing the above-identified on on the appropriate box.  Approved Approved Approved in Part Denied  The inventor name in the publica	RoChaun Johnson Certificates of Correction Branch 703-756-1580  d correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.
Thank You The reques Note your decision  X  Comments al) as cited	dolph Square – 9D10-A n Location 7580  For Your Assistance St for issuing the above-identified on on the appropriate box.  Approved Approved Approved in Part Denied  The inventor name in the publica	RoChaun Johnson Certificates of Correction Branch 703-756-1580  d correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.  tion (2004/0046197 A1 3/2004 Verplancken et rection" does not match with the actual
Thank You The reques Note your decision  X  Comments al) as cited	dolph Square – 9D10-A n Location 7580  For Your Assistance st for issuing the above-identified on on the appropriate box.  Approved Approved in Part Denied The inventor name in the publication the "request for certificate of cortinate of cortinate in the publication the "request for certificate of cortinate in the "request for certifi	RoChaun Johnson Certificates of Correction Branch 703-756-1580  d correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.  tion (2004/0046197 A1 3/2004 Verplancken et rection" does not match with the actual

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

<u>/</u>1716/\_\_

/Parviz Hassanzadeh/

SPE

11/381970



UNITED STATES DEPARTMENT OF COMMERCE Patent and Trademark Office
ASSISTANT SECRETARY OF COMMERCE AND COMMISSIONER OF PATENTS AND TRADEMARKS P.O. BOX 1450

Alexandria, Va 22313- 1450 www.uspto.gov.

DATE: December 27, 2010
Patent No: 7798096 B2

Applicant: Mahajani et al

Issued: September 21, 2010

Request for consideration of Certificate of Correction:

Consideration has been given for your request for the certificate of correction for the above-identified patent under the provisions of Rules 1.322/1.323.

Respecting the alleged error on the title page in the References Cited are printed in accordance with the record. The Examiner stated the inventor name in the publication as cited in the "request for certificate of correction" does not match with the actual inventor name as shown in the cited publication. Therefore, no correction(s) are in order here under United States Codes (U.S.C.) 254 Code of Federal Regulation (C.F.R.) 1.322/1.323.

In view of the foregoing, in this matter your request is hereby denied.

RoChaun Johnson for Mary Diggs, Supervisor Decisions and Certificates of Correction (571) 272-0470

KEITH TACKETT
PATTERSON & SHERIDAN L.L.P
3040 POST OAK BLVD. SUITE 1500
HOUSTON, TX 77056



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DAVID LEWIS 1250 AVIATION AVE., SUITE 200B SAN JOSE, CA 95110

MAILED

AUG 27 2010

In re Application of Swetha Venkatahcalapathy

Application No. 11/382,029

Filed: May 6, 2006

Attorney Docket No. 33-2

OFFICE OF PETITIONS

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 5, 2010, to revive the above-identified application.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, January 29, 2010, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on April 30, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of \$810, and (3) a proper statement of unintentional delay.

In view of the above, the petition is GRANTED.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 2618 for appropriate action by the Examiner in the normal course of business on the reply received August 5, 2010.

April M. Wise

Petitions Examiner

Office of Petitions



COMMISSIONER FOR PATENTES
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

JOSHUA D. ISENBERG JDI PATENT 809 CORPORATE WAY FREMONT CA 94539 MAILED

JAN 0 4 2011

OFFICE OF PETITIONS

In re Application of

Gary M. Zalewski et al

Application No. 11/382,031

Filed: May 6, 2006

Attorney Docket No. SCEA06013US00

**DECISION GRANTING PETITION** 

UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed January 3, 2011, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on November 4, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. \(^1\)

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 3714 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

/Karen Creasy/ Karen Creasy Petitions Examiner Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.



#### UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P. O. Box 1450 Alexandria, VA 22313-1450 www. uspto. gov

FITCH EVEN TABIN & FLANNERY 120 SOUTH LASALLE STREET **SUITE 1600** CHICAGO, IL 60603-3406

MAILED JAN 2 1 2011 OFFICE OF PETITIONS

In re Application of Gary M. Zalewski et al Application No. 11/382,037

ON PETITION

Filed: May 6, 2006

Attorney Docket No. 86324 [SCEA06022US00]

This is a decision on the petition, filed January 20, 2011 under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

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The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on December 20, 2010 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 3714 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/ Irvin Dingle Petitions Examiner Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new [Issue] Fee Transmittal Form PTOL-85(b), which includes the following language thereonic Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

# SPE RESPONSE FOR CERTIFICATE OF CORRECTION

		Pape	er No.:20100804
DATE	: August 6, 2010		
TO SPE OF	: ART UNIT 2614		
SUBJECT	: Request for Certificate of Correct	ction on Patent No.: 11/382,147	
A response is	requested with respect to the accomp	panying request for a certificate of o	correction.
Certificates	lete this form and return with file, v of Correction Branch - PK 3-910 n 7590 - Tel. No. 305-8201		
read as shown	o the change(s) requested, correcting in the certificate of correction? No not claims be changed.		
Thank You F	For Your Assistance	Certificates of Correction	Branch
	for issuing the above-identified on the appropriate box.	correction(s) is hereby:	
⊠ Ар	proved	All changes apply.	
□Ар	proved in Part	Specify below which changes do I	not apply.
☐ De	nied	State the reasons for denial below	<i>'</i> .
Comments:			
		SPE: /Fan Tsang/	Art Unit 2614

#### UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT NO. : US 7,443,960 B2

**DATED** : **OCTOBER 28, 2008** 

INVENTOR: JOHN M. MARTIN, HISAO M. CHANG

ASSIGNEE : AT&T INTELLECTUAL PROPERTY I, L.P.

# REQUEST FOR CERTIFICATE OF CORRECTION UNDER 37 CFR 1.322

ATTENTION: CERTIFICATE OF CORRECTIONS BRANCH

COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

Dear Sir:

This paper is submitted in connection with the above referenced patent. The Patent contains one or more errors and, accordingly, a Certificate of Correction is respectfully requested. Attachment A to this document shows the error(s) and requested corrections. In addition, a proposed Certificate of Correction is attached.

Assignee believes that, because the errors corrected herein were incurred through the fault of the Patent and Trademark Office, no fee is required under the provisions of 37 CFR 1.322. If, however, a fee is required, the Commissioner is authorized to charge any such fee to Jackson Walker L.L.P. Deposit Account No. 10-0096.

If any questions arise during the processing of this request, please do not hesitate to contact the undersigned at the number listed below.

Respectfully submitted,

OK TO ENTER: /GG/

Joseph P. Lally

Reg. No. 38,947

ATTORNEY FOR ASSIGNEE

# **ATTACHMENT A**

# In the Specification

Please correct the indentation of tiers on the table at Line 41 of Column 7 as follows to reflect the indentation that was submitted in the specification as filed:

Steve's Grocery	549 Bull Creek	512-555-2522
Deli		512-555-2533
Produce		512-555-2544

Please correct the indentation of tiers on the table at Line 7 of Column 10 as follows to reflect the indentation that was submitted in the specification as filed:

Johnson Auto Mart	2715 N. Umbridge	512-555-8700
Sales		512-555-8710
Service	512-5	555-8720
Trucks		512-555-8730
Used Cars	2750 N. Umbridge	512-555-8740

Please correct the indentation of tiers on the table at Line 23 of Column 10 as follows to reflect the indentation that was submitted in the specification as filed:

125 Main Street	512-555-8500
7865 Pine	512-555-9514
7895 N. Research	512-555-7532
	7865 Pine

Please correct the indentation of tiers beginning at Line 44 of Column 10 as follows to reflect the indentation that was submitted in the specification as filed:

```
Tier One
Parent
       Child 1
       Child 2
       Child 3
       Child 4
Tier Two
Parent
       Child 1
               Subordinate Child 1.1
               Subordinate Child 1.2
       Child 2
               Subordinate Child 2.1
               Subordinate Child 2.2
Tier Three
Stand-Alone 1
Stand-Alone 2
Parent 1
       Child 1.1
               Subordinate Child 1.1.1
       Child 1.2
               Subordinate Child 1.2.1
               Subordinate Child 1.2.2
Parent 2
       Child 2.1
       Child 2.2
               Subordinate Child 2.2.1
               Subordinate Child 2.2.2
       Child 2.3
               Subordinate Child 2.3.1
```

Please correct the indentation of tiers on the table at Line 26 of Column 11 as follows to reflect the indentation that was submitted in the specification as filed:

Johnson Auto Mart	2715 N. Umbridge	512-555-8700
Sales		512-555-8710
Service	512-5	555-8720
Trucks		512-555-8730
Used Cars	2750 N. Umbridge	512-555-8740
Johnson Auto Mart	325 E. Beanna	512-555-9600
Parts		512-555-9640
Service	512-5	555-9630

# In the Claims

Please insert a new paragraph following "keyword;" at Line 43 of Column 21:

1. A method for providing automated directory assistance, comprising:

initiating a directory assistance dialog with a user;

prompting the user for a user utterance;

detecting a keyword in the user utterance;

querying a directory assistance database based at least in part on the keyword;

responsive to said querying retrieving multiple records from the database, determining hierarchical levels associated with the retrieved records; and

disambiguating the retrieved records based at least in part on the hierarchical levels including disambiguating a subset of the retrieved records, wherein the retrieved records in the subset share a common hierarchical level.

Please correct Claim 11 as follows, including inserting a new paragraph following "utterance;" at Line 46 of Column 22:

11. A system including a processor and storage, the storage including processor executable instructions, embedded in the storage, for providing automated directory assistance, said instructions comprising instructions for:

initiating a directory assistance dialog with a user;

prompting the user for a directory assistance user utterance;

detecting the user utterance in response to the prompt;

identifying one or more directory assistance search terms from the user utterance;

querying a database based on the identified search terms;

responsive to said querying retrieving multiple records from the database, determining hierarchical levels associated with the retrieved records; and

disambiguating the multiple records based at least in part on the hierarchical levels including disambiguating among a plurality of the retrieved records associated with a first hierarchical level to select a first record, and, responsive to detecting a plurality of retrieved records being child records to the selected first record, disambiguating among the child records to identify a selected child record.

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number. (Also Form PTO-1050)

# UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

Page \_ 1 \_ of \_ 4

PATENT NO.

: 7,443,960 B2

APPLICATION NO.: 11/382147

ISSUE DATE

: OCTOBER 28, 2008

INVENTOR(S)

JOHN M. MARTIN AND HISAO M. CHANG

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

#### In the Specification

Please correct the indentation of tiers on the table at Line 41 of Column 7 as follows to reflect the indentation that was submitted in the specification as filed:

Steve's Grocery

549 Bull Creek

512-555-2522

Deli

512-555-2533

Produce

512-555-2544

Please correct the indentation of tiers on the table at Line 7 of Column 10 as follows to reflect the indentation that was submitted in the specification as filed:

Johnson Auto Mart

2715 N. Umbridge

512-555-8700 512-555-8710

Sales Service

512-555-8720

Trucks

512-555-8730

**Used Cars** 

2750 N. Umbridge 512-555-8740

Please correct the indentation of tiers on the table at Line 23 of Column 10 as follows to reflect the indentation that was submitted in the specification as filed:

Smith Foods

Store No. 1 125 Main Street 512-555-8500 Store No. 2 7865 Pine 512-555-9514 Store No. 3 7895 N. Research 512-555-7532

MAILING ADDRESS OF SENDER (Please do not use customer number below):

JACKSON WALKER L.L.P. 100 CONGRESS AVENUE, SUITE 1100 AUSTIN, TEXAS 78701

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number. (Also Form PTO-1050)

# UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

Page 2 of 4

PATENT NO.

: 7,443,960 B2

APPLICATION NO.: 11/382147

ISSUE DATE

: OCTOBER 28, 2008

INVENTOR(S)

JOHN M. MARTIN AND HISAO M. CHANG

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Please correct the indentation of tiers beginning at Line 44 of Column 10 as follows to reflect the indentation that was submitted in the specification as filed:

Tier One Parent

Child 1

Child 2

Child 3

Child 4

Tier Two Parent

Child 1

Subordinate Child 1.1

Subordinate Child 1.2

Child 2

Subordinate Child 2.1

Subordinate Child 2.2

Tier Three

Stand-Alone 1

Stand-Alone 2

Parent 1

Child 1.1

Subordinate Child 1.1.1

Child 1.2

Subordinate Child 1.2.1

Subordinate Child 1.2.2

Parent 2

Child 2.1

Child 2.2

Subordinate Child 2.2.1

Subordinate Child 2.2.2

Child 2.3

Subordinate Child 2.3.1

MAILING ADDRESS OF SENDER (Please do not use customer number below):

JACKSON WALKER L.L.P. 100 CONGRESS AVENUE, SUITE 1100 AUSTIN, TEXAS 78701

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number. (Also Form PTO-1050)

# UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

Page 3 of 4

PATENT NO.

: 7,443,960 B2

APPLICATION NO.: 11/382147

ISSUE DATE

: OCTOBER 28, 2008

INVENTOR(S)

JOHN M. MARTIN AND HISAO M. CHANG

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Please correct the indentation of tiers on the table at Line 26 of Column 11 as follows to reflect the indentation that was submitted in the specification as filed:

Johnson Auto Mart Sales Service Trucks	2715 N. Umbridge	512-555-8700 512-555-8710 512-555-8720 512-555-8730
Used Cars	2750 N. Umbridge	512-555-8740
Johnson Auto Mart Parts Service	325 E. Beanna	512-555-9600 512-555-9640 512-555-9630

#### In the Claims

Please insert a new paragraph following "keyword;" at Line 43 of Column 21:

A method for providing automated directory assistance, comprising: 1.

initiating a directory assistance dialog with a user;

prompting the user for a user utterance;

detecting a keyword in the user utterance;

querying a directory assistance database based at least in part on the keyword;

responsive to said querying retrieving multiple records from the database, determining hierarchical levels associated with the retrieved records; and

disambiguating the retrieved records based at least in part on the hierarchical levels including disambiguating a subset of the retrieved records, wherein the retrieved records in the subset share a common hierarchical level.

MAILING ADDRESS OF SENDER (Please do not use customer number below):

JACKSON WALKER L.L.P. 100 CONGRESS AVENUE, SUITE 1100 AUSTIN, TEXAS 78701

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# UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

Page 4 of 4

PATENT NO.

: 7,443,960 B2

**APPLICATION NO.: 11/382147** 

**ISSUE DATE** 

: OCTOBER 28, 2008

INVENTOR(S)

JOHN M. MARTIN AND HISAO M. CHANG

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Please correct Claim 11 as follows, including inserting a new paragraph following "utterance;" at Line 46 of Column 22:

A system including a processor and storage, the storage including processor executable 11. instructions, embedded in the storage, for providing automated directory assistance, said instructions comprising instructions for:

initiating a directory assistance dialog with a user;

prompting the user for a directory assistance user utterance;

detecting the user utterance in response to the prompt;

identifying one or more directory assistance search terms from the user utterance;

querying a database based on the identified search terms:

responsive to said querying retrieving multiple records from the database, determining hierarchical levels associated with the retrieved records; and

disambiguating the multiple records based at least in part on the hierarchical levels including disambiguating among a plurality of the retrieved records associated with a first hierarchical level to select a first record, and, responsive to detecting a plurality of retrieved records being child records to the selected first record, disambiguating among the child records to identify a selected child record.

MAILING ADDRESS OF SENDER (Please do not use customer number below):

JACKSON WALKER L.L.P. 100 CONGRESS AVENUE, SUITE 1100 AUSTIN, TEXAS 78701

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

		Paper No.:
OATE :	12-04-10	
O SPE OF : AR	T UNIT 2186	
SUBJECT : Req	quest for Certificate of Correction	for Appl. No.: <u>11/382151</u> Patent No.: <u>7831786</u>
Please respond to thi	is request for a certificate of cor	rection within 7 days.
FOR IFW FILES:		
Please review the red mage. No new matt	quested changes/corrections as er should be introduced, nor sh	s shown in the COCIN document(s) in the IFW application ould the scope or meaning of the claims be changed.
Please complete the code COCX.	response (see below) and forw	ard the completed response to scanning using document
OR PAPER FILES:	1	
Please review the recomplete this form (s	quested changes/corrections as see below) and forward it with th	s shown in the attached certificate of correction. Please ne file to:
Certificates Randolph S Palm Locati	of Correction Branch (CofC) quare — 9D10-A ion 7580	4-6-
		Angela Green 703-756-1541
		Certificates of Correction Branch
		703-756-1814
Thank You For You  The request for issemates	ur Assistance  uing the above-identified core in the appropriate box.	rection(s) is hereby:
	· ·	
🗹 App	proved	All changes apply.
	proved in Part	All changes apply.  Specify below which changes do not apply.
	proved in Part	•
□ Арр	proved in Part	Specify below which changes do not apply.
☐ App	proved in Part	Specify below which changes do not apply.
☐ App	proved in Part	Specify below which changes do not apply.
☐ App	proved in Part	Specify below which changes do not apply.
☐ App	proved in Part	Specify below which changes do not apply.
☐ App	proved in Part	Specify below which changes do not apply.

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

SOQUEL GROUP, LLC P.O. BOX 691 SOQUEL, CA 95073 MAILED
JUN 27 2011

OFFICE OF PETITIONS

In re Application of

Glen Arthur O'Connor

Application No. 11/382,204

Filed: May 8, 2006

Attorney Docket No. COR.P001

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) or 37 C.F.R. § 10.40 filed May 31, 2011.

The request is **APPROVED**.

A review of the file record indicates that John W. Branch: (1) does not have power of attorney in this patent application; and (2) has been employed or otherwise engaged in the proceedings in this patent application. In view of the present decision, John W. Branch has been withdrawn from the present application and may not prepare or submit papers under 37 C.F.R. § 1.34, or correspond in any manner in this application unless appointed in an acceptable power of attorney under 37 C.F.R. § 1.32(b).

Telephone inquires concerning this decision should be directed to Irvin Dingle at 571-272-3210.

Irvin Dingle

Petitions Examiner Office of Petitions

cc:

John W. Branch 745 Fifth Avenue New York, NY 10151

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

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STEINS & ASSOCIATES 2333 CAMINO DEL RIO SOUTH SUITE 120 SAN DIEGO CA 92108 MAR 242011

OFFICE OF PETITIONS

In re Application of Charlie Gunderson et al. Application No. 11/382,239

Filed: May 8, 2006

Attorney Docket Number: DRI2-L42

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed September 22, 2010 to revive the above-identified application.

# The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition under 37 CFR 1.137(b)." This is not a final agency decision.

A non-Final Office Action was mailed March 21, 2008. A response was due not later than June 21, 2008. No response having been filed, this application became abandoned June 24, 2008 and a Notice of Abandonment was mailed February 10, 2009.

Petitioner asserts unavoidable delay in responding to the Office Action because of non-receipt.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) <u>must</u> be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with §

- 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) the petition fee as set forth in § 1.17(I);
- (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

This petition lacks item (3) above:

#### SHOWING OF UNAVOIDABLE DELAY

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.<sup>1</sup>

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure or mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.<sup>2</sup>

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

<sup>&</sup>lt;sup>2</sup>Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Petitioner argues that on March 5, 2008 a replacement power of attorney revoking all prior powers of attorney, and granting power of attorney to the petitioner was filed but that on March 17, 2008 the office action was erroneously sent to the prior attorney of record and not the petitioner.

Receipt is acknowledged of the revocation and power of attorney filed March 5, 2008 signed by Karl M. Steins on behalf of the assignee, and a "Declaration in Lieu of Oath, 37 CFR 1.68" signed by the assignee. However, a review of the power of attorney discloses that it was unacceptable since was not in compliance with 37 CFR 3.73(b) in that the putative assignee had not established its right to take action in accordance with 37 CFR 3.73(b). Specifically, petitioners have not provided documentary evidence of a chain of title from the original owner to the assignee, nor shown that documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*i.e.* reel and frame number).

In view thereof, petitioner has not presented sufficient evidence to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).

# **ALTERNATIVE VENUE**

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b)<sup>3</sup>, which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A

<sup>&</sup>lt;sup>3</sup>Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) <u>must</u> be accompanied by:

<sup>(1)</sup> the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

<sup>(2)</sup> the petition fee as set forth in 37 CFR 1.17(m);

<sup>(3)</sup> a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

<sup>(4)</sup> any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

It should be noted that if petitioner chooses to file a petition under the unintentional standard the fees due would be \$1620.00 for a large entity and \$810.00 for a small entity and the fees submitted with the instant petition cannot be applied as petitioner has already received consideration under the unavoidable standard.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petitions

**Commissioner for Patents** 

P.O. Box 1450

Alexandria VA 22313-1450

By FAX:

(571) 273-8300

Attn: Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Senior Petitions Attorney

Office of Petitions



#### UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

VAN PELT, YI & JAMES LLP 10050 N. FOOTHILL BLVD #200 CUPERTINO CA 95014 MAILED MAY 2.6 2011

OFFICE OF PETITIONS

In re Application of Charlie Gunderson et al. Application No. 11/382,239

Filed: May 8, 2006

Attorney Docket Number: DRI2-L42

**ON PETITION** 

This is a decision on the petition under 37 CFR 1.137(b)<sup>1</sup>, filed May 20, 2011 to revive the above-identified application.

# The petition is **GRANTED**.

A non-Final Office Action was mailed March 21, 2008. A response was due not later than June 21, 2008. No response having been filed, this application became abandoned June 24, 2008 and a Notice of Abandonment was mailed February 10, 2009. A Petition to Revive under 37 CFR 1.137(a) was filed December 22, 2010 and was dismissed in a decision mailed March 24, 2011 because the evidence provided did not establish that the delay was "unavoidable".

All other requirements of 37 CFR 1.137(b) having now been met, this matter is being referred to Technology Center 2612 for appropriate action on the amendment filed May 18, 2011.

Telephone inquiries concerning this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball Senior Petitions Attorney Office of Petitions

<sup>&</sup>lt;sup>1</sup>Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) <u>must</u> be accompanied by:

<sup>(1)</sup> the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

<sup>(2)</sup> the petition fee as set forth in 37 CFR 1.17(m);

<sup>(3)</sup> a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and



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# VAN PELT, YI & JAMES LLP 10050 N. FOOTHILL BLVD. #200 CUPERTINO CA 95014

MAILED
OCT 07:2011

In re Application of

Charlie Gunderson et al

Application No. 11/382,239

Filed: May 8, 2006

Attorney Docket No. DRIVP006

OFFICE OF PETITIONS

: DECISION GRANTING PETITION

: UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed October 3, 2011, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on September 15, 2011 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. \(^1\)

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 2612 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

/Karen Creasy/ Karen Creasy Petitions Examiner Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

HONEYWELL/STW
Patent Services
101 Columbia Road
P.O. Box 2245
Morristown, NJ 07962-2245

MAILED
MAY 13 2011
OFFICE OF PETITIONS

In re Application of **Michael E. BAZAKOS**, et *al.* Application No. 11/382,373 Filed: May 9, 2006

Attorney Docket No. H0007388-1100.1402101

DECISION GRANTING PETITION UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed May 12, 2011, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on April 7, 2011 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

Telephone inquiries should be directed to the undersigned at (571) 272-7253.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

This application is being referred to Technology Center AU 2624 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

CC: SEAGER TUFTE & WICKHEM, LLC
1221 NICOLLET AVENUE, SUITE 800
MINNEAPOLIS, MN 55403-2420

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). <u>Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.</u>

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

	JEL NEJFONJE I	ON CENTILICATE OF CONNECTION
		<b>Paper No</b> .:20120417A
DATE	: April 17, 2012	
TO SPE (	OF: ART UNIT 2833	
SUBJECT	Γ : Request for Certificate of Co	prrection on Patent No.: 7331819
A response	e is requested with respect to the acc	companying request for a certificate of correction.
Certificat	emplete this form and return with finds es of Correction Branch - ST (Solution 7590 - Tel. No. (703) 305-830	South Tower) 9A22
read as sh		cting Office and/or Applicant's errors, should the patent No new matter should be introduced, nor should the scope or
Thank Yo	ou For Your Assistance	Certificates of Correction Branch
-	est for issuing the above-identifications is a specification on the appropriated box.	fied correction(s) is hereby:
$\boxtimes$	Approved	All changes apply.
	Approved in Part	Specify below which changes <b>do not</b> apply.
	Denied	State the reasons for denial below.
Commen	ts:	
		/AMY JOHNSON/ Supervisory Patent Examiner.Art Unit 2833



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

MCNEES WALLACE & NURICK LLC 100 PINE STREET P.O. BOX 1166 HARRISBURG PA 17108-1166

**MAILED** 

JUL 18 2011

In re Application of Martin W. Kendig et al Application No. 11/382,499 OFFICE OF PETITIONS

Filed: May 10, 2006

**DECISION ON PETITION** 

Attorney Docket No. 05-1182/24058-0003-01

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 16, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an RCE and a previously filed amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Office action mailed January 27, 2009, is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 1793 for appropriate action by the Examiner in the normal course of business.

/KOC/ Karen Creasy Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

MCKESSON CORPORATIN AND ALSTON & BIRD, LLP C/O ALSTON & BIRD, LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000

MAILED

JAN 3 1 2011

OFFICE OF PETITIONS

In re Application of

Patrick J. Braun, et al.

Application No. 11/382,605

Filed: May 10, 2006

Attorney Docket No. 50704.305048

**DECISION GRANTING PETITION** 

UNDER 37 CFR 1.313(c)(2)

This is a decision on the renewed petition under 37 CFR 1.313(c)(2), filed January 28, 2011, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

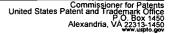
Petitioner is advised that the issue fee paid on October 10, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

Telephone inquiries regarding this decision should be directed to undersigned at (571) 272-1642. All other inquiries regarding the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 3651 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement and the amendment previously filed August 5, 2010.

/AMW/ April M. Wise Petitions Examiner Office of Petitions

The request to apply the issue fee to the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.





THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 400 INTERSTATE NORTH PARKWAY SE SUITE 1500 ATLANTA GA 30339

MAILED

SEP 02 2011

OFFICE OF PETITIONS

In re Patent No. 7,200,283

Issued: April 3, 2007

Application No. 11/382,682

Filed: May 10, 2006

Attorney Docket Number: 252209-2070

ON PETITION

This is a decision on the petition filed August 22, 2011 under 37 CFR 3.81(b)<sup>1</sup> for correction of the assignee data.

The petition is **GRANTED**.

Although the correct name of the assignee was not included on the Issue Fee Transmittal, PTOL-85B, petitioner states that the assignee is **S3 Graphics Co., Ltd.,** and that the assignment was submitted for recordation before issuance of the application which issued into U.S. Patent No. 7,200,283.

In view thereof, and since Office assignment records reflect that the assignment was submitted for recordation before issuance of parent application 10/190,450, which issued into U.S. Patent No. 7,095,906, and of which the instant application is a continuation, **S3 Graphics Co., Ltd.,** is the assignee of record and thus, the request complies with the provisions of 37 CFR 3.81(b). It is therefore appropriate for a certificate of correction to issue.

The petition fee in the amount of \$130.00 and the fee for the certificate of correction in the amount of \$100 have been applied.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-3212. Any questions concerning the issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

This file is being referred to the Certificates of Correction Branch for issuance of a certificate of correction.

Patricia Faison-Ball Senior Petitions Attorney

Office of Petitions

<sup>&</sup>lt;sup>1</sup> See Official Gazette of June 22, 2004



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Foley & Lardner LLP 150 EAST GILMAN STREET P.O. BOX 1497 MADISON WI 53701-1497

# **MAILED**

SEP 29 2011

## **OFFICE OF PETITIONS**

In re Application of

Rhoads

Application No. 11/382,850

Filed: May 11, 2006

Atty Docket No. 098888-1922

ON APPLICATION FOR

PATENT TERM ADJUSTMENT

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FOR PATENT APPLICATION UNDER 37 C.F.R. § 1.705(b), filed September 23, 2011. Applicant submits that the correct patent term adjustment to be indicated on the patent is one thousand one hundred fifty-four (1154) days, not five hundred forty-nine (549) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent or even the filing date of the request for continued examination is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that he may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee<sup>1</sup>.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b). This fee is required and will not be refunded.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

For example, if an applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the \$1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley
Senior Petitions Attorney

Office of Petitions



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/382,855	05/11/2006	Geoffrey B. Rhoads	098888-1923	6771
	7590 04/01/201	1	EXAM	INER
Foley & Lardno	er LLP MAN STREET		WORJLOH	, JALATEE
P.O. BOX 149	7		ART UNIT	PAPER NUMBER
MADISON, W	1 53701-1497		3685	
				T TO THE TOTAL OF
			MAIL DATE	DELIVERY MODE
			04/01/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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# MAR 1 8 2011

DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008

In re Application of: Geoffrey B. Rhoads

Application No. 11/382,855

Filed: May 11, 2006

For: CONTENT PROTECTION

ARRANGEMENTS

PETITION TO WITHDRAW

RESTRICTION REQUIREMENT

UNDER 37 C.F.R. 1.144

This is in response to applicant's petition filed on October 06, 2010, to request that the July 12, 2010 restriction requirement under 37 C.F.R. 1.144 be withdrawn. Applicant also requests, as part of this petition, that a new non-final Office action be issued and the time for response to be reset according to the new non-final.

The petition is GRANTED to the extent stated below.

Applicant alleges that the restriction requirement dated July 12, 2010 is improper and should be withdrawn because the examiner failed to meet the criteria set forth in Rule 145, 35 USC 121 and MPEP 811 in orderly to properly support a restriction by demonstrating that the inventions of claims 21-29 are independent and distinct from those of claims 1-20, and that there will be a serious burden if restriction is not required. Applicant argues that the subject matter of claims 21-29 is similar to claims 1-20 that no restriction is warranted. In addition, applicant alleges that since the Office action dated July 12, 2010 was erroneously made final, then subsequently changed into a non-final Office action, it leaves applicant with little time to prepare a response. Therefore, applicant requests that a new non-final Office action should be issued.

A review of the record shows that on June 10, 2010, applicant filed a response that included new claims 21-29 along with previously presented claims 1-20. On July 12, 2010 a final Office action was mailed in which the examiner identified the newly added claims 21-29 as "independent or distinct" (emphasis added), and withdrew claims 21-29 from consideration under restriction by original presentation. On September 7, 2010 applicant filed a response traversing the restriction of claims 21-29, and argued that the finality of the Office action is premature. On September 27, 2010, a letter was mailed indicating that applicant's request for reconsideration of the finality of the July 12, 2010 Office action is persuasive and the status of said Office action has been changed to a "non-final." On October 6, 2010 applicant timely filed the instant petition.

MPEP 803 sets forth the criteria for restriction as follows: "under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)). If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS
There are two criteria for a proper requirement for restriction between patentably
distinct inventions:

- (A) The inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05 §806.05(i)); and
- (B) There must be a serious burden on the examiner if restriction is required (see MPEP  $\S803.02$ ,  $\S806.04(a)$   $\S806.04(i)$ ,  $\S808.01(a)$ , and  $\S808.02$ ).

MPEP 816 specifies that "The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. ... The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass. See MPEP § 809."

A review of the restriction showed that in restricting new claims 21-29 from claims 1-20, the examiner had claims 21-23 as group (a), claim 24 as group (b), claims 25-26 as group (c), claims 27-29 as group (d). It is unclear whether claims 21-29 are grouped together or they are broken up into smaller groups as (a), (b), (c) and (d). It is also unclear what relationship claims 21-29 have with claims 1-20 (subcombination/combination, product/process, etc.), and what classification or separate status claims 21-29 have. There are no reasons presented in the restriction for holding the claimed invention independent or distinct as required by MPEP 816. There is no explanation for serious burden if restriction is not required as set forth in MPEP 803. The fact that applicant has received an action on the merits for the originally presented invention of claims 1-20 is not an adequate reason for the restriction absent a showing of independent or patentably distinct inventions, and serious burden if restriction is not required. Because of all the missing elements, the restriction is considered incomplete.

In response to applicant's argument that the criteria for restricting are "distinct and independent" inventions, applicant's attention is directed to MPEP 803 presented above which clearly states that the criteria is "distinct or independent" inventions.

As the restriction made on July 12, 2010 is incomplete, the application is returned to the examiner to redo the restriction requirement with proper rationales and reasons for holding a

restriction. As a remedy, the examiner will issue a new non-final Office action, without retroactive effect, that clearly sets forth the restriction and to consider the amendment filed on December 10, 2010.

Any question regarding this decision should be directed to SPE Calvin Hewitt at (571) 272-6709.

Wynn Coggins, Director Technology Center 3600

(571) 272-5350

ch/lm: 3/11/11

LM

		Paper No.:
DATE	: <u>3/14/11</u>	
TO SPE OF	: ART UNIT <u>1616</u>	
SUBJECT	: Request for Certificate of Correct	ction for Appl. No.: <u>11382878</u> Patent No.: <u>7846463</u>
	•	CofC mailroom date: 02/24/11
Please resp	ond to this request for a cer	tificate of correction within 7 days.
FOR IFW F	ILES:	
IFW applica	ew the requested changes/c tion image. No new matter the claims be changed.	orrections as shown in the <b>COCIN</b> document(s) in the should be introduced, nor should the scope or
Please com using docun	plete the response (see belonent code <b>COCX</b> .	ow) and forward the completed response to scanning
FOR PAPE	R FILES:	
correction. Certi <sup>,</sup> Rand	Please complete this form (s ficates of Correction Bran lolph Square – 9D10-A	orrections as shown in the attached certificate of see below) and forward it with the file to:  ch (CofC)
correction. Certi Rand Palm	Please complete this form (s ficates of Correction Bran	see below) and forward it with the file to:  ch (CofC)
correction. Certi Rand Palm	Please complete this form (s ficates of Correction Bran- lolph Square – 9D10-A Location 7580	see below) and forward it with the file to:  ch (CofC)
correction. Certi Rand Palm	Please complete this form (s ficates of Correction Bran- lolph Square – 9D10-A Location 7580	see below) and forward it with the file to:  ch (CofC)  Clamonte Newsome
correction.  Certing Rand Palm	Please complete this form (s ficates of Correction Bran- lolph Square – 9D10-A Location 7580	See below) and forward it with the file to:  ch (CofC)  Camonte Newsome  Certificates of Correction Branch
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Certing Rand Palm Thank You The requestory of th	For Your Assistance  ficates of Correction Branch  for Your Assistance  t for issuing the above-ide	see below) and forward it with the file to:  ch (CofC)   Camonte Newsome  Certificates of Correction Branch  571-272-3421
Thank You The reques Note your decision	For Your Assistance  t for issuing the above-ide to the appropriate box.	See below) and forward it with the file to:  ch (CofC)  Camonte Newsome  Certificates of Correction Branch 571-272-3421  entified correction(s) is hereby:
Thank You The reques Note your decision	For Your Assistance  t for issuing the above-ide on the appropriate box.	See below) and forward it with the file to:  ch (CofC)   Camonte Newsome  Certificates of Correction Branch  571-272-3421  entified correction(s) is hereby:  All changes apply.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

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**MAILED** 

APEX JURIS, PLLC 12733 LAKE CITY WAY NORTHEAST SEATTLE, WA 98125 JAN 202011

OFFICE OF PETITIONS

In re Application of Marty Williams Application No. 11/382,917 Filed: May 11, 2006

Filed: May 11, 2006 Attorney Docket No.: 10.18.18.USP **ON PETITION** 

This is a decision in response to the petition, filed November 12, 2010, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

## The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed August 20, 2008, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on November 21, 2008. A Notice of Abandonment was mailed on March 30, 2009. On November 12, 2010, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of amendment; (2) the petition fee of \$810; and (3) an adequate statement of unintentional delay<sup>1</sup>.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the \$555 extension of time fee submitted with the petition on November 12, 2010 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's credit card.

The application is being referred to Technology Center AU 3611 for appropriate action by the Examiner in the normal course of business on the amendment received November 12, 2010.

<sup>37</sup> CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. While it is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

Commissioner for Patents
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Alexandria, VA 22313-1450

THORPE NORTH & WESTERN, LLP P.O. BOX 1219 SANDY, UT 84091-1219

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APR 11 2011

**OFFICE OF PETITIONS** 

In re Application of

Andrew Halliday et al

Application No. 11/383,112

ppncauon No. 11/363,112 :

Filed: May 12, 2006

Attorney Docket No. 2913-020.NP

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 8, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed July 8, 2009, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on August 9, 2009.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 2173 for further processing.

Trvin Dingle

Petitions Examiner Office of Petitions



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THORPE NORTH & WESTERN, LLP. P.O. Box 1219 SANDY UT 84091-1219

MAILED JUN 0 7 2011 OFFICE OF PETITIONS

In re Application of Andrew Halliday et al. Application No. 11/383,123 Filed: May 12, 2006

Attorney Docket No. 2913-021.NP

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 10, 2011, to revive the above-identified application.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, September 15, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on December 16, 2009.

The petition is **GRANTED**.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment/response, (2) the petition fee of \$810, and (3) a proper statement of unintentional delay.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571) 272-4584.

This application is being referred to Technology Center AU 2178 for appropriate action by the Examiner in the normal course of business on the reply received.

Petitions Examiner Office of Petitions



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THORPE NORTH & WESTERN, LLP. P.O. Box 1219
SANDY UT 84091-1219

MAILED

JUN 15 2011

OFFICE OF PETITIONS

In re Application of

Lunt et al.

Application No. 11/383,134

Filed: May 12, 2006

Attorney Docket No. 2913-022.NP

For: METHOD FOR FACILITATING CREATION OF CONTENT IN A LIFE STORY COLLECTION SYSTEM

ON PETITION

This is a decision on the petition, filed May 16, 2011, under 37 CFR 1.137(b) to revive the above-identified application.

## The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely submit a reply within three (3) months of the mailing of the September 17, 2009 non-final Office action. No response being received and no extensions of time being obtained under the provisions of 37 CFR 1.136(a), this application became abandoned on December 18, 2009. A Notice of Abandonment was mailed on April 13, 2010.

Applicants have submitted an amendment in reply to the September 17, 2009 non-final Office action, an acceptable statement of the unintentional nature of the delay in responding to the September 17, 2009 non-final Office action, and the \$810.00 petition fee.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, practitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, practitioner must notify the Office.

All of the requirements under 37 CFR 1.137(b) being met, the petition is granted.

After the mailing of this decision, the application will be returned to Technology Center GAU 2178 for consideration of the amendment filed on May 16, 2011.

Telephone inquiries should be directed to the undersigned at (571) 272-3230.

Shuru Willis Brantley
Shirene Willis Brantley

Senior Petitions Attorney Office of Petitions



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EDWARD YOO C/O BENNETT JONES LLP 3200 TELUS HOUSE, SOUTH TOWER 10020 - 100 STREET EDMONTON, ALBERTA AB T5J 0N3 CA CANADA

MAILED
JUN 2 1 2011
OFFICE OF PETITIONS

In re Application of Columba K. YEUNG Application No. 11/383,137 Filed: May 12, 2006 Attorney Docket No. 50078 6

**DECISIO ON PETITION** 

Attorney Docket No. 50078.6

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 29, 2011, to revive the above-identified application.

## The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of August 20, 2010. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). A three (3) month extension of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is February 21, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of \$405.00, and the submission required by 37 CFR 1.114, previously submitted March 09, 2011; (2) the petition fee of \$810.00; and (3) a proper statement of unintentional delay. Accordingly, the reply to the final Office action of August 20, 2010 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4231.

This application is being referred to Technology Center AU 1774 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Michelle R. Eason

Paralegal Specialist

Office of Petitions

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MARGER JOHNSON & MCCOLLOM/PARC 210 MORRISON STREET SUITE 400 PORTLAND OR 97204 MAILED
MAR 1 0 2011
OFFICE OF PETITIONS

In re Patent No. 7,822,863

Issue Date: October 26, 2010

Application No. 11/383,144

Filed: May 12, 2006

Attorney Docket No. 20051730-US-NP-9841-009

**DECISION ON PETITION** 

This is a decision on the Petition To Correct Assignment Information On Issued Patent and Request For Certificate Of Correction, filed November 5, 2010, which is being treated as a Petition Under 37 CFR §3.81(b) to add the second assignee's name and residence. A completed Certificate of Correction Form (PTO/SB/44) was submitted with Petition.

The petition under 37 CFR §3.81(b) is **GRANTED**.

Petitioner urges that the present Petition was submitted to add the second assignee's name and residence on the previously submitted PTOL-85B. Accordingly, petitioner requests that a Certificate of Correction (PTO/SB/44) be issued to add the second assignee's name and residence to the Title Page of the Letters Patent.

37 CFR 3.81(b), effective June 25, 2004, reads:

After payment of the issue fee: Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a) and the processing fee set forth in § 1.17(i) of this chapter.

Decision on Petition under 37 CFR 3.81

The requisite \$130.00 processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(i), has been submitted. The \$100.00 fee (Fee Code 1811), as set forth under 37 CFR 1.20(a), was not submitted. However, review of Office records show that the PTOL-85(b) accompanied deposit account authorization to charge any required fees. As such, the fee has been charged. Further, Office assignment records are consistent with the requested correction. Accordingly, since the Petition complies with the provisions of 37 CFR 3.81(b), it is appropriate for the Office to issue a Certificate of Correction in accordance with the content of the Form PTO/SB/44 submitted with the Petition.

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

Any questions concerning the issuance of a Certificate of Correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,822,863.

Cheryl Gibson-Baylor Petitions Examiner

Office of Petitions

Page 2



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria. Virginia 22313-1450

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/383,184	05/12/2006	Denis Bekman	1361032-2047.1	7267
7	7590 01/25/2011		EXAM	INER
Yahoo! Inc. c/o Frommer La	wrence & Haug LLP		VOSTAL, C	ONDREJ C
745 Fifth Avenue			ART UNIT	PAPER NUMBER
NEW YORK, NY	′ 10151		2453	
			MAIL DATE	DELIVERY MODE
			01/25/2011	PAPER

# **DECISION DISMISSING PETITION UNDER 37 CFR 1.138(d)**

The declaration of express abandonment will not be recognized

This is in response to the petition under 37 CFR 1.138(d), requesting for a refund of any previously paid search fee and excess claims fee in the above-identified application.

The petition is dismissed.

The express abandonment will **not** be recognized for the reason(s) indicated below:

- 1. The petition was not filed in sufficient time to permit the appropriate officials to recognize the abandonment before an examination has been made of the application. See 37 CFR 1.138(d).
- 2. The petition was not signed by a party authorized by 37 CFR 1.33(b)(1), (3) or (4).
- 3. The application is not an application filed under 35 U.S.C. 111(a) on or after December 8, 2004.
- 4. ☐ The petition for express abandonment under 1.138(d) is dismissed because the applicant did not pay any search fee and excess claims fees in the above-identified application.

Telephone inquiries should be directed to the Office of Data Management at (571) 272-4200.

Patent Publication Branch Office of Data Management

	SPE RESPONSE F	OR CERTIFICATE OF CORRECTION
DATE	- 6/1/2011	
TO SPE OF	: ART UNIT <u>28/3</u>	
SUBJECT	: Request for Certificate of Correc	ction for Appl. No.:
		CofC mailroom date: 5/23/2
Please respo	ond to this request for a cer	rtificate of correction within 7 days.
OR IFW FII	LES:	<b>~</b>
he IFW app		corrections as shown in the COCIN document(s) in atter should be introduced, nor should the scope or
	plete the response (see bel	low) and forward the completed response to scanning
FOR PAPER	R FILES:	
		corrections as shown in the attached certificate of (see below) and forward it with the file to:
Rande	icates of Correction Bran olph Square – 9D10-A Location 7580	ich (CofC)
Note:		
		Certificates of Correction Branch
		(571) 272-0460
Thank You	For Your Assistance	
	t for issuing the above-id on the appropriate box.	entified correction(s) is hereby:
<b>12</b>	Approved	All changes apply.
	Approved in Part	Specify below which changes do not apply.
	Denied	State the reasons for denial below.
Comments:		
, concension of the second		
		3-7 A-D
		SPE Art Unit
L-306 (REV. 7/03)		U.S. DEPARTMENT OF COMMERCE Patent and Trademark



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

FISH & RICHARDSON P.C. (AT) P.O. BOX 1022 MINNEAPOLIS MN 55440-1022

MAILED

JUL 18 2011

OFFICE OF PETITIONS

In re Patent No. 7,903,549

Issue Date: March 8, 2011

Application No. 11/383,347

Filed: May 15, 2006

Attorney Docket No. 20281-0012001

**ON PETITION** 

This is a decision on the petition filed April 8, 2011, which is being treated as a request under 37 CFR 3.81(b)<sup>1</sup> to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3208. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

/KOC/ Karen Creasy Petitions Examiner Office of Petitions

<sup>&</sup>lt;sup>1</sup> See MPEP 1309, subsection II; and Official Gazette of June 22, 2004.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834

MAILED

SEP 3 0 2010

OFFICE OF PETITIONS

In re Application of

Victor B. Kley

Application No. 11/383,356

ON PETITION

Filed: May 15, 2006

Attorney Docket No.: 20921K-003100US

This is a decision in response to the petition, filed August 10, 2010, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

This application became abandoned for failure to timely file an Appeal Brief within two months of the January 25, 2010 date of the Notice of Appeal. This decision precedes the mailing of a Notice of Abandonment. On August 10, 2010, the present petition was filed.

The application is being revived for consideration of a Request for Continued Examination (RCE) under 37 CFR 1.114. Accordingly, the filing of the RCE on August 10, 2010, obviates the Notice of Appeal filed January 25, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE), including the fee of \$405 and the submission required by 37 CFR 1.114; (2) the petition fee of \$810; and (3) an adequate statement of unintentional delay.

This application is being referred to Technology Center AU 2881 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley Petitions Examiner Office of Petitions



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.usplo.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR .	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/383,371	05/15/2006	Toshio Shintani	UNIU79.068AUS	7573
20995	7590 09/01/2010 RTENS OLSON & BE		EXAM	INER
2040 MAIN ST	TREET	AK LLI	DUCHENEAU	X, FRANK D
FOURTEENTI IRVINE, CA 9		•	ART UNIT	PAPER NUMBER
,,			1787	
			NOTIFICATION DATE	DELIVERY MODE
			09/01/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com efiling@kmob.com eOAPilot@kmob.com



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

www.uspto.gov

wk

**DECISION ON** 

**PETITION** 

Mailed:

SEP 0 1 2010

In re application of Shintani et al.

Serial No. 11/383,371

Filed: May 15, 2006

For: PRESSURE-SENSITIVE ADHESIVE SHEET FOR USE

IN DICING AND METHOD OF PROCESSING

PRODUCTS WORKED WITH IT

This is a decision on the PETITION FILED UNDER 37 CFR 1.181 on August 11, 2010 to withdraw the finality of the Office Action mailed June 11, 2010.

On March 10, 2010 Applicants amended various claims and added new claims 23-25. Independent claim 3 was not amended. The Final Office Action of June 11, 2010 maintained the previous rejection of claim 3 under 35 USC 102(b) and included a new rejection of Claims 3 and 25. The Office Action was made final by the Examiner because Applicants' amendments necessitated the new grounds of rejections.

MPEP 706.07(a) states that a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

A review of the record indicates that the Office Action newly rejects unamended independent claim 3.

#### **DECISION**

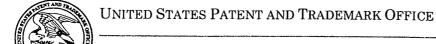
The petition is **GRANTED**.

11/383,371

The finality of the June 11, 2010 Office Action is withdrawn. The period for response will continue run from the mail date of June 11, 2010.

/W. GARY JONES/ W. Gary Jones, Director Technology Center 1700 Chemical and Materials Engineering

Kerry Taylor KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE CA 92614



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MERCHANT & GOULD SCIENTIFIC ATLANTA, A CISCO COMPANY P.O. BOX 2903 MINNEAPOLIS MN 55402-0903 JUN 13 2011

OFFICE OF PETITIONS

In re Application of

Buchen et al.

Application No. 11/383,373

Filed: May 15, 2006

Attorney Docket No. 60374.0284US01/968651

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed April 29, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Amendment, (2) the petition fee of \$1620.00, and (3) a proper statement of unintentional delay.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the \$1110.00 extension of time fee submitted with the petition was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be refunded to petitioner's credit card in due course.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206.

This matter is being referred to Technology Center AU 2436 for further examination on the merits.

/Liana Walsh/ Liana Walsh Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

KUNZLER NEEDHAM MASSEY & THORPE 8 EAST BROADWAY SUITE 600 SALT LAKE CITY UT 84111 MAILED
FEB 1 1 2011
OFFICE OF PETITIONS

In re Patent No. 7,879,406

Issued: February 1, 2011

Application No. 11/383,386

Filed: May 15, 2006

Attorney Docket No. 2735.2.25

ON PETITION

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed January 4, 2011.

On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-7751.

Joan Olszewski Petitions Examiner

Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

AT&T LEGAL DEPARTMENT – JW ATTN: PATENT DOCKETING ROOM 2A-207 ONE AT&T WAY BEDMINSTER, NJ 07921

MAILED

AUG 1.6 2010

In re Application of : OFFICE OF PETITIONS

Julia Skladman, et al.

Application No. 11/383,388 : ON PETITION

Filed: May 15, 2006

Attorney Docket No. A00547-2 (00128)

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 6, 2010, to revive the above-identified application.

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed December 29, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on March 30, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of \$810, and the submission required by 37 CFR 1.114; (2) the petition fee of \$1620; and (3) a proper statement of unintentional delay.

In view of the above, the petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 2614 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Petitions Examiner
Office of Petitions

DAIL	· August 25. 2010	
TO SPE OF SUBJECT		for Appl. No/11/383407 /pat. 7746656
Please res 7 days.	pond to this request for a certific	
FOR IFW I	FILES:	
the irvv ap	iew the requested changes/correpplication image. No new matter the claims be changed.	ections as shown in the COCIN document(s) in r should be introduced, nor should the scope or
Please con using docu	nplete the response (see below)	and forward the completed response to scannii
FOR PAPE	R FILES:	
Please revi	iew the requested changes/corre Please complete this form (see	ections as shown in the attached certificate of below) and forward it with the file to:
	•	•
Cert Rand	ificates of Correction Branch dolph Square – 9D10-A n Location 7580	•
Cert Rand	ificates of Correction Branch dolph Square – 9D10-A	(CofC)
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Cert Rand	ificates of Correction Branch dolph Square – 9D10-A	(CofC)  Magdalene Talle
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Cert Rand Palm Thank You The reques Note your decision	ificates of Correction Branch dolph Square – 9D10-A n Location 7580  For Your Assistance st for issuing the above-identification on the appropriate box.	Magdalene Talle  Certificates of Correction Branch 571-272-0423  fied correction(s) is hereby:
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Cert Rand Palm Thank You The reques Note your decision	ificates of Correction Branch dolph Square – 9D10-A n Location 7580  I For Your Assistance st for issuing the above-identification on the appropriate box. I Approved YS I Approved in Part I Denied	Magdalene Talle  Certificates of Correction Branch 571-272-0423  fied correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.

/Jayprakash N Gandhi/

PTOL-306 (REV. 7/03)

2835

SPE Art Unit
U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

SPE RESPONSE FOR CERTIFICATE OF CORRECTION





Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Boston Scientific Corporation c/o Frommer Lawrence & Haug LLP 745 Fifth Avenue New York NY 10151

## MAILED

DEC 17 2010

OFFICE OF PETITIONS

In re Application of

Yue-Teh Jang

Application No. 11/383445

Filing or 371(c) Date: 05/15/2006

Attorney Docket No. 21400/1210033-US4

DECISION ON PETITION

UNDER 37 CFR 1.78(a)(3)

This is a decision on the "Petition to Accept Unintentionally Delayed Priority Claim," filed April 29, 2010, for the benefit of the prior-filed applications set forth in the amendment filed with the petition. The petition is properly treated as a renewed petition under 37 C.F.R. § 1.78(a)(3).

#### The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in  $\S 1.17(t)$ ; and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37

CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.

A Corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional applications, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Derek Woods at (571) 272-3232. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 3734 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed applications.

Any questions concerning this matter may be directed to Derek Woods at (571) 272-3232.

Christopher Bottorff

Supervisor

Office of Petitions

ATTACHMENT: Corrected Filing Receipt.



#### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450

APPLICATION	FILING or	GRP ART				
NUMBER	371(c) DATE	UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
11/383,445	05/15/2006	3734	1230	1362001-2105.4	22	3

79292
Boston Scientific Corporation
c/o Frommer Lawrence & Haug LLP
745 Fifth Avenue
New York, NY 10151

CONFIRMATION NO. 7677
CORRECTED FILING RECEIPT



Date Mailed: 12/15/2010

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

Applicant(s)

Yue-Teh Jang, Fremont, CA;

Power of Attorney: The patent practitioners associated with Customer Number 79292

Domestic Priority data as claimed by applicant

This application is a CON of 10/306,976 11/27/2002 PAT 7,044,964 which is a CON of 09/384,846 08/27/1999 ABN which is a CON of 08/880,947 06/23/1997 PAT 6,074,362 which is a DIV of 08/556,660 11/13/1995 PAT 5,749,848

**Foreign Applications** 

If Required, Foreign Filing License Granted: 06/05/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/383,445** 

Projected Publication Date: Not Applicable

**Non-Publication Request: No** 

Early Publication Request: No

page 1 of 3

#### Title

Catheter System Having Imaging, Balloon Angioplasty, And Stent Deployment Capabilities, And Method Of Use For Guided Stent Deployment

#### **Preliminary Class**

623

#### PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

#### LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

#### **GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where

page 2 of 3

the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

#### **NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

14.5 44.4

#### UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

LAW OFFICE OF MICHAEL A. BLAKE, LLC 95 HIGH STREET SUITE 5 MILFORD CT 06460

MAILED
MAY 3 1 2011
OFFICE OF PETITIONS

In re Application of Gary Pearson Application No. 11/383,579 Filed: May 16, 2006

ON PETITION

Attorney Docket No. PEAR -0001

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 2, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to properly reply in a timely manner to the final Office action mailed, December 10, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on March 11, 2009. A Notice of Abandonment was mailed on September 2, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a continuing application under 37 CFR 1.53(b), (2) the petition fee of \$810, and (3) a proper statement of unintentional delay. Accordingly, the filing of a continuing application under 37 CFR 1.53(b) is accepted as being unintentionally delayed.

The application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the application, the application is again abandoned in favor of a continuing application under 37 CFR 1.53(b).

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

/Kimberly Inabinet/

Kimberly Inabinet Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION MAILED

P.O. BOX 506

**MERRIFIELD VA 22116** 

MAR 282011

In re Patent No. 7,646,791 OFFICE OF PETITIONS Issued: January 12, 2010

Application No.: 11/383,759

Filed: May 17, 2006

Attorney Docket No: ASTP0071USA

**NOTICE** 

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin **Petitions Attorney** Office of Petitions



#### UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

## MAILED

CAPITOL PATENT & TRADEMARK LAW FIRM, PLLC P.O. BOX 1995 VIENNA VA 22183 JAN 18 2011
OFFICE OF PETITIONS

In re Patent No. 7,590,129

: DECISION ON REQUEST

**Absillis** 

: FOR

Issue Date: September 15, 2009

: RECONSIDERATION OF

Application No. 11/383,781

: PATENT TERM ADJUSTMENT

Filed: May 17, 2006

: and

Atty Docket No. 129250-002254

: NOTICE OF INTENT TO ISSUE : CERTIFICATE OF CORRECTION

This is a decision on the petition filed on May 19, 2010, which requests reconsideration of the "Decision on Request for Recalculation of Patent Term Adjustment in View of *Wyeth*" mailed April 21, 2010, and recalculation of the patent term adjustment.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by six hundred and thirty-nine (639) days is **GRANTED.** 

It is noted that no fee was required to accompany the Request for Recalculation of Patent Term Adjustment in View of *Wyeth* filed March 15, 2010. It is also noted that the "Decision on Request for Recalculation of Patent Term Adjustment in View of *Wyeth*" mailed April 21, 2010, erroneously dismissed the Request for Recalculation of Patent Term Adjustment in View of Wyeth. Accordingly, no fee is being assessed for the instant request for reconsideration as the instant petition resulted in the first recalculation of the patent tem adjustment in view of *Wyeth* and it appears that patentee met the qualifications of the matter to be considered by the Request for Recalculation of Patent Term Adjustment in View of Wyeth, filed March 15, 2010.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentee is given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by six hundred and thirty-nine (639) days.

Patent No. 7,590,129 Application No. 11/383,781 Page 2

Telephone inquiries specific to this matter should be directed to the undersigned, at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin Petitions Attorney Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

# **DRAFT COPY**

# UNITED STATES PATENT AND TRADEMARK OFFICE

# **CERTIFICATE OF CORRECTION**

**PATENT** 

: 7,590,129 B2

DATED

: Sep. 15, 2009

INVENTOR(S): Absillis

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (518) days

Delete the phrase "by 518 days" and insert – by 639 days--

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#### UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Kilpatrick Townsend & Stockton/Qualcomm Two Embarcadero Center 8th Floor San Francisco CA 94111-3834

MAILED JAN 23 2012

In re Patent No. 7,389,591

OFFICE OF PETITIONS

Issue Date: June 24, 2008 Application No. 11/383,918

**NOTICE** 

Filed: May 17, 2006

Attorney Docket No. 112968 (816810)

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed December 2, 2011.

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3215.

Charlema Grant

Attorney Advisor

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

#### MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C ONE FINANCIAL CENTER BOSTON MA 02111

## **MAILED**

AUG 02 2010

In re Application of

Robert Hecht-Nielsen, et al.

Application No. 11/384,015

Filed: March 17, 2006

Attorney Docket No. 35006-502001US

OFFICE OF PETITIONS

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 15, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Restriction Requirement, mailed September 11, 2009, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on October 12, 2009. The Notice of Abandonment was mailed April 26, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an election, (2) the petition fee of \$1,620, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Terri Johnson at (571) 272-2991.

This application is being referred to Technology Center AU 3685 for appropriate action by the Examiner in the normal course of business on the reply received.

Terri Johnson

Petitions Examiner

Office of Petitions

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

MAILED MAY 25 2011

OFFICE OF PETITIONS

DOCKET CLERK P.O. DRAWER 800889 DALLAS TX 75380

In re Patent No. 7,542,875

Issue Date: June 2, 2009

Application No. 11/384,020

Filed: March 17, 2006

Attorney Docket No. PERF04-00013

**DECISION ON PETITION** 

This is a decision on the Request For Certificate Of Correction, filed January 10, 2011, which is being treated as a Petition Under 37 CFR §3.81(b), to delete in its entirely assignee's name. A completed Certificate of Correction Form (PTO/SB/44) was submitted with the petition.

The petition under 37 CFR §3.81(b) is **GRANTED**.

Petitioner requests that the present Petition was submitted to delete in its entirely assignee's name on the previously submitted PTOL-85B and such error was of a clerical or typographical error. Accordingly, petitioner requests that a Certificate of Correction (PTO/SB/44) be issued to delete in its entirely assignee's name to the Title Page of the Letters Patent.

The requisite \$100.00 fee (Fee Code 1811) as set forth under 37 CFR 1.20(a), has been submitted. However, the requisite \$130.00 processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(i), is required. Therefore, since the petition was accompanied deposit account authorization, the fee has been charged.

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

Any questions concerning the issuance of a Certificate of Correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,542,875.

Cheryl Gibson-Baylor

Petitions Examiner Office of Petitions



#### UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

DOCKET CLERK P.O. DRAWER 800889 DALLAS TX 75380 MAILED
JUN. 1-5 2011

OFFICE OF PETITIONS

In re Patent No. 7,542,875

Issue Date: June 2, 2009

Application No. 11/384,020

Filed: March 17, 2006

Attorney Docket No. PERF04-00013

: DECISION ON REQUEST FOR REFUND

This is a decision on the Request For Refund filed June 3, 2011.

The request is **DISMISSED**.

Applicant files a request for refund of the petition fee (\$130.00) charged on May 25, 2011, in the above-identified application.

The decision mailed on May 25, 2011, stated that "The requisite \$100.00 fee (Fee Code 1811) as set forth under 37 CFR 1.20(a), has been submitted. However, the requisite \$130.00 processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(i), is required. Therefore, since the petition was accompanied deposit account authorization, the fee has been charged." Applicant is encouraged to note 37 CFR §3.81(b). The petition treated under the provisions of 37 CFR §3.81(b) was necessary.

In view of the above, the request for refund is dismissed.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/ Karen Creasy Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS) 136 S WISCONSIN ST PORT WASHINGTON WI 53074 MAILED

AUG 05 2010

OFFICE OF PETITIONS

In re Application of

Pan et al.

NOTICE

Application No. 11/384029

Filing/371(c) Date: 03/17/2006

Attorney Docket Number:

GEMS8081.486

This is a notice regarding request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Telephone inquiries concerning this Notice should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/

Derek L. Woods Attorney Office of Petitions

#### UNITED STATES PATENT AND TRADEMARK OFFICE



COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

SHERIDAN ROSS PC 1560 BROADWAY SUITE 1200 DENVER CO 80202 MAILED

AUG 3 0 2010

OFFICE OF PETITIONS

In re Application of

Henry, et al.

Application No. 11/384,172

Filed: March 17, 2006

Attorney Docket No. 2060-95-CON-CIP.0102

ON PETITION

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed July 28, 2010, to revive the above-identified application.

The application became abandoned March 3, 2010 for failure to timely the issue fee and publication fee as required by the Notice of Allowance and Issue Fee Due (Notice) mailed December 2, 2009. The Notice set a three month statutory period of time for reply. This decision precedes Notice of Abandonment. A petition under 37 CFR 1.137(b) was filed March 3, 2010 and dismissed June 7, 2010.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D).

The instant petition has been carefully reviewed and found in compliance with the requirements set forth above.

In view thereof, the petition under 37 CFR 1.137(b) is hereby **GRANTED**.

This application is being forwarded to Group Art Unit 1797 for consideration of the request for continued examination filed March 3, 2010.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown Petitions Attorney Office of Petitions

#### UNITED STATES PATENT AND TRADEMARK OFFICE



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FLASTER/GREENBERG P.C. FOUR PENN CENTER 1600 JOHN F. KENNEDY BOULEVARD 2ND FLOOR PHILADELPHIA PA 19103

MAILED

FEB 1 4 2012

**OFFICE OF PETITIONS** 

In re Application of

Grovit

Application No. 11/384,223

Filed/Deposited: 17 March, 2006

Attorney Docket No. I0179-1U1

**DECISION** 

This is a decision on the papers filed on 28 December, 2011, pursuant to 37 C.F.R. §1.137(b) for revival of an application abandoned due to unintentional delay.

#### **NOTE:**

The record (including the petition filed on 28 December, 2011) does not necessitate a finding that the delay between midnight 30 December, 2009 (the date of abandonment), and 28 December, 2011 (the date of the filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on the duty of candor and good faith of Petitioner/Counsel Lynda L. Calderone (Reg. No. 35,837) when accepting Petitioners' representation that the delay in filing the response was unintentional.<sup>1</sup>

The petition pursuant to 37 C.F.R. §1.137(b) is **GRANTED**.

See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. '10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. '1.137(b) to the Patent and Trademark Office).

Application No. 11/384,223

# As to the Allegations of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee

Petitioners' attentions always are directed to the guidance in the Commentary at MPEP  $\S711.03(c)(II)$ .

#### **BACKGROUND**

The record reflects as follows:

Petitioner failed to reply timely and properly to the non-final Office action mailed on 30 September, 2009, with reply due absent an extension of time on or 30 December 2009.

The application went abandoned by operation of law after midnight 30 December, 2009.

The Office mailed the Notice of Abandonment on 16 April, 2010.

On 28 December, 2011, Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.137(b), with fee, a reply in the form an amendment, and made the statement of unintentional delay.

As noted above, the record (including the petition filed on 28 December, 2011) does not necessitate a finding that the delay between midnight 30 December, 2009 (the date of abandonment), and 28 December, 2011 (the date of the filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on the duty of candor and good faith of Petitioner/Counsel Lynda L. Calderone (Reg. No. 35,837) when accepting Petitioners' representation that the delay in filing the response was unintentional.<sup>2</sup>

Petitioners' attentions always are directed to the guidance in the Commentary at MPEP §711.03(c) as to the showing regarding unintentional delay and a petition pursuant to 37 C.F.R. §1.137(b).

<sup>&</sup>lt;sup>2</sup> See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. '10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. '1.137(b) to the Patent and Trademark Office).

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.<sup>3</sup>

#### STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994). And the regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.<sup>4</sup>,<sup>5</sup>

Moreover, the Office has set forth in the Commentary at MPEP §711.03(c)(I) the showing and timeliness requirements for a proper showing for relief under 37 C.F.R. §1.181 in these matters.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies

<sup>&</sup>lt;sup>3</sup> <u>See</u> supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. <u>See Changes to Patent Practice and Procedure</u>, 62 <u>Fed. Reg.</u> at 53160 and 53178, 1203 <u>Off. Gaz. Pat. Office</u> at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §11.18, formerly §10.18, to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

<sup>&</sup>lt;sup>4</sup> See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))

#### Application No. 11/384,223

and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.<sup>6</sup>

# As to Allegations of Unintentional Delay

As indicated above, the requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a proper reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

It appears that the requirements under the rule have been satisfied.

#### **CONCLUSION**

Accordingly, the petition pursuant to 37 C.F.R. §1.137(b) is granted.

The instant application is released to the Technology Center/AU 2876 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

<sup>6</sup> In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

# Application No. 11/384,223

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2<sup>7</sup>) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./ John J. Gillon, Jr. Senior Attorney Office of Petitions

<sup>7</sup>The regulations at 37 C.F.R. §1.2 provide: §1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attdance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MARTIN D. MOYNIHAN d/b/a PRTSI, INC. P.O. BOX 16446 **ARLINGTON VA 22215** 

MAILED

SEP 1 2 2011

OFFICE OF PETITIONS

In re Application of

FURMAN et al.

Application No. 11/384,328 : DECISION ON PETITION Filed: March 21, 2006 : UNDER 37 CFR 1.78(a)(3)

Attorney Docket No.: 42803

This is a decision on the petitions under 37 CFR 1.78(a)(6), filed June 27, 2011, which has been treated as a petition under 37 CFR 1.78(a)(3), to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to prior-filed international Application No. PCT/IL2004/00878, filed September 22, 2004.

#### The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted:
- the surcharge set forth in § 1.17(t); and **(2)**
- a statement that the entire delay between the date the **(3)** claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37

CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon.

A corrected Filing Receipt, which includes the priority claim to the prior-filed international application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Jose' G Dees at (571) 272-1569. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 2887 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed application.

**Boris Milef** 

**PCT Legal Examiner** 

Office of PCT Legal Administration

ATTACHMENT: Corrected Filing Receipt



#### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE UNITED STATES DEFARIMENT OF COMMIT United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Vignia 22313-1450 www.uspto.gov

FILING or GRP ART APPLICATION FIL FEE REC'D ATTY.DOCKET.NO TOT CLAIMS IND CLAIMS 371(c) DATE NUMBER UNIT 11/384,328 03/21/2006 2887 42803 20 850

67801 MARTIN D. MOYNIHAN d/b/a PRTSI, INC. P.O. BOX 16446 ARLINGTON, VA 22215

**CONFIRMATION NO. 2575 CORRECTED FILING RECEIPT** 



Date Mailed: 09/08/2011

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

Applicant(s)

Lilach Furman, Petah Tikva, ISRAEL; Efrat Feinberg, Herzelia, ISRAEL;

**Power of Attorney:** 

Martin Moynihan--40338

Domestic Priority data as claimed by applicant

This application is a CON of PCT/IL2004/000878 09/22/2004

Foreign Applications (You may be eligible to benefit from the Patent Prosecution Highway program at the USPTO. Please see <a href="http://www.uspto.gov">http://www.uspto.gov</a> for more information.) ISRAEL 158,048 09/22/2003

If Required, Foreign Filing License Granted: 04/12/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/384,328** 

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

\*\* SMALL ENTITY \*\*

Title

READING DEVICE

**Preliminary Class** 

235

#### PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

#### LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

#### **GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

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#### **NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
11/384,429	03/21/2006	Prem Gururajan	P1073US00	3004	
39500 Anglehart et al	7590 02/14/20	I	EXAMINER		
Suite 258		MOSSER, ROBERT E			
393 St-Jacques Montreal, QC		ART UNIT	PAPER NUMBER		
CANADA		3714			
			NOTIFICATION DATE	DELIVERY MODE	
			02/14/2011	ELECTRONIC	

# Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

james.anglehart@anglehart.et-al.ca martine@anglehart.et-al.ca





Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.usplo.gov

**DECISION ON PETITION** 

Anglehart et al.
Suite 258
393 St-Jacques
Montreal QC H2Y 1N9 CA CANADA

In re Application of:

GURURAJAN, PREM et al

Appl. No.: 11/384,429

Filed: March 21, 2006

Attorney Docket No. P1073US00

For:

GAMING OBJECT POSITION ANALYSIS

AND TRACKING

This is a decision on the petition filed on February 1, 2011 by which petitioners request supervisory review and withdrawal of the finality of the Office action dated December 8, 2010. The petition is considered pursuant to 37 CFR § 1.181, and no fee is required.

#### The petition is <u>dismissed</u>.

A review of the relevant prosecution history shows that the applicant filed a RCE on October 9, 2010 with amendment to independent claims 1, 4, 7, 17, 19, 22, 25, 28, 30-34 and 38-40. The RCE was properly filed in accordance with the 37 CFR § 1.114 and MPEP § 706.07(h). On December 8, 2010, the examiner issued a first Office action final rejection to the RCE. The examiner finally rejected all pending claims 1, 4-22 and 25-44 under applicable sections of 35 U.S.C. §103 based on Blackjack Tracking System by Wesley Cooper dated April 2004 referenced as BTS in view of Tran et al (US 2005/0272501).

On Feb. 1, 2011, the petitioner filed the current petition requesting supervisory review of the propriety of the final rejection and withdrawal of the finality of the office action dated December 8, 2010 pursuant to MPEP § 706.07(b). The petitioner is of the opinion that the first Office action final rejection of December 8, 2010 was improper under MPEP § 706.07(b), claims filed in the amendment of October 9, 2010 could not have been made in response to the final rejection of April 13, 2010. Petitioner also questions the propriety of the rejection regarding the definition of the points of contour test in the newly amended claims.

It is noted that the independent method and apparatus claims include the amended features as to obtaining a contour, determining and defining position features, etc. On December 8, 2010, the Examiner issued a first Office action that was made final. On pages 3-7 of the final rejection of December 8, 2010, the examiner provided detailed explanation as how the prior art references were read on the claims.

#### Analysis of Application Record

In the earlier final rejection of April 13, 2010, claims 1, 4-22 and 25-44 were rejected under 35 U.S.C. § 103(a) as unpatentable over Blackjack Tracking System by Wesley Cooper dated April 13, 2010, referenced as BTS in view of Tran et al (US 2005/0272501). On June 22, 2010, an interview was conducted between the examiner and the applicant's attorney without any agreement. In response to the final rejection of April 13, 2010, on October 9, 2010 the applicant filed the current RCE with an amendment to amend all independent claims and many dependent claims. Apparently, the claims as amended in the amendment of October 9, 2010 fail to define over the prior art references. The first Office action final rejection was issued on December 8, 2010. This final rejection is based on the same prior art references under the same applicable statutes of 35 USC § 103 with the contents substantially the same as the previous final rejection mailed April 13, 2010.

Petitioner opines that the amendment would not have been properly finally rejected on the grounds and art of record in the next Office action because the applicant could not have made the amendment of October 9, 2010 prior to the final rejection of April 13, 2010. Petitioner also questions the propriety of the rejection of the claims regarding the contour test is not an equivalent of the previous limitations of interpolating and analyzing. The amended claims are distinguishable over the prior art references. This line of argument is not convincing because the final rejection of December 8, 2010 was based on the same prior art references under the same applicable statutes of 35 U.S.C. §103 with the contents substantially the same as the previous final rejection mailed April 13, 2010. This clearly shows the amendment filed with the RCE on October 9, 2010 is directed to the same invention as claimed previously.

Petitioner questions the propriety of the examiner's rejection of the claims regarding the contour test. The disagreement with the examiner's position and the interpretation of the claim limitations as set forth in the petition is clearly appealable and not petitionable matters. As such, the petition will not be decided by this decision under 37 CFR § 1.181(a) (1)<sup>1</sup>. The issue presented here by petitioner is clearly directed to the propriety of the examiner's rejection of the claims under 35 U.S.C. § 103. The question of whether claims 1, 4-22 and 25-44 should be rejected under 35 U.S.C. § 103 or not is an appealable issue under 37 CFR 41.31(a) (1). After the review of the final Office action of December 8, 2010, the examiner's Office action does comply with the USPTO rules and regulations. The Office action of December 8, 2010 stands. Petitioner is reminded that the period to respond to the outstanding final Office action remains unchanged.

<sup>&</sup>lt;sup>1</sup> 37 CFR § 1.181 Petition to the Director. (a) Petition may be taken to the Director: (1)From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

#### **Decision**

Based on the analysis of record, when the examiner promulgated the first Office action final rejection of December 8, 2010, the conditions set forth in MPEP § 706.07(b)<sup>2</sup> were met. In particular, the amended claims in the amendment of October 9, 2010, in fact, are directed to the same invention as the claims in the earlier amendment filed on Jan. 30, 2010 as indicated by the scope of the claims and the contents of the rejections. The claims in the amendment of October 9, 2010 would have been properly finally rejected on the same grounds and art of record in the next Office action if they had been filed earlier. Therefore, under MPEP § 706.07(b) the first action final rejection of December 8, 2010 is deemed proper.

For the foregoing reasons it appears that the examiner did not abuse his discretion, or act in an arbitrary or capricious manner, in making the December 8, 2010 Office action final. Therefore, there is no basis for granting any of the relief requested.

The application is being forwarded to the examiner via the Supervisory Patent Examiner of Art Unit 3714 awaiting a response to the outstanding Office action mailed on December 8, 2010. Petitioner may file a request for reconsideration of this decision, without fee. However, such request must be filed within two months of the date of this decision. See 37 CFR § 1.181(f). The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. No extension of time under 37 CFR 1.136(a) is permitted.

Should petitioner have any further questions, he is invited to contact Henry Yuen, TC 3700 SPRE, at 571-272-4856.

PETITION DISMISSED

Donald T. Hajec, Director Technology Center 3700

<sup>&</sup>lt;sup>2</sup> 706.07(b) Final Rejection, When Proper on First Action [R-1]The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. A first Office action in a continuing or substitute application may not be made final if it contains a new ground of rejection necessitated by the amendments to 35 U.S.C. 102 (e) by the Intellectual Property and High Technology Technical Amendments of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)). However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised. Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application. A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted.



#### UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/384,429	03/21/2006	Prem Gururajan	P1073US00	3004
39500 Anglehart et al	7590 03/07/2011	EXAMINER		
Suite 258		MOSSER, ROBERT E		
393 St-Jacques Montreal, QC l			ART UNIT	PAPER NUMBER
CANADA		3714		
	•			
			NOTIFICATION DATE	DELIVERY MODE
			03/07/2011	ELECTRONIC

#### Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

james.anglehart@anglehart.et-al.ca martine@anglehart.et-al.ca

# United States Patent and Trademark Office



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.go

Anglehart et al.
Suite 258
393 St-Jacques
Montreal QC H2Y 1N9 CA CANADA

In re Application of: GURURAJAN, PREM et al

Appl. No.: 11/384,429

Filed: March 21, 2006

Attorney Docket No: P1073YS00

For: GAMING OBJECT POSITION ANALYSIS

AND TRACKING

DECISION ON PETITION

This is a decision on the renewed petition filed on February 22, 2011 by which petitioners request reconsideration of the earlier decision mailed on February 14, 2011 to withdraw the finality of the Office action dated December 8, 2010. The petition is considered pursuant to 37 CFR § 1.181, and no fee is required.

#### The petition is denied.

A review of the relevant prosecution history shows that the applicant filed a RCE on October 9, 2010 with amendment to independent claims 1, 4, 7, 17, 19, 22, 25, 28, 30-34 and 38-40. The RCE was properly filed in accordance with the 37 CFR § 1.114 and MPEP § 706.07(h). On December 8, 2010, the examiner issued a first Office action final rejection to the RCE. The examiner finally rejected all pending claims 1, 4-22 and 25-44 under applicable sections of 35 U.S.C. §103 based on Blackjack Tracking System by Wesley Cooper dated April 2004 referenced as BTS in view of Tran et al (US 2005/0272501).

On Feb. 1, 2011, petitioner filed a petition requesting supervisory review of the propriety of the final rejection and withdrawal of the finality of the Office action dated December 8, 2010 pursuant to MPEP § 706.07(b). The petitioner is of the opinion that the first Office action final rejection of December 8, 2010 was improper under MPEP § 706.07(b), claims filed in the amendment of October 9, 2010 could not have been made in response to the final rejection of April 13, 2010. Petitioner also questions the propriety of the rejection regarding the definition of the points of a contour test in the newly amended claims.

It is noted that the independent method and apparatus claims include the amended features as to obtaining a contour, determining and defining position features, etc. On December 8, 2010, the Examiner issued a first Office action that was made final. On pages 3-7 of the final rejection of December 8, 2010, the examiner provided detailed explanation as how the prior art references were read on the claims.

In response to the petition filed on February 1, 2011, the Director concurred with the examiner's final rejection. A dismissal decision was mailed on February 14, 2011.

On February 2, 2011, a renewed petition was filed requesting reconsideration of the earlier dismissal decision.

# **Analysis of Application Record**

In the renewed petition, petitioner believes that during the interview with the examiner on June 22, 2010, it was understood that the amendment filed with the RCE on October 9, 2010 could not have been entered after final because the amended claim 1 involved restructuring of claim 1 as filed on January 30, 2010. Petitioner opines that the applicant could not have made the amendment of October 9, 2010 prior to the final rejection of April 13, 2010. Petitioner now argues that the first action final rejection of December 8, 2010 is improper and does not comply with under MPEP 706.07(b)<sup>1</sup>. This line of arguments is not convincing. On June 22, 2010, an interview was conducted between the examiner and the applicant's attorney without any agreement. In response to the final rejection of April 13, 2010, on October 9, 2010 the applicant filed the current RCE with an amendment to amend all independent claims and many dependent claims. Apparently, the claims as amended in the amendment of October 9, 2010 fail to define over the prior art references. This clearly shows the amendment filed with the RCE on October 9, 2010 is directed to the same invention as claimed previously. Subsequently, the first Office action final rejection was issued on December 8, 2010. This final rejection is based on the same prior art references under the same applicable statutes of 35 USC § 103 with the contents substantially the same as the previous final rejection mailed April 13, 2010. Therefore, the final rejection of December 8, 2010 is proper in accordance with rules and regulations.

A further review of the interview record of June 29, 2010 and the applicant's response filed on October 9, 2010 still does not show any denial of entry of any submitted amendment nor proposed amendment in the notice of interview summary. There is no indication on the record that any proposed amendments would overcome the rejection of record. The applicant's

<sup>&</sup>lt;sup>1</sup> 706.07(b) Final Rejection, When Proper on First Action [R-1]The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. A first Office action in a continuing or substitute application may not be made final if it contains a new ground of rejection necessitated by the amendments to 35 U.S.C. 102 (e) by the Intellectual Property and High Technology Technical Amendments of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)). However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised. Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application. A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted.

summary of the interview, presented in the applicant's subsequent remarks submitted on October 9, 2010 makes no reference to any denial of entry of amendment after final perceived or otherwise. Petitioner's arguments that any denial of entry of proposed amendments (perceived or actual) was understood by the parties is not evidenced by the record and therefore not supported. After the review of the entire file records, the examiner's final Office action does comply with the MPEP 706.07(b). The final rejection of December 8, 2010 stands. Petitioner is reminded that the period to respond to the outstanding final Office action remains unchanged.

#### Conclusion

For the forgoing reasons, when the examiner promulgated the first Office action final rejection of December 8, 2010, the conditions set forth in MPEP § 706.07(b) were met. In particular, the amended claims in the amendment of October 9, 2010, in fact, are directed to the same invention as the claims in the earlier amendment filed on Jan. 30, 2010 as indicated by the scope of the claims and the contents of the rejections. The claims in the amendment of October 9, 2010 would have been properly finally rejected on the same grounds and art of record in the next Office action if they had been filed earlier. Therefore, under MPEP § 706.07(b) the first action final rejection of December 8, 2010 is proper. The renewed petition fails to add anything new that is persuasive to cause reversal of the previous decision. The relief requested by petitioner to withdraw the finality of the final Office action will not be granted. The decision is maintained

The application is being forwarded to the examiner via the Supervisory Patent Examiner of Art Unit 3714 awaiting a response to the outstanding Office action mailed on December 8, 2010. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181" and directed to the Office of the Deputy Commissioner for Patent Examination Policy at Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. See MPEP 1002.02(b).

Any inquiry regarding this decision should be directed to Henry Yuen, Special Program Examiner, at (571) 272-4856.

PETITION DENIED.

Donald T. Hajec, Director Technology Center 3700



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413

# MAILED

JAN 202011

#### OFFICE OF PETITIONS

In re Patent of Blaudin De The et al.

Patent No. 7,622,266

Issue Date: November 24, 2009

Application No. 11/384,481 Filing Date: March 21, 2006

Attorney Docket No. 03495.0059-20

DECISION ON REQUEST

FOR RECONSIDERATION OF

PATENT TERM ADJUSTMENT AND NOTICE OF INTENT TO

ISSUE CERTIFICATE OF

CORRECTION

This is a decision on the petition filed January 20, 2010, which is being treated as a petition under 37 C.F.R. § 1.705(d) requesting the patent term adjustment indicated on the patent be corrected to indicate the term of the patent is extended or adjusted by seven hundred forty-six (746) days.

The petition to correct the patent term adjustment indicated on the patent to indicate the term of the patent is extended or adjusted by seven hundred forty-six (746) days is **GRANTED to the extent indicated herein**.

The Office will *sua sponte* issue a certificate of correction setting forth a patent term adjustment determination of <u>371 days</u>. Pursuant to 37 C.F.R. § 1.322, the Office will not issue a certificate of correction without first providing an assignee or a patentee an opportunity to be heard. Accordingly, Patentees are given **one** (1) **month or thirty** (30) **days**, whichever is longer, from the mail date of this decision to respond. Extensions of time will not be granted under 37 C.F.R. § 1.136.

No portion of this decision should be construed as a waiver of the requirement, set forth in 35 U.S.C. § 154(b)(4), that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. § 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The patent sets forth a patent term adjustment of 357 days, which is the sum of 516 days of delay under 37 C.F.R. § 1.703(a) ("A Delay") and 248 days of delay under 37 C.F.R. § 1.703(b) ("B Delay") reduced by 248 days of overlap between the periods of A Delay and B Delay ("Overlap") and reduced by 131 days of delay under 37 C.F.R. § 1.704 ("Applicant Delay").

Patentees contend the correct patent term adjustment is 746 days, which is the sum of 516 days of A Delay and 248 days of B Delay reduced by 18 days of Applicant Delay.

## A Delay

The Office previously determined the total period of A Delay is 516 days, which includes:

- 1. 94 days of delay under 37 C.F.R. § 1.703(a)(2), and
- 2. 422 days of delay under 37 C.F.R. § 1.703(a)(6).

Patentees agree the total period of A Delay is 516 days.

# **B** Delay

Patentees assert, and the Office agrees, the period of B Delay is 248 days.

## Overlap

The Office previously determined the period of Overlap is 248 days.

Patentees implicitly assert the period of Overlap is 0 days.

The period of A Delay includes a 422-day time period beginning September 29, 2008, and ending November 24, 2009.

The period of B Delay consists of a 248-day time period beginning March 22, 2009, and ending November 24, 2009.

The period of A Delay and the period of B Delay include the 248-day time period beginning March 22, 2009, and ending November 24, 2009. Therefore, the period of overlap is 248 days.

## **Applicant Delay**

The Office's PALM system previously determined the total period of Applicant Delay is 159 days, which consisted of:

- 1. 11 days of delay under 37 C.F.R. § 1.704(b) based on the submission of a reply to an Office action on July 30, 2007,
- 2. 28 days of delay under 37 C.F.R. § 1.704(c)(10) based on the submission of a letter on April 28, 2008,
- 3. 7 days of delay under 37 C.F.R. § 1.704(c)(10) based on the submission of a substitute specification, and
- 4. 113 days of delay under 37 C.F.R. § 1.704(c)(10) based on the submission of substitute drawings.

Patentees assert the correct period of Applicant Delay is 18 days, which consists of:

1. 11 days of delay under 37 C.F.R. § 1.704(b) based on the submission of a reply to an Office action on July 30, 2007, and

2. 7 days of delay under 37 C.F.R. § 1.704(c)(10) based on the submission of a substitute specification.

# Applicant Delay - Issue 1

Patentees' calculation of Applicant Delay does not include a 28-day reduction in patent term adjustment entered by the Office. Therefore, the Office will assume Patentees dispute the propriety of the reduction.

The Office mailed a Notice of Allowance on March 3, 2008.

Office PALM records indicate a "Miscellaneous Incoming Letter" was filed April 28, 2008.

The Office entered a 28-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(10) based on the submission of the April 28, 2008 letter.

The electronic file wrapper does not include a copy of any paper filed April 28, 2008. The file wrapper does not include any Office communication responding to, or even referencing, any paper filed April 28, 2008.

Since a paper does not actually appear to have been filed on April 28, 2008, the 28-day reduction in patent term adjustment was improper.

#### Applicant Delay - Issue 2

Patentees' calculation of Applicant Delay does not include a 113-day reduction in patent term adjustment entered by the Office. Therefore, the Office will assume Patentees dispute the propriety of the reduction.

The Office mailed a Notice of Allowance and a Notice of Allowability on March 3, 2008. The Notice of Allowability required the submission of a substitute specification.

Patentees submitted the following items on May 28, 2008:

- 1. Issue Fee,
- 2. Letter titled "Submission of Substitute Specification,"
- 3. Substitute specification,
- 4. Letter titled "Submission of Substitute Drawings," and
- 5. Substitute drawings.

The Office mailed a Response to Rule 312 Communication on June 3, 2008. The response indicated the "amendment filed on 28 May 2008 under 37 CFR 1.312 has been considered, and has been ... entered."

The Office entered a 7-day reduction in patent term adjustment based on the submission of the substitute specification and a 113-day reduction in patent term adjustment based on the submission of the substitute drawings.

# 37 C.F.R. § 1.704(c)(10) states,

[Upon] [s]ubmission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed ... the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
- (ii) Four months.

The June 3, 2008 response mailed by the Office appears to be a response to the submission of the substitute specification *and* the submission of the substitute drawings. Therefore, the 113-day reduction based on the submission of the drawings was improper.

# Applicant Delay - Issue 3

Patentees filed a letter titled "Peer to Patent Consent Form" on September 26, 2008. The letter was accompanied by a form titled "Applicant's Consent to Third-Party Comments in Published Applications and Consent to Pilot Participation."

The Office issued a response to the September 26, 2008 communication on April 30, 2009. The response stated the request to include the application in the Peer Reviewed Prior Art Pilot Project was not approved because the application is not classified in Technology Center 3600 or classified in any of the classes in Technology Centers 2100 and 2400 identified in the response.

The September 26, 2008 communication was filed after the Office issued the March 3, 2008 Notice of Allowance. Therefore, a reduction in patent term adjustment is warranted under 37 C.F.R. § 1.704(c)(10).

The number of days of the reduction is the lesser of:

- 1. The number of days beginning September 26, 2008, the date the communication was filed, and ending April 30, 2009, or
- 2. Four months.

The time period beginning September 26, 2008, and ending April 30, 2009, is longer than four months, therefore the proper reduction under 37 C.F.R. § 1.704(c)(10) is 120 days.

#### Applicant Delay - Issue 4

Patentees filed a status letter on October 29, 2009.

On November 4, 2009, the Office mailed an Issue Notification stating the application would issue as a patent on November 24, 2009.

Clarification of the Office's interpretation of the scope of 37 C.F.R. § 1.704(c)(10) is set forth in Manual of Patent Examining ("MPEP") § 2732 (8th ed., Rev. 7, July 2008). MPEP § 2732 states, with emphasis added,

37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application....

Papers that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include:

- (1) a request for a refund;
- (2) <u>a status letter</u>;
- (3) amendments under 37 CFR 1.312;
- (4) late priority claims;
- (5) a certified copy of a priority document;
- (6) drawings;
- (7) letters related to biologic deposits; and
- (8) oaths or declarations.

As indicated in the quoted language above, a status letter filed after allowance will result in a reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(10).

The number of days beginning October 29, 2009, the date the status letter was filed, and ending November 4, 2009, the date the Office mailed the Issue Notification, is 7 days. Therefore, a 7-day reduction in patent term adjustment is warranted under 37 C.F.R. § 1.704(c)(10) as a result of the submission of the status letter.

## Conclusion

The total period of A Delay is 516 days.

The period of B Delay is 248 days.

The period of Overlap is 248 days.

The total period of Applicant Delay is 145 days, which consists of:

- 1. 11 days of delay under 37 C.F.R. § 1.704(b) based on the delay in the filing of the July 30, 2007 reply to an Office action,
- 2. 7 days of delay under 37 C.F.R. § 1.704(c)(10) based on the submission of a substitute specification and substitute drawings on May 28, 2008,
- 3. 120 days of delay under 37 C.F.R. § 1.704(c)(10) based on the submission of the September 26, 2008 communication, and
- 4. 7 days of delay under 37 C.F.R. § 1.704(c)(10) based on the status letter filed October 29, 2009.

Patent No. 7,622,266

The proper patent term adjustment is 371 days, which is the sum of 516 days of A Delay and 248 days of B Delay reduced by 248 days of Overlap and reduced by 145 days of Applicant Delay.

The Office acknowledges submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the patent is extended or adjusted by **three hundred seventy-one (371)** days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley Senior Petitions Attorney

Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

# UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

PATENT NO.

7,622,266 B2

APPLICATION NO. : INVENTOR(S)

11/384,481

DATED

November 24, 2009

Hugues Blaudin de The et al.

**DRAFT** 

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the Title page,

[\*] Notice:

Subject to any disclaimer, the term of this patent is extended or adjusted under

35 U.S.C. 154(b) by 357 days.

Delete the phrase "by 357 days" and insert -- by 371 days--



FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 MAILED
APR 0 4 2011
OFFICE OF PETITIONS

In re Patent of Blaudin De The et al.

Patent No. 7,622,266

Issue Date: November 24, 2009 Application No. 11/384,481

Filing Date: March 21, 2006

Attorney Docket No. 03495.0059-20

DECISION ON REQUEST

FOR RECONSIDERATION OF

PATENT TERM ADJUSTMENT

AND NOTICE OF INTENT TO

ISSUE CERTIFICATE OF

CORRECTION

This is a decision on the petition filed February 16, 2011, which requests reconsideration of a decision mailed by the Office on January 20, 2011.

## The petition is granted.

On January 20, 2011, the Office issued on a petition under 37 C.F.R. § 1.705(d). The decision stated,

The proper patent term adjustment is 371 days, which is the sum of 516 days of A Delay and 248 days of B Delay reduced by 248 days of Overlap and reduced by 145 days of Applicant Delay.

The decision indicated the 145 days of Applicant Delay included "120 days of delay under 37 C.F.R. § 1.704(c)(10) based on the submission of the September 26, 2008 communication" discussed in the decision.

The instant petition disputes the propriety of the 120-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(10).

The inventor, filing date, art unit, and confirmation number identified on the September 26, 2008 communication are different than the inventors, filing date, art unit, and confirmation number for the instant case and the petition states the attorney who filed the September 26, 2008 communication, Susan Murray is not associated with the instant case.

The application number listed on the September 26, 2008 communication appears to have been the result of an error by Ms. Murray. A review of Office records strongly suggests Ms. Murray actually intended to file the communication in Application No. 11/383,481.

In view of the facts in this case, the Office agrees a 120-day reduction in patent term adjustment based on the submission of the September 26, 2008 communication is not warranted.

The proper patent term adjustment is 491 days, which is the sum of 516 days of A Delay and 248 days of B Delay reduced by 248 days of Overlap and reduced by 25 days of Applicant Delay.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the patent is extended or adjusted by **four hundred ninety-one (491)** days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley Senior Petitions Attorney

Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

# UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

PATENT NO.

7,622,266 B2

APPLICATION NO. :

11/384,481

DATED

November 24, 2009

**DRAFT** 

INVENTOR(S)

Hugues Blaudin de The et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the Title page,

[\*] Notice:

Subject to any disclaimer, the term of this patent is extended or adjusted under

35 U.S.C. 154(b) by 357 days.

Delete the phrase "by 357 days" and insert -- by 491 days--

SMITH PATENT OFFICE 1901 PENNSYLVANIA AVENUE N W SUITE 901 WASHINGTON DC 20006

MAILED

FEB 10 2012

**OFFICE OF PETITIONS** 

In re Application of

Kubo et al.

Application No. 11/384550

Filing or 371(c) Date: 03/21/2006

Attorney Docket Number:

Attorney Docket Number

0085/023001

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 12, 2012, to revive the above-identified application.

# The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of February 4, 2011. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). Applicant filed a reply on July 5, 2011; however, the reply failed to place the application in condition for allowance. Accordingly, the date of abandonment of this application is July 6, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee (and the submission required by 37 CFR 1.114); (2) the petition fee; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.

The application is being referred to Technology Center AU 2625 for processing of the RCE, and for appropriate action on the Amendment by the Examiner in the normal course of business.

/DLW/

Derek L. Woods Attorney Office of Petitions



MAILED

NOV 0 1^2011

OFFICE OF PETITIONS

PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A. 4800 IDS CENTER 80 SOUTH 8<sup>TH</sup> STREET MINNEAPOLIS MN 55402-2100

In re Patent No. 7, 387,286

Issue Date: June 17, 2008

Application No. 11/384,604

Filed: March 20, 2006

Attorney Docket No. 3156.13US03

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to Diane Goodwyn at (571) 272-6735.

Thurman K. Page

Petitions Examiner
Office of Petitions

## UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

WYATT, GERBER & O'ROURKE, L.L.P. 99 PARK AVENU **NEW YORK NY 10016** 

MAILED FEB 13 2012 OFFICE OF PETITIONS

**DECISION ON PETITION** 

In re Patent No. 7,305,329

Issue Date: December 04, 2007

Application No. 11/384,606

Filed: March 20, 2006

Attorney Docket No.

This is a decision on the petition under 37 CFR 1.378(c), filed January 18, 2012, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on December 04, 2011 for failure to pay the three and one-half year maintenance fee. Since this petition was submitted within twenty-four months after the sixmonth grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4231.

The patent file is being forwarded to Files Repository.

/Michelle R. Eason/ Michelle R. Eason Paralegal Specialist Office of Petitions



TAYLOR IP, P.C. P.O. Box 560 142. S Main Street Avilla IN 46710

MAILED
FEB 0 7 2012
OFFICE OF PETITIONS

In re Patent No. 7,405,809

Issued: 07/29/2008

Application No. 11/384,636

Filed: 03/21/2006

Attorney Docket No. AKL0004.US

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed January 19, 2012.

The Office no longer investigates or rejects original or reissue patent under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3211.

/Christina Tartera Donnell/

Christina Tartera Donnell Senior Petitions Attorney Office of Petitions

Doc Code: PET.AUTO Document Description: Petition	n automatically granted by EFS-Web	PTO/SB/83 U.S. Patent and Trademark Office Department of Commerce			
Electronic Petition Request	c Petition Request REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS				
Application Number	11384662				
Filing Date	20-Mar-2006	20-Mar-2006			
First Named Inventor	Joseph Lorkovic				
Art Unit	2423	2423			
Examiner Name	RICKY CHIN				
Attorney Docket Number	NDCTV.001A				
Title  Dual display interactive video					
of record.  The reason(s) for this request ar  10.40(b)(4)	torney or agent for the above identified pate re those described in 37 CFR:	ын аррисацон ана ан те ргасицонегs			
Certifications					
intend to withdraw from er		•			
I/We have delivered to the to which the client is entitle		e client all papers and property (including funds)			
✓ I/We have notified the clie	nt of any responses that may be due and the tim	ne frame within which the client must respond			
Change the correspondence add properly made itself of record pu	ress and direct all future correspondence to the rsuant to 37 CFR 3.71:	first named inventor or assignee that has			
Name	Joe Lorkovic				
Address	4079 Governor Dr. #158				
City	San Diego				
State	CA				
Postal Code	92122				

I am authorized to sign on behalf of myself and all withdrawing practitioners.			
Signature	/Joshua Schoonover/		
Name Joshua Schoonover			
Registration Number	63294		



# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Decision Date: October 25,2011

In re Application of : DECISION ON REQUEST TO WITHDRAW AS

Joseph Lorkovic ATTORNEY/AGENT OF RECORD

Application No: 11384662

Filed: 20-Mar-2006

Attorney Docket No: NDCTV.001A

This is an electronic decision on the Request to Withdraw as attorney or agent of record under 37 CFR.§ 1.36(b), filed October 25,2011

#### The request is **APPROVED**

The request was signed by Joshua Schoonover (registration no. 63294) on behalf of all the attorneys/agents of record. All attorneys/agents of record have been withdrawn.

Since there are no remaining attorneys of record, all future communications from the Office will be directed the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 with correspondence address:

Name Joe Lorkovic

Name2

Address 1 4079 Governor Dr. #158

Address 2

City San Diego

State CA

Postal Code 92122

Country US

As a reminder, requester is required to inform the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 of the electronically processed petition.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

Office of Petitions



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.usplo.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
11/384,706	03/20/2006	Chunxin Ji	GP-305806	806 9221	
65798 MILLER IP Gl	7590 08/03/2010 ROUP PLC		EXAM	INER	
GENERAL MOTORS CORPORATION			CANTELMO, GREGG		
42690 WOOD' SUITE 200	WARD AVENUE		ART UNIT	PAPER NUMBER	
BLOOMFIELD HILLS, MI 48304			1795		
			MAIL DATE	DELIVERY MODE	
			08/03/2010	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



wk

Mailed:

In re application of Chunxin Ji et al. Serial No. 11/384,706

Filed: March 20, 2006

For: ACRYLIC FIBER BONDED CARBON FIBER

PAPER AS GAS DIFFUSION MEDIA FOR FUEL

**CELL** 

DECISION ON PETITION

This is a response to Applicants Petition To Review Objection filed March 12, 2010.

In the Office Action mailed June 19, 2009, the Examiner objected to claims 8, 14 and 23 under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner maintained the objection in the Final Office Action mailed December 10, 2009.

AUG - 3 2010

One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. Dependent claims 8 (depends from claim 1), 14 (depends from claim 9) and 23 (depends from claim 15) all claim that the gas diffusion layer is incorporated into a proton exchange membrane fuel cell. Independent claims 1 and 9 are directed to a gas diffusion layer for a fuel cell and independent claim 15 is a method for making a gas diffusion layer. The Examiner's position is that claims 8, 14 and 23 recite the use of the gas diffusion layer and do not further limit the gas diffusion layer. Note, that although 37 CFR 1.75(c) requires the dependent claim to further limit a preceding claim, this rule does not apply to product-by-process claims.

The Examiner refers to claim 1 as being a product by process claim (Final Office Action pages 8-11). The Examiner asserts in the Final Office Action that having a gas diffusion layer incorporated into a proton exchange membrane cell fails to impart any structural features. Applicants argue that the dependent claims contain a further structural limitation in that the claims require that proton exchange membrane type fuel cell be part of the claimed structure. When evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.

The position of the Applicant that the claims language referred to by the Examiner has patentable weight because it precisely defines structural attribute and a particular capability or purpose of the claimed invention. The position that Applicants set forth is reasonable.

Serial Number: 11/384,706

# **DECISION**

The Petition is **GRANTED**.

The Examiner is directed to withdraw the objection to claims 8, 14 and 23.

/W. GARY JONES/
W. Gary Jones, Director
Technology Center 1700
Chemical and Materials Engineering

John A. Miller MILLER IP GROUP, PLC GENERAL MOTORS CORPORATION 42690 WOODWARD AVENUE SUITE 200 BLOOMFIELD HILLS MI 48304 Doc Code: PET.PTA.RCAL

**Document Description: Request for Recalculation in view of Wyeth** 

Approved for use through 02/28/2011. OMB 0651-0020

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

Attorney Docket Patent Number: 7,660,364 TI-35616 Number: Filing Date Issue Date: 02/09/2010 (or 371(b) or (f) Date): 03-20-2006

First Named

Harald Sandner Inventor:

Title: METHOD OF TRANSMITTING A SERIAL BIT-STREAM AND ELECTRONIC TRANSMITTER FOR TRANSMITTING A SERIAL BIT-STREAM

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-WYETH INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

Signature / Wade J. Brady III /	Date August 2, 2010
Name (Print/Typed) Wade J. Brady III	Registration Number 32,080
(i illib i yped)	Negistration Number

Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature,

~	*Total of1	forms are submitted
---	------------	---------------------

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/12/2010

TEXAS INSTRUMENTS INCORPORATED P O BOX 655474, M/S 3999 DALLAS, TX 75265

Applicant : Harald Sandner

Patent Number: 7660364 : 02/09/2010 Issue Date Application No: 11/384,731 Filed : 03/20/2006

: DECISION ON REQUEST FOR : RECALCULATION of PATENT : TERM ADJUSTMENT IN VIEW : OF WYETH AND NOTICE OF INTENT TO

: ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 897 days. The USPTO will sua sponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



# UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS UNITED STATES PATENT AND TRADEMARK OFFICE P.O. Box 1450 ALEXANDRIA, VA 22313-1450

Paper No.

CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD. 11TH FLOOR, SEVEN PENN CENTER 1635 MARKET STREET PHILADELPHIA PA 19103-2212

MAILED JAN 04-2011 OFFICE OF PETITIONS

In re Application of

Oury et al.

Application No. 11/384,763

Filed: March 20, 2006

Attorney Docket No. C1190/20017

Title: SUBLINGUAL COATED TABLET

OF FENTANYL

DECISION ON PETITION

PURSUANT TO

37 C.F.R. § 1.137(B)

This is a decision on the petition pursuant to 37 C.F.R. § 1.137(b), filed September 29, 2010, to revive the aboveidentified application.

:

This petition pursuant to 37 C.F.R. § 1.137(b) is GRANTED.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R § 1.113 in a timely manner to the final Office action mailed January 22, 2010, which set a shortened statutory period for reply of three months. final amendment was received on June 23, 2010 along with a three-month extension of time so as to make timely the response, and an advisory action was mailed on August 4, 2010. extensions of time under the provisions of 37 C.F.R § 1.136(a) were obtained, and no further responses were received. Accordingly, the above-identified application became abandoned on July 23, 2010. A notice of abandonment was mailed on August 20, 2010.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R.  $\S 1.17(m);$

- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

With this petition, Petitioner has submitted the petition fee, both a notice of appeal and the associated fee, a Pre-Appeal Brief Request for a Panel Review, and the proper statement of unintentional delay. The first three requirements of Rule 1.137(b) have been met. The fourth requirement of Rule 1.137(b) is not applicable, as a terminal disclaimer is not required.

The Technology Center will be notified of this decision. The Technology Center will then notify the Technology Center Art Unit supervisor of the examiner of record of this decision, so that a panel of examiners experienced in the field of technology can be designated, to review the applicant's remarks and the examiner's rejections. Petitioner may find it beneficial to view Private PAIR within a fortnight of the present decision to ensure that the revival has been acknowledged by the Technology Center in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Technology Center where that change of status must be effected - the Office of Petitions cannot effectuate a change of status.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.<sup>2</sup> All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

<sup>1</sup> See Rule 1.137(d).

<sup>2</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).





UNISYS CORPORATION
Office of the General Counsel
801 Lakeview Drive, Suite 100
MailStop: 2NW
BLUE BELL PA 19422

FEB 03 2012

OFFICE OF PETITIONS:

MAILED

In re Application of Mazzagatti Application No. 11/384,777 Filed: March 20, 2006 Attorney Docket No. TN452

**DECISION ON PETITION** 

This is in response to the papers filed January 18, 2011, which is being treated as a request to withdraw the holding of abandonment pursuant to 37 CFR 1.181. This decision will also address the petition under the unintentional provisions of 37 CFR 1.137(b), also filed on January 18, 2012.

The petition filed under 37 CFR 1.181 is **DISMISSED**. The petition filed under 37 CFR 1.137(b) is **GRANTED**.

This above-identified application became abandoned for failure to timely file a reply to a non-final Office action mailed May 11, 2010. The Office Action set a three (3) month shortened statutory period for reply. No timely extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on August 12, 2010. A Notice of Abandonment was mailed on January 3, 2011.

#### PETITION UNDER 37 CFR 1.181

In the present petition, petitioner states that they did not realize that the case has been abandoned. However, where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. Where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application.

It is further noted that 37 CFR 1.181(f) provides that, inter alia, except as otherwise provided, any petition not filed within 2 months from the action complained of may be dismissed as

untimely. This request was not submitted within two months of the abandonment of the application.

In view of the above, the application was properly held abandoned.

# PETITION UNDER 37 CFR 1.137(b)

The petition to revive the application under 37 CFR 1.137(b) is **GRANTED**.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the areply in the form of an amendment (2) the petition fee of \$1860.00, and (3) a statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3215.

This application is being referred to Technology Center AU 2168 for appropriate action by the Examiner in the normal course of business on the reply received

Charlema Grant

Attorney Advisor

Office of Petitions



#### UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MERCHANT & GOULD (MICROSOFT) P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903

MAILED JUL 14 2011

In re Application of

Arthur C. Leonard et al

Filed: March 20, 2006

Application No. 11/385,139

Attorney Docket No. 14917.0213USI1/314937.01

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition, filed July 12, 2011 under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

# The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on June 14, 2011 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 2432 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/ Irvin Dingle Petitions Examiner Office of Petitions

 $<sup>^{\</sup>mathrm{I}}$  The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).



MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C.

MAILED

One Financial Center BOSTON, MA 02111

AUG 1 6 2010

OFFICE OF PETITIONS

In re Patent of Thomas Najarian

**DECISION ON REQUEST** 

Patent No. 7,659,256

FOR RECONSIDERATION OF

Issue Date: February 9, 2010

PATENT TERM ADJUSTMENT

Application No. 11/385,199

AND NOTICE OF INTENT TO

Filing Date: March 20, 2006

ISSUE CERTIFICATE OF

Attorney Docket No. 79050-056003US

CORRECTION

This is a decision on the petition filed April 9, 2010, which is being treated as a petition under 37 C.F.R. § 1.705(d) requesting the patent term adjustment indicated on the patent be corrected to indicate the term of the patent is extended or adjusted by nine hundred nine (909) days.

The petition to correct the patent term adjustment indicated on the patent to indicate the term of the patent is extended or adjusted by nine hundred nine (909) days is **GRANTED**.

The Office acknowledges submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the patent is extended or adjusted by **nine hundred nine (909)** days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley Senior Petitions Attorney

Office of Petitions

Enclosure:

Copy of DRAFT Certificate of Correction

# UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

PATENT NO.

7,659,256 B2

APPLICATION NO. :

11/385,199

DATED

February 9, 2010

INVENTOR(S)

Thomas Najarian

**DRAFT** 

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the Title page,

[\*] Notice:

Subject to any disclaimer, the term of this patent is extended or adjusted under

35 U.S.C. 154(b) by 583 days.

Delete the phrase "by 583 days" and insert -- by 909 days--

DATE	10/13/09	Paper No.:
TO SPE OF	: ART UNIT <u>2//5</u>	1
SUBJECT	: Request for Certificate of Correc	ction for Appl. No.: 11/385853. Patent No.: 75908.
Please resp	ond to this request for a ce	rtificate of correction within 7 days.
FOR IFW F	ILES:	
the IFW app	ew the requested changes/o plication image. No new ma the claims be changed.	corrections as shown in the <b>COCIN</b> document(s) in atter should be introduced, nor should the scope or
Please com using docun	plete the response (see bel	low) and forward the completed response to scanning
FOR PAPE	R FILES:	
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•	•	Winging Tolkant
•		Virginia Tolbert
		Certificates of Correction Branch
	·	Certificates of Correction Branch 571-272-0460
	·	Certificates of Correction Branch 571-272-0460
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lote your decision	t for issuing the above-ide on the appropriate box.	Certificates of Correction Branch  571-272-0460  Thank You For Your Assista
lote your decision	on the appropriate box.	Certificates of Correction Branch  571-272-0460  Thank You For Your Assista  entified correction(s) is hereby:
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Note your decision	Approved Approved in Part Denied	Certificates of Correction Branch  571-272-0460  Thank You For Your Assista  entified correction(s) is hereby:  All changes apply.  Specify below which changes do not apply.  State the reasons for denial below.
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#### UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

HOWARD & HOWARD ATTORNEYS PLLC 450 West Fourth Street Royal Oak MI 48067

MAILED FEB 2 8 2011

**OFFICE OF PETITIONS** 

In re Application of

Michael Baumann et al.

Application No. 11/385,335 Filed: March 21, 2006

Attorney Docket No. 60,126-269

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 16, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Notice of Non-Compliant Amendment, mailed June 9, 2009, which set a shortened statutory period for reply of one (1) month or thirty (30) days whichever is longer. A five (5) months extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on December 10, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment (2) the petition fee of \$1,620, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571)272-4584.

This application is being referred to Technology Center AU 3752 for appropriate action by the Examiner in the normal course of business on the reply received.

Joanne Burke
Petitions Examiner
Office of Petitions



## UNITED STATES PATENT AND TRADEMARK OFFICE

\* COMMISSIONER FOR PATENTS UNITED STATES PATENT AND TRADEMARK OFFICE P.O. Box 1450 ALEXANDRIA, VA 22313-1450 www.uspto.gov

MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO IL 60661

MAILED OCT 06 2010 OFFICE OF PETITIONS

In re Patent No. 7,634,237 : DECISION ON REQUEST FOR

HARALABIDIS et al.

Issue Date: 12/15/2009

Application No. 11/385,401

Filed: 03/21/2006

Attorney Docket No. 17376US02 :

: RECONSIDERATION OF

PATENT TERM ADJUSTMENT

This is a decision on the petition filed on June 3, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the aboveidentified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by five hundred sixty-two (562) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is DISMISSED.

Patentee is given TWO (2) MONTHS from the mailing date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

37 CFR 1.703(b) indicates that the period of adjustment under 37 CFR 1.702(b) ("over three year period") is the number of days, if any, in the period beginning on the day after the date that is three years after the actual filing date of the application and ending on the date a patent was issued. 35 U.S.C. 154(b)(1)(B). However, 37 CFR 1.703(b) also sets forth the limitations on patent term adjustment specified in 35 U.S.C.

154(b)(1)(B)(i) and (ii). Specifically, 37 CFR 1.703(b)(1) provides that the period of adjustment of the term of a patent shall not include the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the B delay period, the over three year period begins on March 22, 2009, and ends on June 23, 2009, the day before the RCE was filed, and is 124 (not 125) days. See 35 U.S.C. 154(b)(1)(B)(i).

Accordingly, the patent term adjustment remains 561 days.

The Office acknowledges the submission of the \$200.00 fee set forth in 37 CFR 1.18(e).

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell Senior Petitions Attorney

Christina Partera Donnell

Office of Petitions



OYEN, WIGGS, GREEN & MUTALA, LLP 480 - THE STATION 601 WEST CORDOVA STREET VANCOUVER BC V6B 1G1 CA CANADA MAILED

NOV 3 0 2010

OFFICE OF PETITIONS

In re Application of Jeffrey Grossman, et. al. Application No. 11/385,482 Filed: March 20, 2006

Attorney Docket No. 1249 0012/GNM

**DECISION ON PETITIONS** 

This is a decision on the petitions under 37 CFR §§ 1.48 and 1.182 filed on May 31, 2010, for correction of the inventorship and to change the order of the names of the inventors.

# The petitions are granted.

It has been found that this non-provisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding Richard W. Evans as a joint inventor.

Additionally, the order of the names of the inventors will be changed as follows:

- 1. Timothy J. Davies
- 2. Richard W. Evans
- 3. Jeffrey Grossman
- 4. Scott Phillips

Office records have been corrected to reflect the above inventorship and the change in the order of the named inventors. A corrected Filing Receipt, which sets forth the correct inventorship and desired order of the named inventors, accompanies this decision on petition.

Tylis application is being referred to Office of Data Management for processing into a patent.

releghone inquiries regarding this decision should be directed to Andrea Smith at (571) 272-3226.

Petitions Examiner
Office of Petitions

Petitions Examiner

ATTACHMENT: Corrected Filing Receipt



## United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address COMMISSIONER FOR PATENTS PO. 80x 1450 Alexandria, Virginia 22313-1450

APPLICATION	FILING or	GRP ART				
NUMBER	371(c) DATE	UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
11/385,482	03/20/2006	3768	4730	I249 0012/GNM	53	10

CONFIRMATION NO. 2062 CORRECTED FILING RECEIPT

720 OYEN, WIGGS, GREEN & MUTALA LLP 480 - THE STATION 601 WEST CORDOVA STREET VANCOUVER, BC V6B 1G1 CANADA

Date Mailed: 11/29/2010

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

#### Applicant(s)

Timothy J. Davies, Calgary, CANADA;

Richard W. Evans, Bristol, UNITED KINGDOM;

Jeffrey Grossman, Calgary, CANADA; Scott Phillips, Victoria, CANADA;

Power of Attorney: The patent practitioners associated with Customer Number 00720

#### Domestic Priority data as claimed by applicant

This application is a CIP of 11/314,139 12/21/2005 PAT 7,819,805

and is a CIP of 10/945,459 09/20/2004 PAT 7,850,611

#### Foreign Applications

If Required, Foreign Filing License Granted: 04/13/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/385,482** 

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

\*\* SMALL ENTITY \*\*

Title

SYSTEMS AND METHODS FOR ULTRASOUND IMAGING

## **Preliminary Class**

600

# PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country; an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and quidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

# LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

#### **GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

#### **NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

The request for lessling the above-identified correction(s) is hereby:  Approved  All changes apply.  Approved in Part  Specify below which changes do not apply.  Chanied  State the reasons for denial below.	SARE	27/4/18	Paper No.:
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Finance respond to the request for a certificate of correction within 7 days.  FOR IFW FILES:  Please review the requested changes/corrections as shown in the COCIN document(s) in the IFV application image. No new matter should be infroduced, nor should the coupe or meaning of the claims be changed.  Please complete the response (see below) and forward the completed response to scanning using document code COCX.  FOR PAPER FILES:  Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:  Certificates of Correction Branch (CofC).  Randolph Squam - 9019-A.  Palm Location 7880.  Thank You For Your Assistant  The request for lesuing the above-identified correction(s) is hereby:  See your excellence to be approprise box.  Approved All changes apply.  D Approved in Part Specify below which changes do not apply.  D Certificate for reasons for denial below.		Remedia Continue of Conse	markar kandi kan 11/88511/0 - Kananari 11/84616
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Please review the requested changes/corrections as shown in the attached perificate of correction. Please complete this form (see below) and forward it with the file to:  Certificates of Correction Branch (CofC) Randolph Square - 9010-A Palm Location 7680   Certificates of Correction Branch (CofC) Randolph Square - 9010-A Palm Location 7680  Certificates of Correction Branch (CofC) Thank You For Your Assistant the request for issuing the above-identified correction(s) is hereby:  The request for issuing the above-identified correction(s) is hereby:  Approved All changes apply.  Change apply State the reasons for denial below.	moo esseP <sup>a</sup> ruoob grisu	plete the response (see belo nent code COCX	printeds of senegger betelamps aff bravial bits (w
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# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/03/2010

Terry W. Kramer, Esq. Kramer & Amado, P.C. 1725 Duke Street, Suite 240 Alexandria, VA 22314

Applicant : Alistair John Parker : DECISION ON REQUEST FOR

Patent Number: 7644425 : RECALCULATION of PATENT : 01/05/2010 Issue Date : TERM ADJUSTMENT IN VIEW

Application No: 11/385,735 : OF WYETH AND NOTICE OF INTENT TO Filed : 03/22/2006 : ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 912 days. The USPTO will sua sponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

#### UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

HOWREY LLP (07783) C/O IP DOCKETING DEPARTMENT 1299 PENNSYLVANIA AVENUE, NW, ROOM B-3 WASHINGTON DC 20004-2402

**MAILED** 

NOV 02 2010

**OFFICE OF PETITIONS** 

In re Application of

Sun et al.

Application No. 11/386,047

**DECISION ON PETITION** 

Filed: March 20, 2006

Attorney Docket No. 07783.0169.NPUS01

This is a decision on the petition, filed January 7, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

### The petition is **DISMISSED**.

This application was held abandoned for failure to reply to the Restriction Requirement mailed June 23, 2009, which set a one (1) month statutory period for reply. A Notice of Abandonment was mailed on January 5, 2010.

Petitioner asserts that the Office action dated June 23, 2009 was not received.

A review of the written record indicates no irregularity in the mailing of the Office action, and, in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. In this regard, the showing required to establish the failure to receive the Office action must consist of the following:

- (1) A statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable.
- (2) A statement from the practitioner that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received.
- (3) A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required. A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm.

See MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

The instant petition does not comply with items (1) and (3) above.

As to item (1), petitioner has not provided a statement on how the system used by the firm and whether it is sufficiently reliable.

As to item (3), although petitioner provided a copy of the docket report for this instant application, the master docket for the firm was not provided.

Further, the address given on the petition differs from the address of record. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop PETITIONS Commissioner for Patents Post Office Box 1450 Alexandria, VA 22313-1450

By hand:

Customer Window located at:

U.S. Patent and Trademark Office

Customer Service Window Randolph Building

401 Dulany Street Alexandria, VA 22314

By fax:

(571) 273-8300

ATTN: Office of Petitions

Any questions concerning this matter may be directed to Joan Olszewski at (571) 272-7751.

/Liana Walsh/ Liana Walsh Petitions Examiner Office of Petitions

cc:

Viola T. Kung Howrey LLP

2941 Fairview Park Drive

Suite 200

Falls Church, VA 22042

#### UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

HOWREY LLP (07783) C/O IP DOCKETING DEPARTMENT 1299 PENNSYLVANIA AVENUE, NW, ROOM B-3 WASHINGTON DC 20004-2402

MAILED

NOV 22 2010

OFFICE OF PETITIONS

In re Application of

Sun et al.

Application No. 11/386,047

Filed: March 20, 2006

Attorney Docket No. 07783.0169.NPUS01

**DECISION ON PETITION** 

This is a decision on the renewed petition, filed November 15, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above- identified application.

#### The petition is **GRANTED**.

This application was held abandoned for failure to reply in a timely manner to the Restriction Requirement mailed June 23, 2009. A Notice of Abandonment was mailed January 5, 2010.

Petitioner asserts that the Office action dated June 23, 2009 was not received.

A review of the written record indicates no irregularity in the mailing of the Office action, and, in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. In this regard, the showing required to establish the failure to receive the Office action must consist of the following:

- (1) A statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable.
- (2) A statement from the practitioner that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received.
- (3) A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required. A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm.

See MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

The petition satisfies the above-stated requirements. Accordingly, the application was not abandoned in fact.

In view of the above, the Notice of Abandonment is hereby <u>vacated</u> and the holding of abandonment withdrawn.

This application is being referred to the Technology Center AU 2874 technical support staff for re-mailing the Restriction Requirement of June 23, 2009. The period for reply will be reset to expire one (1) month from the date the Restriction Requirement is remailed. This period is extendable under the provisions of 37 CFR 1.136.

Any questions concerning this matter may be directed to Joan Olszewski at (571) 272-7751.

/Liana Walsh/ Liana Walsh Petitions Examiner Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

INGRASSIA FISHER & LORENZ, P.C. 7010 E. COCHISE ROAD SCOTTSDALE AZ 85253 MAILED
NOV 1 0 2010
OFFICE OF PETITIONS

In re Application of Michael PENGELLY

Application No. 11/386,224

Filed: March 21, 2006

Attorney Docket No. 056.0002

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 21, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely pay the issue and publication fees on or before October 18, 2010, as required by the Notice of Allowance and Fee(s) Due, mailed July 16, 2010, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on October 19, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of \$1510 and publication fee of \$300; (2) the petition fee of \$1620; and (3) the required statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6735.

The application is being referred to the Office of Data Management for processing into a patent.

/DCG/ Diane C. Goodwyn Petitions Examiner Office of Petitions

# SPE RESPONSE FOR CERTIFICATE OF CORRECTION

		Раро	er No.:20100907
DATE	: September 13, 2010		
TO SPE OF	: ART UNIT 1654		
SUBJECT	: Request for Certificate of Correct	ction on Patent No.: 7718767	
A response is	requested with respect to the accomp	panying request for a certificate of	correction.
Certificates	lete this form and return with file, working the file, working the state of the file of th		
read as showr	o the change(s) requested, correcting in the certificate of correction? No note claims be changed.		
Thank You F	For Your Assistance	Certificates of Correction	n Branch
	for issuing the above-identified on the appropriate box.	correction(s) is hereby:	
⊠ Ар	proved	All changes apply.	
☐ Approved in Part Specify below which changes do not apply.			<b>not</b> apply.
☐ De	nied	State the reasons for denial below	<b>/</b> .
Comments:			
		SPE: /Cecilia Tsang/ SPE	Art Unit 1654

<u>5</u> PI	E RESPONSE FOR CERTIFICATE (	OF CORRECTION
		Paper No.:
	09-07-2010	
ART UNIT	1654	SN-11/386291

SUBJECT: Request for Certificate of Correction for Appl. No: 11/386291 Patent No 7/18767 Please respond to this request for a certificate of correction within 7 days.

#### FOR IFW FILES:

DATE

TO SPE OF

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

#### **FOR PAPER FILES:**

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (Co f C) Randolph Square – 9D10-A Palm Location 7580

Should priority data be entered?	Eva James
•	Certificates of Correction Branch
	703-756-1583
Thank You For Your Assistance	,
The request for issuing the above-ide Note your decision on the appropriate box.	entified correction(s) is hereby:
Approved	All changes apply.
☐ Approved in Part	Specify below which changes do not apply.
☐ Denied	State the reasons for denial below.
,	

OK TO ENTER: /N.H./

PTO/SB/44 (09-07)
Approved for use through 08/31/2010 OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

(Also Form PTO-1050)

# UNITED STATES DATENT AND TDADEMARK OFFICE

CERTIFICATE OF CORRECTION
PATENT NO. : 7,738,343  APPLICATION NO.: 11/386381  ISSUE DATE : June 15, 2010  INVENTOR(S) : KOMMA et al.
It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:  On the front page of the Letters Patent the Terminal Disclaimer is not identified.
should read, "This patent is subject to a terminal disclaimer."

MAILING ADDRESS OF SENDER (Please do not use customer number below):

This collection of information is required by 37 CFR 1 322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA. 22313-1450, DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

#### **Privacy Act Statement**

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

- The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
- 2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
- A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record
- 4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
- A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
- 6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
- 7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
- 8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
- A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

#### UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Stephen S. Mosher Whitaker, Chalk, Swindle & Sawyer, LLP 3500 City Center Tower II 301 Commerce Street Fort Worth TX 76102-4186

**MAILED** 

DEC 292011

**OFFICE OF PETITIONS** 

In re Application of

Kusin

Application No. 11/386,425

Filed: March 22, 2006

Attorney Docket No. 21553.001

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 15, 2011, to revive the above-identified application.

The petition is GRANTED.

The application became abandoned May 29, 2011 for failure to timely submit a proper reply in response to the final Office action mailed December 28, 2010. Notice of Abandonment was mailed July 20, 2011.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE), including fee and submission required by 37 CFR 1.114; (2) the required petition fee; and (3) a proper statement of unintentional delay.

This application is being referred to Technology Center AU 3723 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown Attorney Advisor Office of Petitions SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : <u>04/05/12</u>	
------------------------	--

TO SPE OF ART UNIT \_\_\_\_\_ 3771\_\_

SUBJECT: Request for Certificate of Correction for Appl. No.: 11386484 Patent No.: 7771396

CofC mailroom date: 03/23/12

Please respond to this request for a certificate of correction within 7 days.

## **FOR IFW FILES:**

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

#### **FOR PAPER FILES:**

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC) Randolph Square – 9D10-A Palm Location 7580

You can lex the Directors/SPE response to 57/1-273-3421

Note: Should the changes in the claims be approved?

<u> Lamonte Newsome</u>

Certificates of Correction Branch 571-272-3421

**Thank You For Your Assistance** 

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

te your decision on the appropriate box.

Specify below which changes <b>do not</b> apply
Specify below which changes <b>do not</b> apply
Specify below which changes <b>do not</b> apply
State the reasons for denial below.
State the reasons for definal below.
· · · · · · · · · · · · · · · · · · ·
/Justine Yu/
3771
_0//1



#### UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Decision Date: April 22,2011

In re Application of:

Yasuhisa Tani

DECISION ON PETITION

UNDER CFR 1.313(c)(2)

Application No: 11386777

Filed: 23-Mar-2006

Attorney Docket No: 127400

This is an electronic decision on the petition under 37 CFR 1.313(c)(2), filed April 22,2011 , to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.** 

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid in this application cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

This application file is being referred to Technology Center AU 2882 for processing of the request for continuing examination under 37 CFR 1.114.

Office of Petitions

Doc Code: PET.AUTO Document Description: Petition autom	natically granted by EFS-Web	PTO/SB/140 U.S. Patent and Trademark Office Department of Commerce		
Electronic Petition Request	PETITION TO WITHDRAW AN APPLIC THE ISSUE FEE UNDER 37 CFR 1.313(	CATION FROM ISSUE AFTER PAYMENT OF		
Application Number	11386777			
Filing Date	23-Mar-2006			
First Named Inventor	Yasuhisa Tani			
Art Unit	2882			
Examiner Name	MESFIN ASFAW			
Attorney Docket Number	127400			
Title	PROJECTION EXPOSURE APPARATUS, CLE PROJECTION EXPOSURE APPARATUS, AN	EANING AND MAINTENANCE METHODS OF A ID DEVICE MANUFACTURING METHOD		
withdraw an application from issue, a	om issue for further action upon petition by applicant must file a petition under this sections why withdrawal of the application from	tion including the fee set forth in § 1.17(h) and a		
APPLICANT HEREBY PETITIONS TO WI	ITHDRAW THIS APPLICATION FROM ISSUE U	JNDER 37 CFR 1.313(c).		
are unpatentable, an amendment to claims to be patentable; (b) Consideration of a request for con	nims, which must be accompanied by an un such claim or claims, and an explanation as natinued examination in compliance with § 1	nequivocal statement that one or more claims s to how the amendment causes such claim or 1.114 (for a utility or plant application only); or e in favor of a continuing application, but not a		
Petition Fee				
Applicant claims SMALL EN	TITY status. See 37 CFR 1.27.			
Applicant is no longer claim	ing SMALL ENTITY status. See 37 CFR 1.27(	g)(2).		
Applicant(s) status remains a	as SMALL ENTITY.			
Applicant(s) status remains as	s other than SMALL ENTITY			
Reason for withdrawal from issue				

One or more claims are unpate	ntable				
Consideration of a request for or	Consideration of a request for continued examination (RCE) (List of Required Documents and Fees)				
Applicant hereby expressly abar have power of attorney pursuar	ndons the instant application (any attorney/agent signing for this reason must nt to 37 CFR 1.32(b)).				
RCE request, submission, and fee.					
I certify, in accordance with 3  The RCE request ,submission,	37 CFR 1.4(d)(4) that: and fee have already been filed in the above-identified application on				
Are attached.					
THIS PORTION MUST BE COMPLETE	D BY THE SIGNATORY OR SIGNATORIES				
I certify, in accordance with 37 CFR	1.4(d)(4) that I am:				
<ul> <li>An attorney or agent registered in this application.</li> </ul>	to practice before the Patent and Trademark Office who has been given power of attorney				
An attorney or agent registered	to practice before the Patent and Trademark Office, acting in a representative capacity.				
A joint inventor; I certify that I am authorized to sign this submission on behalf of all of the inventors					
A joint inventor; all of whom are signing this e-petition					
The assignee of record of the entire interest that has properly made itself of record pursuant to 37 CFR 3.71					
Signature	/Mario A. Costantino/				
Name	Mario A. Costantino				
Registration Number	33565				



#### UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
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WWW.USPTO.GOV

Paper No.

VORYS, SATER, SEYMOUR & PEASE LLP 1909 K St., NW

9th Floor

WASHINGTON DC 20006-1152

MAILED

JUN 16 2011

OFFICE OF PETITIONS

In re Application of

Habashi

Application No. 11/386,807

Filed: March 23, 2006
Attorney Docket No.

060547.000003

Title: VENTILATION METHOD AND CONTROL OF A VENTILATOR BASED ON SAME

DECISION ON PETITION UNDER 37 C.F.R. § 1.181

This is a decision on the petition filed February 18, 2011, which is being treated as a petition pursuant to 37 C.F.R. § 1.181(a), to withdraw the holding of abandonment.

The petition pursuant to 37 C.F.R. § 1.181(a) is GRANTED.

A final Office action was mailed on January 7, 2010, which set a shortened statutory period for reply of three months. An after-final amendment was received on July 7, 2010 along with a notice of appeal and a three-month extension of time so as to make timely the submission, and an advisory action was mailed on July 23, 2010. The above-identified application became abandoned for failure to submit an Appeal Brief within two-months of the filing of the aforementioned notice of appeal of July 7, 2010. No additional submissions or extensions of time pursuant to 37 C.F.R. \$1.136(a) were received. Accordingly, the above-identified application became abandoned on September 8, 2010. A Notice of Abandonment was mailed on January 31, 2011.

On February 8, 2011, Petitioner filed, *inter alia*, a Request for Continued Examination (RCE) along with the associated fee, an amendment, and a five-month extension of time (which extends the period for response to February 7, 2011). It appears that Petitioner attempted to withdraw the Notice of Appeal via the

Application No. 11/386,807 Decision on Petition

submission on an RCE, pursuant to MPEP § 706.07(h)(X). However, the RCE does not contain an executed certificate of mailing.

On February 18, 2011, Petitioner filed, inter alia, this petition, the petition fee, and the proper statement of unintentional delay. The amendment filed on February 8, 2011 has been accepted as the required reply under 37 C.F.R. § 1.137(b)(1).

As such, the first three requirements of Rule 1.137(b) have been met. The fourth requirement of Rule 1.137(b) is not applicable, as a terminal disclaimer is not required.

An extension of time under 37 C.F.R. § 1.136 must be filed prior to the expiration of the maximum extendable period for reply. Accordingly, since the \$ 1175 extension of time submitted with the RCE on February 8, 2011 was filed subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to Deposit Account No. 22-0585 in due course.

The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of this decision, so that the submission under 37 C.F.R. § 1.114 - the amendment submitted on February 8, 2011 - can be processed in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the present decision to ensure that the revival has been acknowledged by the Technology Center in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Technology Center where that change of status must be effected - the Office of Petitions cannot effectuate a change of status.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. All other inquiries

<sup>1 &</sup>lt;u>See</u> Rule 1.137(d).

<sup>2</sup> See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988).

<sup>3</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

Application No. 11/386,807 Decision on Petition

concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions



#### UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

In re Application of Richard I. Chaifetz

Application No. 11386852

Filed: March 23,2006

Attorney Docket No. P28884

:

:DECISION ON PETITION TO MAKE SPECIAL :UNDER 37 CFR 1.102(c)(1)

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1), filed 02-APR-2012 to make the above-identified application special based on applicant's age as set forth in MPEP § 708.02, Section IV.

#### The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1), MPEP § 708.02, Section IV: Applicant's Age must include a statement by applicant or a registered practitioner having evidence that applicant is at least 65 years of age. No fee is required.

Accordingly, the above-identified application has been accorded "special" status and will be taken up for action by the examiner upon the completion of all pre-examination processing.

Telephone inquiries concerning this electronic decision should be directed to the Electronic Business Center at 866-217-9197.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

Doc code: PET.OP.AGE

Description: Petition to make special based on Age/Health

PTO/SB/130 (07-09)

Approved for use through 07/31/2012. OMB 0651- 0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number

PET	ITION TO M	IAKE SPEC	IAL BASED ON A UNDER 37 CFR			NT OF E	EXAMINATION
			Application	Inform	ation		
Application Number	11/386,85	2	Confirmation Number	5318		Filing Date	2006-03-23
Attorney Docket Number (optional)	P28884		Art Unit	1734		Examin	ner NGUYEN, NGOC YEN
First Named Inventor	Richard I. C	Richard I. CHAIFETZ					
Title of Invention	METAL CH	LORIDES A	ND METALS OBTAIN	ED FRO	M METAL OXIDE	CONTAI	NING MATERIALS
A grantable petition (1) Statement by on (2) Certification by a showing one named  Name of Inventor v	requires on e named inv registered inventor in	e of the follo ventor in the attorney/ag the applica	owing items: application that he ent having evidence tion is 65 years of a	/she is	65 years of age, as a birth certific	or more;	
Given Name		Middle Na	me	Family	Name		Suffix
Richard		I.		CHAIF	ETZ		
A signature of the applease see 37 CFR Select (1) or (2):				cordand	e with 37 CFR 1	.33 and ′	10.18.
(1) I am an invento	r in this appli	cation and I a	am 65 years of age, o	r more.			
							ify that I am in possession of 5 years of age, or more.
Signature		/Arnold Turk	¢/		Date (YYYY-MM-DE	))	2012-04-02
Name		Arnold Turk			Registration Number		33094

Doc code: PET.OP.AGE

Description: Petition to make special based on Age/Health

Approved for use through 07/31/2012. OMB 0651- 0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number

# **Privacy Act Statement**

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

- 1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Fr eedom of Information Act requires disclosure of these records.
- 2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
- 3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
- 4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
- 5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
- 6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
- 7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about indivi duals.
- 8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
- 9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

#### SPE RESPONSE FOR CERTIFICATE OF CORRECTION

	<u> </u>	
		<b>Paper No</b> .:20110629
DATE	: July 29, 2011	
TO SPE (	<b>OF</b> : ART UNIT 1638	
SUBJECT	: Request for Certi	ficate of Correction on Patent No.: 7390655
A response	e is requested with respe	ct to the accompanying request for a certificate of correction.
Certificat		eturn with file, within <b>7</b> days to: nch - ST (South Tower) 9A22 03) 305-8309
read as sh		ested, correcting Office and/or Applicant's errors, should the patent correction? No new matter should be introduced, nor should the scope or
Thank Yo	u For Your Assistand	Certificates of Correction Branch
•	est for issuing the absion on the appropriated box.	ove-identified correction(s) is hereby:
$\boxtimes$	Approved	All changes apply.
	Approved in Part	Specify below which changes <b>do not</b> apply.
	Denied	State the reasons for denial below.
	al application as filed opeen filed correcting th	claimed priority to the provisional application and a substitute e mistake of the originally filed oath that did not include the
		/ANNE GRUNBERG/ Supervisory Patent Examiner.Art Unit 1638

# UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

PATENT NO.:	7390655	Page 1 of 1
DATED:	June 24, 2008	
INVENTOR(S):	Brendan Hinchey	
	ror appears in the above-identified patent and that reby corrected as shown below:	at said
On the Title Page, add under Related U.S. Ap	Provisional application No. 60/663817, filed on March plication Data	21, 2005
In claim 1, column 13,	line 3, delete "the"	



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/387,121	03/22/2006	Preetham Kajekar	26310-0169001	4782
94150 7590 11/28/2011 Fish & Richardson PC P.O.Box 1022			EXAMINER	
			LEE, KEVIN H	
Minneapolis, MN 55440			ART UNIT	PAPER NUMBER
			2475	
			MAIL DATE	DELIVERY MODE
			11/28/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

#### SPE RESPONSE FOR CERTIFICATE OF CORRECTION

	<u></u>				
		<b>Paper No</b> .:20111121			
DATE	: November 21, 20	11			
TO SPE (	OF: ART UNIT 2475				
SUBJECT	F: Request for Certi	ficate of Correction on Patent No.: 8040895			
A response is requested with respect to the accompanying request for a certificate of correction.					
Please complete this form and return with file, within 7 days to:  Certificates of Correction Branch - ST (South Tower) 9A22  Palm location 7590 - Tel. No. (703) 305-8309					
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.					
Thank Yo	ou For Your Assistand	ce Certificates of Correction Branch			
The request for issuing the above-identified correction(s) is hereby:  Note your decision on the appropriated box.					
$\boxtimes$	Approved	All changes apply.			
	Approved in Part	Specify below which changes <b>do not</b> apply.			
	Denied	State the reasons for denial below.			
	ges to the 5th inventor	are approved as the error to the inventor's name is of a clerical xamination or constitute new matter.			
Supervisory Patent Examiner, Art Unit 2475					





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Fish & Richardson PC P.O.Box 1022 Minneapolis MN 55440

MAILED
DEC 2 2 2011
OFFICE OF PETITIONS

In re Patent No. 8,040,895

KAJEKAR et al.

Issue Date: October 18, 2011 Application No. 11/387,121

Filed: March 22, 2006

Attorney Docket No. 26310-

0169001

Title: METHOD AND SYSTEM FOR REMOVING DEAD ACCESS CONTROL

ENTRIES (ACES)

: DECISION ON REQUEST FOR

: RECONSIDERATION OF

: PATENT TERM ADJUSTMENT

: AND NOTICE OF INTENT TO

: ISSUE CERTIFICATE OF

: CORRECTION

This is a decision on the petition filed on December 16, 2011, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by eight hundred sixty-six (866) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED** to the extent indicated herein. The term of the above-identified patent is extended or adjusted by seven hundred thirty-five (735) days.

#### BACKGROUND

On October 18, 2011, the above-identified application matured into U.S. Patent No. 8,040,895 with a revised patent term adjustment of 672 days. On December 16, 2011, patentee timely submitted this request for reconsideration of patent term

adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 866.

Patentee asserts that the Office should not have assessed a period of 3 days of applicant delay pursuant to 37 CFR 1.704(b) for the filing of the reply on the next business day, Tuesday, September 8, 2009, in response to the final Office action mailed June 5, 2009. Patentee maintains that the three-month due date should be calculated from September 8, 2009, because September 5, 2009, fell on a Saturday, and Monday, September 7, 2009, was a federal holiday,

Patentee's assertion is well taken. The reduction of 3 days pursuant to 37 CFR 1.704(b) will be removed.

Patentee dispute the period of reduction of 60 days associated with the filing of a reply to the Notice to File Corrected Application Papers mailed July 21, 2011. Patentee contends that the reply was improperly coded in PAIR as a "Miscellaneous Incoming Letter." Patentee asserts that patentee filed the reply to the Notice to File Corrected Application Papers on August 9, 2011, within three months of the mailing date of the Notice.

The record supports a conclusion that patentee filed a reply to the Notice to File Corrected Application Papers on August 9, 2011. Thus, patentee did not fail to engage in reasonable efforts to conclude processing or examination of the application within the meaning of 37 CFR 1.704. Accordingly, the reduction of 60 days is not warranted and is being removed.

Next, Patentee maintains that the Office incorrectly calculated Office delay pursuant to 37 CFR 1.702(b). Patentee contends that the Office erred in subtracting from the "B delay" a period of time that was not "consumed by continued examination of the application." Specifically, Patentee argues that (after the filing of the request for continued examination) the Office mailed a Notice of Allowance on June 10, 2011, thereby closing examination of the application on that date. Thus, Patentee argues no continued examination took place during the 131-day period from June 10, 2011 (the mailing date of the Notice of Allowance) until October 18, 2011 (the date the patent was issued). As such, Patentee maintains that the "B delay" should include the 131 days and be increased from 169 to 300 days.

Patentee concludes that the correct patent term adjustment is 866 days (the sum of 577 days of "A delay" plus 300 days of "B delay" minus 0 days of overlap between "A delay" and "B delay" minus 11 days of applicant delay).

#### RELEVANT STATUTE AND REGULATIONS

The statutory basis for calculation of "B delay" is 35 U.S.C. 154(b)(1)(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —

- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);
- (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or
- (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

The implementing regulation, 37 CFR 1.702(b) provides that:

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

- (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);
- (2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);

- (3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
- (4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or
- (5) Any delay in the processing of the application by the Office that was requested by the applicant.

#### OPINION

Patentee's arguments have been considered, but not found persuasive. The Office calculated the period of "B delay" pursuant to 35 U.S.C. 154(b)(1)(B)(i) and 37 CFR 1.702(b)(1) as 169 days based on the application having been filed under 35 U.S.C. 111(a) on March 22, 2006, and the patent not having issued as of the day after the three year date, March 23, 2009, and a request for continued examination under 35 U.S.C. 132(b) having been filed on September 8, 2009. In other words, the 131-day period beginning on the date of mailing of the Notice of Allowance to the date of issuance of the patent was considered time consumed by continued examination of an application under 35 U.S.C. 132(b) and was not included in the "B delay."

The Office's calculation of "B delay" is correct. The "B delay" is an adjustment entered if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed. However, the adjustment does not include, among other things, any time consumed by continued examination of the application at the request of the applicant under 35 U.S.C. 132(b)<sup>1</sup>. Thus, with respect to calculating the "B delay", where applicant has filed a request for continued examination the

Pursuant to 35 U.S.C. 132(b), 37 CFR 1.114 provides for continued examination of an application, as follows:

<sup>(</sup>a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in  $\S 1.17(e)$  prior to the earliest of:

<sup>(1)</sup> Payment of the issue fee, unless a petition under  $\S$  1.313 is granted;

<sup>(2)</sup> Abandonment of the application; or

<sup>(3)</sup> The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

period of adjustment is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the number of days in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

Further, counting the period of time excluded from the "B delay" for the filing of a request for continued examination under 35 U.S.C. 132(b), from the date on which the request for continued examination is filed to the date the patent is issued is proper. Patentee does not dispute that time consumed by continued examination of an application under 35 U.S.C. 132(b) is properly excluded and that the calculation of the excluded period begins on the date of filing of the request for continued examination. At issue is what further processing or examination beyond the date of filing of the request for continued examination is not any time consumed by continued examination of the application under 35 U.S.C. 132(b). The USPTO indicated in September of 2000 in the final rule to implement the patent term adjustment provisions of the AIPA that once a request for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114 is filed in an application, any further processing or examination of the application, including granting of a patent, is by virtue of the continued examination given to the application under 35 U.S.C. 132(b) and CFR 1.114. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56366, 56376 (Sept. 18, 2000) (response to comment 8). Thus, the excluded period begins with the filing of the request for continued examination and ends with the issuance of the patent.

Patentee's argument that the period of time after the issuance of a Notice of Allowance on a request for continued examination is not "any time consumed by continued examination requested by the applicant under section 132(b)" within the meaning of 35 U.S.C. 154(b)(1)(B)(i) is not availing. This limitation is not

<sup>(</sup>b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

supported by the statutory language. Garcia v. United States, 469 U.S. 70, 75 (1984) ("only the most extraordinary showing of contrary intentions from [legislative history] would justify a limitation on the 'plain meaning' of the statutory language"). BP Am. Prod. Co. v. Burton, 549 U.S. 84, 91 (2006) ("Unless otherwise defined, statutory terms are generally interpreted in accordance with their ordinary meaning"). The statute provides for a guarantee of no more than 3-year application pendency, by providing for an adjustment in the patent term:

First, "Subject to the limitations of paragraph (2)," means that the limitations of paragraph 2 apply to this paragraph's adjustment of patent term. That is, the day-to-day extension of patent term for pendency beyond the 3 year period is restricted as follows: 1) "B delay" cannot accrue for days of "A delay" that overlap, 2) the patent term cannot be extended beyond disclaimed term, and 3) the period of adjustment, including accrued "B delay," will be reduced for applicant delay.

Second, "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States," meaning that the condition must first occur that the issuance of an original patent (35 U.S.C. 153), not merely the issuance of a notice of allowance, is delayed due to the Office's failure to issue a patent (sign and record a patent grant in the name of the United States), not merely mail a notice of allowance, within 3 years after the actual filing date of the application in the United States. This provision gives the Office a three-year period to issue a patent (sign and record a patent grant in the name of the United States) after the application filing date before an adjustment will accrue for "B delay."

Third, "not including- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b); (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), meaning that the three-year period does not include "any time consumed"

by" or "any delay in processing," as specified in clauses (i)-(iii). This language correlates to 35 U.S.C. 154(b)(1)(A) which likewise provides the basis for determining the period given the Office to take the specified actions before an adjustment will accrue for "A delay" (e.g., extended for 1 day after the day after the period specified in clauses (i)-(iv)).

Furthermore, these clauses are interpreted using their ordinary Nonetheless, the context of the legislation should be meanings. considered. As stated in Wyeth v. Dudas, 580 F. Supp. 2d 138 (D.D.C. 2008), because the clock for calculating the 20-year patent term begins to run on the filing date, and not on the day the patent is actually granted, some of the effective term of a patent is consumed by the time it takes to prosecute the application. To mitigate this effect, the statute, inter alia, grants adjustments of patent term whenever the patent prosecution takes more than three years, regardless of the reason. The time consumed by prosecution of the application includes every day the application is pending before the Office from the actual filing date of the application in the United States until the date of issuance of the patent. The time it takes to prosecute the application ends not with the mailing of the notice of allowance, but with the issuance of the patent.

Thus, not including "any time consumed by" means not including any days used to prosecute the application as specified in clauses (i)-(ii)². Clause (i) specifies "any time consumed by continued examination of the application requested by the applicant under section 132(b)." Clause (ii) specifies "any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court." "Time" in the context of this legislation throughout refers to days. "Consumed by" means used by or used in the course of. Websters Collegiate Dictionary, (11th ed.). The "any" signifies that the days

Clause (iii) provides for not including (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued. It is noted that paragraph (3)(C) allows with an adequate showing by applicant for reinstatement of no more than 3 months of the patent term reduced for applicant delay in taking in excess of three months to respond.

consumed by are "any" of the days in the pendency of the application, and not just days that occur after the application has been pending for 3 years. As such, "any time consumed by" refers to any days used in the course of 1) continued examination of the application under section 132(b) (the filing of a request for continued examination), 2) interference proceedings, 3) secrecy orders, and 4) appellate review. Thus, that 3-year period given to the Office to issue a patent before an adjustment will accrue for "B delay" does not include any days used in the course of or any time consumed by clauses (i)-(ii), including any time consumed by the filing of a request for continued examination.

Fourth, "the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued" meaning that the consequence of this failure is that after "the end of that 3-year period" an additional 1 day of patent term will accrue for each day that the application is pending until the day the patent is issued.

The "time consumed by" or used in the course of the continued examination of the application requested by the applicant under section 132(b) does not end until issuance of the patent. 35 U.S.C. 132(b) was enacted under the same title, the "American Inventors Protection Act of 1999," as 35 U.S.C. 154(b). Section 4403 of the AIPA amended 35 U.S.C. § 132 to provide, at the request of the applicant, for continued examination of an application for a fee (request for continued examination or RCE practice), without requiring the applicant to file a continuing application under 37 CFR 1.53(b) or a continued prosecution application (CPA) under 37 CFR 1.53(d). Thus, clause (i) is different from clause (ii) in that clause (i) refers to an examination process whereas clause (ii) refers to time consumed by proceedings (interferences, secrecy orders and appeals) in an application.

By nature, the time used in the course of the examination process continues to issuance of the patent. The examination process involves examining the application to ascertain whether it appears that the applicant is entitled to a patent under the law. See 35 U.S.C. 131 ("[t]he Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director

shall issue a patent therefor"). If on examination it appears that the applicant is entitled to a patent, the USPTO issues a notice of allowance. See 35 U.S.C. 151 ("[i]f it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant"). If on examination it appears that the applicant is not entitled to a patent, the USPTO issues a notice (an Office action) stating the applicable rejection, objection, or other requirement, with the reasons therefor. See 35 U.S.C. 132 ("[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application"). Neither the issuance of a notice of allowance nor the insurance of an Office action terminates the examination process. If after the issuance of an Office action under 35 U.S.C. 132 it subsequently appears that the applicant is entitled to a patent (e.g., in response to an argument or amendment by the applicant), the USPTO will issue a notice of allowance. Conversely, if after the issuance of a notice of allowance under 35 U.S.C. 151 it subsequently appears that the applicant is not entitled to a patent (e.g., in response to information provided by the applicant or uncovered by the USPTO), the USPTO will withdraw the application from issuance and issue an Office action under 35 U.S.C. 132 stating the applicable rejection, objection, or other requirement, with the reasons therefor.

As held in <u>Blacklight Power</u>, the USPTO's responsibility to issue a patent containing only patentable claims does not end with the issuance of a notice of allowance under 35 U.S.C. 151. <u>See BlackLight Power</u>, Inc. v. Rogan, 295 F.3d 1269, 1273 (Fed. Cir. 2002). Rather, if there is any substantial, reasonable ground within the knowledge or cognizance of the Director as to why an application should not issue, it is the USPTO's duty to refuse to issue the patent even if a notice of allowance has previously been issued for the application. <u>See In re Drawbaugh</u>, 9 App. D.C. 219, 240 (D.C. Cir 1896).

Moreover, the applicant continues to be engaged in the examination process after the mailing of the notice of allowance. 37 CFR 1.56 makes clear that the applicant has a duty to disclose information material to patentability as long

as the application is pending before the USPTO (i.e., until a patent is granted or the application is abandoned). See 37 CFR 1.56(a) ("[t]he duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned"). 37 CFR 1.97 and 1.98 provide for the consideration of information submitted by the applicant after a notice of allowance has been mailed. See 37 CFR 1.97(d). In addition, 37 CFR 1.312 provides for the amendment of an application after a notice of allowance has been mailed. In fact, the request for examination procedures permits the filing of a request for continued examination under 37 CFR 1.114 even after the issuance of a notice of allowance under 35 U.S.C. 151. See 37 CFR 1.114(a)(1).

As the examination process does not terminate with the mailing of the Notice of Allowance, the time consumed by continued examination requested by the applicant under section 132(b) does not terminate with the mailing of the Notice of Allowance. All the time the application is pending from the date of filing of the request for continued examination to the mailing of the Notice of Allowance through issuance of the patent is a consequence of the filing of the request for continued examination. Further action by the Office is pursuant to that request. Applicant has gotten further prosecution of the application without having to file a continuing application under 37 CFR 1.53(b).

All of the continued examination pursuant to the filing of the request by the applicant is properly excluded from the delay attributed to the Office. 35 U.S.C. 154(b)(1)(B)'s guarantee of a total application pendency of no more than three years provides for adjustment of the patent term for delay due to the Office's failure to issue the patent within three years, but does not include "any time consumed by continued examination requested by the applicant under 35 U.S.C. 132(b)." It is not necessary to mitigate the effect on the 20-year term to the extent that applicant has requested that the Office continue to examine the application via a request for continued examination, in lieu of, the filing of a continuing application under 37 CFR 1.53(b).

Thus, on occasion, even where a request for continued examination has already been filed and a notice of allowance issued pursuant to that request, applicant may file a further request for continued examination.

In this instance, a request for continued examination was filed on September 8, 2009, and the patent issued by virtue of that request on October 18, 2011. Pursuant to 35 U.S.C. 154(b)(1)(B)(i), the period beginning on September 8, 2009, and ending on October 18, 2011, is not included in calculating Office delay.

#### CONCLUSION

Accordingly, the patent term adjustment is 735 days (577 days of "A delay" + 169 days of "B delay" - 0 days of overlap - 11 days of applicant delay).

The Office will sua sponte issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentee is given one (1) month or thirty (30) days, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by seven hundred thirty-five (735) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina lautera Donnell

Christina Tartera Donnell Senior Petitions Attorney Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

# **DRAFT COPY**

# UNITED STATES PATENT AND TRADEMARK OFFICE **CERTIFICATE OF CORRECTION**

8,040,895 B2 **PATENT** Oct. 18, 2011

INVENTOR(S): Kajekar et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

DATED

Subject to any disclaimer, the term of this patent is extended or adjusted [\*] Notice: under 35 USC 154(b) by (672) days.

Delete the phrase "by 672 days" and insert – by 735 days--



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

In re Application of John C. Meade

Application No. 11387127

Filed: March 22,2006

Attorney Docket No. 2003B (306932)

:DECISION ON PETITION TO MAKE SPECIAL :UNDER 37 CFR 1.102(c)(1)

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1), filed 05-NOV-2010 to make the above-identified application special based on applicant's age as set forth in MPEP § 708.02, Section IV.

#### The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1), MPEP § 708.02, Section IV: Applicant's Age must include a statement by applicant or a registered practitioner having evidence that applicant is at least 65 years of age. No fee is required.

Accordingly, the above-identified application has been accorded "special" status and will be taken up for action by the examiner upon the completion of all pre-examination processing.

Telephone inquiries concerning this electronic decision should be directed to the Electronic Business Center at 866-217-9197.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ASHKAN NAJAFI, P.A. 6817 SOUTHPOINT PARKWAY SUITE 2301 JACKSONVILLE FL 32216

MAILED

OCT 072011

OFFICE OF PETITIONS

In re Application of

Glenda Amaya et al. :

Application No. 11/387,130 : DECISION ON PETITION

Filed: March 23, 2006 :

Attorney Docket No. MIM2010 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 26, 2011, to revive the above-identified application.

#### The petition is **GRANTED**.

The application became abandoned for failure to submit formal drawings and pay the issue fee in a timely manner in reply to the Notice of Allowability and Notice of Allowance, mailed December 23, 2008, which set a period for reply of three (3) months. Accordingly, this application became abandoned on January 24, 2009. A Notice of Abandonment was mailed on February 17, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of corrected drawings and the issue fee payment of \$755, (2) the petition fee of \$810, (3) a proper statement of unintentional delay. Accordingly, the corrected drawings and fee are accepted as being unintentionally delayed.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to the Office of Data Management for further processing into a patent.

/Kimberly A. Inabinet/

Kimberly A. Inabinet Petitions Examiner Office of Petitions

cc: Diana C. Perez 9371 SW 164<sup>th</sup> Court Miami, FL 33196

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.usbto.gov

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON DC 20001-4413

MAILED

FEB 14 2011

OFFICE OF PETITIONS

In re Application of

CARETTA and MARCHINI

Application No. 11/387,697

ON PETITION

Filed: 03/24/2006

Attorney Docket No. 07040.0023-02

This is in response to the Request for Corrected Filing Receipt, filed December 20, 2010, to include the second inventor's name and residence.

## The request is **GRANTED**.

On March 24, 2006, applicant filed the above-identified application. On April 18, 2006, the Office mailed a filing receipt listing only one inventor, Renato Caretta. Applicant filed a Request for Corrected Filing Receipt, requesting that the Office issue a corrected filing receipt to include the second named inventor, Maurizio Marchini. Applicant submitted a copy of a two-page Declaration and Power of Attorney listing the second named inventor on page two, accompanied by a returned, date-stamped postcard receipt acknowledging receipt of the Declaration and Power of Attorney (2 pages) in the USPTO on March 24, 2006.

Upon review of the record, page 2 of the Declaration and Power of Attorney deposited on March 24, 2006, has not been located among the application papers. However, the evidence is convincing that the application papers deposited on March 24, 2006, included a second page of Declaration and Power of Attorney listing Maurizio Marchini as the second inventor. Therefore, the Office will enter Maurizio Marchini as the second named inventor and issue a corrected filing receipt.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3211.

Christina Lantera Donnell
Senior Petitions Attorney

Office of Petitions

ATTACHMENT: Corrected Filing Receipt



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address COMMISSIONER FOR PATENTS PO. Box 1450 Alexandra, Virginia 22313-1450 www.uspte.gov

APPLICATION FILING or GRP ART FIL FEE REC'D ATTY.DOCKET.NO TOT CLAIMS IND CLAIMS NUMBER 371(c) DATE UNIT 07040.0023-02 11/387,697 03/24/2006 1747 9400 128 18

> **CONFIRMATION NO. 8732 CORRECTED FILING RECEIPT**

22852 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413

Date Mailed: 02/14/2011

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

Applicant(s)

Renato Caretta, Gallarate (Varese), ITALY; Maurizio Marchini, Seregno (Milano), ITALY;

**Assignment For Published Patent Application** 

PIRELLI PNEUMATICI S.p.A.

Power of Attorney: None

Domestic Priority data as claimed by applicant

This application is a CON of 09/840,095 04/24/2001 PAT 7,041,185 which is a CON of 09/219,422 12/23/1998 ABN which claims benefit of 60/098,376 08/28/1998

Foreign Applications (You may be eligible to benefit from the Patent Prosecution Highway program at the USPTO. Please see <a href="http://www.uspto.gov">http://www.uspto.gov</a> for more information.) EUROPEAN PATENT OFFICE (EPO) 97830731.2 12/30/1997

If Required, Foreign Filing License Granted: 04/14/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US 11/387.697

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

page 1 of 3

Title

#### METHOD FOR MAKING TIRES FOR VEHICLE WHEELS

#### **Preliminary Class**

156

#### PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

#### LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

#### **GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

#### **NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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HARRIS CORPORATION C/O FOX ROTHSCHILD, LLP 997 LENOX DRIVE BUILDING 3 LAWRENCEVILLE, NJ 08543-5231

MAILED

AUG 22 2011

OFFICE OF PETITIONS

In re Application of

Terence W. O'Brien, et al

Application No.: 11,387,744

**ON PETITION** 

Filed: March 23, 2006

Attorney Docket No.: 7162-0145US0

This is a decision on the petition, filed August 19, 2011, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on August 3, 2011, cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.\(^1\)

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 2436 for further processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement (IDS).

/SDB/

Sherry D. Brinkley Petitions Examiner Office of Petitions

<sup>&</sup>lt;sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s)
Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.



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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 MAILED
SEP 0 8 2010
OFFICE OF PETITIONS

In re Application of Masato Nishihara, et al. Application No. 11/387 9

Application No. 11/387,936 Filed: March 24, 2006

Attorney Docket No. 1075.1468

**DECISION GRANTING PETITION** 

UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed September 7, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on August 23, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. \(^1\)

Telephone inquiries regarding this decision should be directed to undersigned at (571) 272-1642. All other inquiries regarding the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 2613 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/AMW/ April M. Wise Petitions Examiner Office of Petitions

<sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.



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HARRIS CORPORATION C/O FOX ROTHSCHILD, LLP 997 LENOX DRIVE BUILDING 3 LAWRENCEVILLE NJ 08543-5231

MAILED

AUG 2 9 2011

In re Application of

Terence W. O'Brien et al

Application No. 11/387,991

Filed: March 23, 2006

Attorney Docket No. 7162-0144US0

OFFICE OF PETITIONS

DECISION GRANTING PETITION

UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed August 25, 2011, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on August 3, 2011 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 2436 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

/Karen Creasy/ Karen Creasy Petitions Examiner Office of Petitions

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.



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DINSMORE & SHOHL, LLP FIFTH THIRD CENTER ONE SOUTH MAIN STREET SUITE 1300 DAYTON, OH 45402 MAILED
SEP 0 9 2010
OFFICE OF PETITIONS

In re Application of Ingo Curdt, et al.

Application No. 11/388,156

Filed: March 23, 2006

Attorney Docket No.: 22211 US-pd/c

ON PETITION

This is a decision on the petition, filed June 3, 2010, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

# The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed July 21, 2007, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extension of time under the provisions of 37 CFR 1.136(a) was obtained. A Notice of Abandonment was mailed on March 7, 2008. On June 21, 2010, the present petition was filed.

This application has been abandoned for an extended period of time. The U.S. Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." See Changes to Patent Practice and Procedure, 62 Fed. Reg., at 53160 and 53178; 1203 Off. Gaz. Pat. Office, at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the U.S. Patent and Trademark Office).

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the response in the form of an election of the invention to be examined; (2) the petition fee of \$1,620; and (3) an adequate statement of unintentional delay.

The application is being referred to Technology Center AU 1641 for consideration of the response filed June 3, 2010.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. All other inquiries regarding this application should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

13. (Currently amended) A betting system having a plurality of system components, the betting system comprising:

a casino event monitoring system component configured to define a casino-related event that includes one or more slot machines paying each of a plurality of bettors at least a particular sum of money during a defined time period, wherein odds of the casino-related event occurring are defined and change with time during the defined time period; and

a payment system component configured to record multiple consecutive bets from the plurality of bettors on how many of the plurality of bettors will win more than the particular sum of money during the defined time period;

the casino event monitoring system component further configured to determine that one of the multiple consecutive bets is a winning bet based on an occurrence of the casino-related event during the defined time period; and

the payment system component further configured to notify each of the plurality of bettors of the winning bet.

- 14. (Canceled)
- 15. (Original) The betting system of claim 13, wherein the casino-related event involves a game offered by a casino.
- 16. (Canceled)
- 17. (Canceled)
- 18. (Canceled)
- 19. (Previously presented) The betting system of claim 13, further comprising:

the casino event monitoring system component further configured to subscribe the plurality of bettors to play the multiple consecutive bets during the defined time period.

DATE	: 08-17-11	
TO SPE OF	: ART UNIT	
SUBJECT		for Appl. No.: 11/388190 Patent No.: 7620456
		CofC mailroom date: 08-10-11
Please respo	and to this request for a certific	ate of correction within 7 days.
FOR IFW FI	LES:	
the IFW app	w the requested changes/corre lication image. No new matter he claims be changed.	ections as shown in the COCIN document(s) in should be introduced, nor should the scope or
	plete the response (see below) nent code <b>COCX</b> .	and forward the completed response to scanning
FOR PAPER	R FILES:	
	. •	ections as shown in the attached certificate of below) and forward it with the file to:
Randol	rates of Correction Branch (CofC) ph Square – 9D10-A ocation 7580	A-Ck
Note:		Angela Green 571.272.9005
·		CofC Branch 703-756-1814
Thank You	For Your Assistance	
	t for issuing the above-ident on the appropriate box.	ified correction(s) is hereby:
Note your decision	Approved	All of some some souls
Note your decision	Approved	All changes apply.
X	Approved in Part	Specify below which changes do not apply.
× -		
X 	Approved in Part Denied	Specify below which changes do not apply.  State the reasons for denial below.
X 	Approved in Part	Specify below which changes do not apply.  State the reasons for denial below.
X 	Approved in Part Denied	Specify below which changes do not apply.  State the reasons for denial below.
X 	Approved in Part Denied	Specify below which changes do not apply.  State the reasons for denial below.
X 	Approved in Part Denied	Specify below which changes do not apply.  State the reasons for denial below.



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PATENT CORRESPONDENCE ARNALL GOLDEN GREGORY LLP 171 17TH STREET NW, SUITE 2100 ATLANTA, GA 30363 MAILED
MAY 13 2011

OFFICE OF PETITIONS

In re Application of

Giorgio CALDERARI, et al.

Application No. 11/388,270

Filed: March 24, 2006

Attorney Docket No. 23278.8403

NOTICE UNDER 37 CFR 1.28(C)

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7253.

/Monica A. Graves/
Petitions Examiner, Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

Knobbe, Martens, Olson & Bear LLP 2040 Main Street 14th Floor Irvine CA 92614 MAILED FEB 0 1 2011 OFFICE OF PETITIONS

In re Application of

Keith Doran Weeks et al. Application No. 11/388,313

Filed: March 23, 2006

Attorney Docket No. ASMEX.510A

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 22, 2010, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before November 22, 2010, as required by the Notice of Allowance and Fee(s) Due, mailed August 20, 2010. Accordingly, the date of abandonment of this application is November 23, 2010. A Notice of Abandonment was mailed on December 8, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of \$1,510 and the publication fee of \$300, (2) the petition fee of \$1,620, and (3) a proper statement of unintentional delay. Accordingly, the issue and publication fees are accepted as being unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to the Office of Data Management for further processing into a patent.

/Kimberly A. Inabinet/

Kimberly A. Inabinet Petitions Examiner Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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# MAILED

SCHWEGMAN, LUNDBERG & WOESSNER/INTEL PO BOX 2938 MINNEAPOLIS MN 55402 NOV 032010

OFFICE OF PETITIONS

In re Application of

Joshua POSAMENTIER

Application No. 11/388,324

Filed: March 23, 2006

Attorney Docket No. 42P23327

ON PETITION

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed October 5, 2010, to revive the above-identified application.

#### The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of January 8, 2010. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that prima facie places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is January 28, 2010. A Notice of Abandonment was mailed on June 21, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of \$810, and the submission required by 37 CFR 1.114; (2) the petition fee of \$1620 and (3) an adequate statement of unintentional delay.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is **not** a correct reading of the statement appearing in the petition.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6735.

All other inquiries should be directed to the Technology Center at (571) 272-2600.

This application is being referred to Technology Center AU 2612 for processing of the RCE and submission required by  $37\ CFR\ 1.114$ .

/DCG/ Diane C. Goodwyn Petitions Examiner Office of Petitions





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

PERKINS COIE LLP P.O. BOX 1208 SEATTLE, WA 98111-1208

MAILED

SEP 2 4 2010

**OFFICE OF PETITIONS** 

In re Application of De Vries al.

Application No. 11/388,381 Filed: March 23, 2006

Attorney Docket No. 30126-8008.US01

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 3, 2010.

The request is APPROVED.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office will require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, which the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any replies that may be due and the time frame within which the client must respond, pursuant to 37 CFR 10.40 (c).

The request was signed by R. Michael Ananian, on behalf of the practitioners of record associated with Customer No. 22918.

Customer Number 22918 has been withdrawn as attorney of record. Applicant is reminded that there is no attorney of record at this time.

There is an outstanding Office action mailed March 29, 2010 that requires a reply from the applicant.

As no change of correspondence address was indicated therefore, the address will remain unchanged.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-6059. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Alicia Kelley Petitions Examiner Office of Petitions



22918

#### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandris, Virginia 22313-1450

APPLICATION NUMBER

PERKINS COIE LLP P.O. BOX 1208 FILING OR 371(C) DATE

FIRST NAMED APPLICANT

ATTY. DOCKET NO /TITLE

11/388,381

SEATTLE, WA 98111-1208

03/23/2006

Jeffrey de Vries

30126-8008.US01

CONFIRMATION NO. 8938

POWER OF ATTORNEY NOTICE

Date Mailed: 09/24/2010

### **NOTICE REGARDING CHANGE OF POWER OF ATTORNEY**

This is in response to the Power of Attorney filed 08/03/2010.

• The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

/atkelley/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

Doc Code: PET.PTA.RCAL

**Document Description: Request for Recalculation in view of Wyeth** 

Approved for use through 02/28/2011. OMB 0651-0020

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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# REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

Attorney Docket Patent Number: **7,666,796** 42P23247 Number: Filing Date Issue Date: 02-23-2010 (or 371(b) or (f) Date): 03-23-2006

First Named

Ibrahim Ban Inventor:

Title: SUBSTRATE PATTERNING FOR MULTI-GATE TRANSISTORS

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-WYETH INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

Signature /Rahul D. Engineer/	<sub>Date</sub> July 14, 2010
Namo B I I B E I	Registration Number 47548

Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.

*Total of forms are submitte
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The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# Instruction Sheet for: REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH\*

(Not to be Submitted to the USPTO)

This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A).

This form must be filed within 180 days of the day the patent was granted, with the following exception:

Patentees who received a decision from the USPTO under the USPTO's pre-<u>Wyeth</u> interpretation of 35 U.S.C. 154(b)(2)(A) may file a request for reconsideration of that decision if such a request for reconsideration is filed within **two months** of the date of the decision (37 CFR 1.181(f)). If the patentee's sole basis for requesting reconsideration of the decision is the USPTO's pre-<u>Wyeth</u> interpretation of 35 U.S.C. 154(b)(2)(A), the request for reconsideration need only state that reconsideration is being requested in view of <u>Wyeth</u> (this form may be used for this purpose if it is filed within **two months** of the date of the decision from the USPTO).

Do not use this form if the application has been allowed, but not yet issued as a patent.

- 1. For patents issued before March 2, 2010: A request for reconsideration under 37 CFR 1.705(d) and the fee set forth in 37 CFR 1.18(e) are not required, provided that the patentee's sole basis for requesting recalculation of the PTA in the patent is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A) and this form is filed within 180 days of the day the patent was granted.
- 2. For patents issued on or after March 2, 2010 (do not use this form): Patentees seeking a revised PTA in a patent issued on or after March 2, 2010, must file a request for reconsideration under 37 CFR 1.705(d) that complies with the requirements of 37 CFR 1.705(b)(1) and (b)(2) within two months of the day the patent issued.

For more information, see "Notice Concerning Calculation of the Patent Term Adjustment With Respect to the Overlapping Delay Provision of 35 U.S.C. 154(b)(2)(A)" available on the USPTO Web site at http://www.uspto.gov/patents/law/notices/2010.jsp.

\*Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

#### **Privacy Act Statement**

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

- 1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
- 2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
- A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record
- 4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
- 5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
- 6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
- 7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
- 8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
- 9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 09/08/2010

INTEL CORPORATION c/o CPA Global P.O. BOX 52050 MINNEAPOLIS, MN 55402

Applicant: Ibrahim Ban: DECISION ON REQUEST FORPatent Number: 7666796: RECALCULATION of PATENTIssue Date: 02/23/2010: TERM ADJUSTMENT IN VIEW

Application No: 11/388,526 : OF WYETH AND NOTICE OF INTENT TO Filed : 03/23/2006 : ISSUE CERTIFICATE OF CORRECTION

:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 834 days. The USPTO will suasponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
BLDG. 082-1
LEXINGTON KY 40550-0999

MAILED

SEP 0'8 2010

OFFICE OF PETITIONS

In re Application of

Dawson, Jedediah T.

Application No. 11/388,848

Filed: March 24, 2006

Attorney Docket No. 2005-0839.01

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed August 3, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of replacement drawings, (2) the petition fee of \$1620.00, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206.

This matter is being referred to the Office of Data Management for processing into a patent.

Mana Walsh

Petitions Examiner Office of Petitions

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

CANTOR COLBURN LLP 20 CHURCH STREET 22<sup>ND</sup> FLOOR HARTFORD, CT 06103

MAILED

JAN 14 2011

**OFFICE OF PETITIONS** 

In re Application of Felice Dimascio Application No. 11/388,892 Filed: March 24, 2006

ON PETITION

Attorney Docket No. NCC0001US2

This is a decision on the petition under 37 CFR 1.137(b), filed November 24, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed May 13, 2010, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on August 14, 2010.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 1734 for further processing.

Trvin Dingle
Petitions Examiner
Office of Petitions

cc:

Benjamin E. Carlsen 1601 W. Diehl Road Naperville, IL 60565-1198



Commissioner for Patents
United States Patent and Trademark Office
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OFFICE OF PETITIONS

In re Application of

Martin U. Christ et al.

Application No. 11/388,896

Filed: March 24, 2006

Attorney Docket No. SGL0002.US

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 26, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of November 10, 2010. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). A three months extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is May 11, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of \$810, and the submission required by 37 CFR 1.114; (2) the petition fee of \$1620; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at (571) 2783.

This application is being referred to Technology Center AU 1744 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Ramesh Krishnamurthy Petitions Examiner

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

BIRCH STEWART KOLASCH & BIRCH P.O. BOX 747 FALLS CHURCH, VA 22040-0747 **MAILED** 

APR 112011
OFFICE OF PETITIONS

In re Application of

Kazunori Abe :

ON PETITION

Application No. 11/388,997 Filed: March 27, 2006

Attorney Docket No. ELECTRONIC ENDOSCOPE APPARATUS

This is a decision on the petition, filed April 8, 2011 under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on March 25, 2011 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 3779 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/ Irvin Dingle Petitions Examiner Office of Petitions

¹ The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON DC 20004

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FEB 28 2011

OFFICE OF PETITIONS

In re Application of

In Jae Chung et al.

Application No. 11/389,036

Filed: March 27, 2006

Attorney Docket No. **41501-0000** 

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 6, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (Notice), mailed March 4, 2010. The Notice set a period for reply of one (1) months from the mail date of the Notice. Accordingly, the application became abandoned on April 5, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form specification, (2) the petition fee of \$1,620, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571)272-4584.

This application is being referred to the Office of Data Management for normal course of business.

Joanne Burke

Petitions Examiner
Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

NIXON PEABODY, LLP 401 9<sup>TH</sup> STREET, NW SUITE 900 WASHINGTON, DC 20004-2128

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OCT 1.9 2010

OFFICE OF PETITIONS

In re Application of

Xin Wang, et al.

Application No. 11/389,096

Filed: March 27, 2006

Attorney Docket No. 111325-164700

**DECISION ON PETITION** 

TO WITHDRAW

FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 10, 2010.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Nixon Peabody, LLP has been revoked by the assignee of the patent application on September 16, 2010. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to undersigned at 571-272-1642.

/AMW/ April M. Wise Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 600 GALLERIA PARKWAY, S.E.

**STE 1500** 

ATLANTA GA 30339-5994

MAILED

MAY 06 2011

In re Application of : OFFICE OF PETITIONS

Arzhang ARDAVAN et al.

Application No. 11/389,183

ON PETITION

Filed: March 27, 2006

Attorney Docket No. 821507-1010

This is a decision on the petition under 37 CFR 1.137(b), filed February 22, 2011, to revive the above-identified application, and the request for refund filed April 25, 2011.

The petition under 37 CFR 1.137(b) is **DISMISSED**.

The request for refund is **DISMISSED**.

#### With respect to the petition under 37 CFR 1.137(b)

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed June 21, 2010, and a one (1) month extension of time under the provisions of 37 CFR 1.136(a) was obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on September 21, 2010. See MPEP 1215.04.

While petitioner did file a declaration under 37 CFR 1.132 on September 21, 2010, 37 CFR 41.33(d)(1) states:

An affidavit or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

Accordingly, entry of the declaration under 37 CFR 1.132 is not proper and the examiner should have used form PTOL-303, Advisory Action Before the Filing of an Appeal Brief to notify applicant of the non-entry and the reasons for non-entry. See MPEP 1206 II. As such, the mailing of the final Office action on February 23, 2011 is improper and any time period set therein has no effect as the examiner does not have the authority to revive an abandoned application and hence, mail an Office action.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item(s) (1).

The application became abandoned for failure to timely file an Appeal Brief in accordance with 37 CFR 41.37. The proposed reply required for consideration of a petition to revive must be an Appeal Brief (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that prima facie places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). The reply is not acceptable because the appeal fee required by 37 CFR 41.20(b)(2) has not been paid.

#### With respect to the refund request

As set forth above, a Petition for Revival of Application for Patent abandoned unintentionally under the provisions of 37 CFR 1.137(b) and an Appeal Brief were received in the USPTO on February 22, 2011.

Applicant now files the above request for refund in the amount of \$810 because the examiner issued a new final Office action which dismissed the appeal and thus, the petition to revive was not necessary. However, as set forth above: (1) the appeal was dismissed and the application became abandoned because no Appeal Brief was filed; and (2) as the application was abandoned the examiner had no authority to mail a final Office action.

As ser forth in MPEP 607.02:

Under 35 U.S.C. 42(d) and 37 CFR 1.26, the Office may refund: (1) a fee paid by mistake (e.g., fee paid when no fee is required); or (2) any fee paid in excess of the amount of fee that is required. See Ex parte Grady, 59 USPQ 276, 277 (Comm'r Pat. 1943) (the

statutory authorization for the refund of fees under the "by mistake" clause is applicable only to a mistake relating to the fee payment).

When an applicant or patentee takes an action "by mistake" (e.g., files an application or maintains a patent in force "by mistake"), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d).

# 37 CFR 1.26(a) also states:

The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.

# Furthermore, MPEP 711.03 (c) states that:

[T]he petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), reprinted in 1982 U.S.C.C.A.N. 770 ("[t]he fees set forth in this section are due on filing the petition"). Therefore, the Office: (A) will not refund the petition fee required by 37 CFR 1.17(1) or 1.17(m), regardless of whether the petition under 37 CFR 1.137 is dismissed or denied; and (B) will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee.

In view of the above, the request for refund is dismissed as the fees were not paid "by mistake".

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/ Karen Creasy Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 400 INTERSTATE NORTH PARKWAY SE SUITE 1500 ATLANTA CA 30339 MAILED
JUL 27 2011

OFFICE OF PETITIONS

In re Application of

Arzhang Ardavan et al

Application No. 11/389,183

Filed: March 27, 2006

Attorney Docket No. 821507-1010

**DECISION ON PETITION** 

This is a decision on the communication styled "REQUEST FOR RECONSIDERATION OF DECISION MAILED MAY 6, 2011 ON PETITION".

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an appeal brief filed February 22, 2011; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply is accepted as having been unintentionally delayed.

Further, the required appeal brief fee is being charged to petitioner's deposit account as authorized.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 2881 for appropriate action by the Examiner in the normal course of business.

/KOC/ Karen Creasy Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

In re Patent No. 7305781

Issue Date: December 11,2007

Application No. 11389270 :DECISION GRANTING PETITION :UNDER 37 CFR 1.378(c)

Filed: March 24,2006

Attorney Docket No. MOWRY

This is a decision on the electronic petition, filed December 29,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and
this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print
and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number. PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c)) Issue Date Application Filing Date Patent Number Docket Number (if applicable) (YYYY-MM-DD) (YYYY-MM-DD) Number 7305781 2007-12-11 11389270 2006-03-24 CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d). SMALL ENTITY Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27. LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g) Small Entity **NOT Small Entity** Code Fee Code Fee 3 1/2 year (2551)3 ½ year (1551)7 ½ year (2552)(1552)7 ½ year (2553)11 1/2 year 11 1/2 year (1553)SURCHARGE The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee. MAINTENANCE FEE (37 CFR 1.20(e)-(g)) The appropriate maintenance fee must be submitted with this petition. STATEMENT THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES 37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest." I certify, in accordance with 37 CFR 1.4(d)(4) that I am An attorney or agent registered to practice before the Patent and Trademark Office A sole patentee A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees. A joint patentee; all of whom are signing this e-petition

The assignee of record of the entire interest

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Sole Patentee						
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature.						
Signature	/Holly L. Mowry/	Date (YYYY-MM-DD)	2011-12-29			
Name	Holly L. Mowry					

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.

# **Privacy Act Statement**

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

- 1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.
- A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
- 3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
- 4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
- 5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
- 6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
- 7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
- 8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
- 9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

MAGINOT, MOORE & BECK CHASE TOWER SUITE 3250 111 MONUMENT CIRCLE INDIANAPOLIS, IN 46204

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OFFICE OF PETITIONS

In re Application of

Johannes Bucher

Application No. 11/389,292

Filed: March 24, 2006

Attorney Docket No. 1867-0118

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 6, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to file a reply within the meaning of 37 CFR 1.113 to the final Office action of August 19, 2010. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that prima facie places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were timely obtained. Accordingly, the date of abandonment of this application is November 20, 2010. A Notice of Abandonment was mailed May 5, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) including the fee of \$810 and the submission required by 37 CFR 1.114, (2) the petition fee of \$1,620, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6059.

This application is being referred to Technology Center AU 3656 for processing of the RCE and for appropriate action by the Examiner in the normal course of business in accordance with 37 CFR 1.114./

Alicia Kelley-Collier
Petitions Examiner
Office of Petitions



· Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

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JOHN R. ROSS TREX ENTERPRISES 10455 PACIFIC CENTER CT SAN DIEGO CA 92121 SEP 1 3 2010

OFFICE OF PETITIONS

In re Application of

Izu-Chiang Hsieh et al

Application No. 11/389,356

Filed: March 24, 2006

Attorney Docket No. 674

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 6, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an election; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the restriction requirement Office action mailed August 4, 2009, is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 2622 for appropriate action by the Examiner in the normal course of business on the reply received July 6, 2010.

/KOC/ Karen Creasy Petitions Examiner Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

October 11, 2011

Patent No.

: 7,414,894 B2

Appl. No.

: 11/389,557

Inventor(s)

: Jeffrey W. Lutze, et al.

Issued

: August 19, 2008

Title

: METHODS FOR IDENTIFYING NON-VOLATILE MEMORY

ELEMENTS WITH POOR SUBTHRESHOLD SLOPE OR WEAK

TRANSCONDUCTANCE

Docket No. : SNDK.301US1

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based solely on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing *incorrect or erroneous* assignment data, before issuance of a Certificate of Correction under 37 CFR 1.323 (see Manual of Patent Examining Procedures (M.P.E.P) Chp. 1400, sect. 1481). This procedure is required at any time after the issue fee is paid, including after issuance of the patent.

In view of the foregoing, your request, in this mater, is hereby denied.

All petitions for correction of Assignees' names under rule 3.81(b) should:

- (A) state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent;
- (B) include a request for a certificate of correction under 37 CFR 1.323 along with the fee set forth in 37 CFR 1.20(a); (unless fee (currently \$100) was previously paid for consideration of request for certificate of correction)
- (C) include the processing fee set forth in 37 CFR 1.17(i).

The petition under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail:

Mail Stop PETITIONS

Commissioner for Patents Post Office Box 1450

Alexandria, VA 22313-1450

By hand:

Customer Service Window

Mail Stop Petitions Randolph Building 40l Dulany Street Alexandria, VA 22314

(Hours of operation are 8:30 a.m. to midnight, Eastern Standard Time, Monday through Friday)

By fax:

(571) 273-8300

ATTN: Office of Petitions

# Antonio Johnson

For Mary F. Diggs Decisions & Certificates of Correction Branch (571)272-0483

DAVIS WRIGHT TREMAINE LLP - SANDISK CORPORATION 505 MONTGOMERY STREET SUITE 800 SAN FRANCISCO CA 94111



DAVIS WRIGHT TREMAINE LLP - SANDISK CORPORATION 505 MONTGOMERY STREET SUITE 800 SAN FRANCISCO CA 94111

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OFFICE OF PETITIONS

In re Patent No. 7,414,894
Issue Date: August 19, 2008
Application No. 11/389.557

Application No. 11/389,557 : DE

Filed: March 23, 2006

Attorney Docket No. SNDK.301US1

DECISION ON PETITION

This is a decision on the petition under 37 CFR 3.81(b), filed October 21, 2011.

The petition is GRANTED.

An application may issue in the name of an assignee rather than the applicant if requested prior to issuance of a patent. However, in the event the request is not made prior to issuance, a Certificate of Correction under 37 CFR 1.323 may be requested. A request for a Certificate of Correction under 37 CFR 1.323 to correct the assignee's name will not be granted unless a petition under 37 CFR 3.81(b) is granted. Such request under 37 CFR 3.81(b) should include:

- (A) the processing fee required by 37 CFR 1.17(i);
- (B) a request for issuance of the application in the name of the assignee, or a request that a patent be corrected to state the name of the assignee;
- (C) a statement that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent; and

<sup>&</sup>lt;u>See</u> 37 CFR 3.81.

(D) a request for a certificate of correction under 37 CFR 1.323 accompanied by the fee set forth in 37 CFR 1.20(a).

Receipt of the \$130 processing fee and the \$100 fee for the Certificate of Correction is acknowledged.

The file is being forwarded to the Certificate of Corrections Branch for issuance of the requested Certificate of Correction.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Uff

Cliff Congo Petitions Attorney Office of Petitions

<sup>&</sup>lt;sup>2</sup> MPEP 307.





Foley & Lardner LLP 150 EAST GILMAN STREET P.O. BOX 1497 MADISON WI 53701-1497

MAILED FEB 272012 OFFICE OF PETITIONS

In re Application of

Alattar

Application No. 11/389,560

Filed: March 23, 2006

Attorney Dkt. No. 098888-1926

IDENTIFY VIDEO CONTENT

For: VIDEO FINGERPRINTING TO

ON APPLICATION FOR PATENT TERM ADJUSTMENT

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)" filed February 7, 2012. Applicant requests that the determination of patent term adjustment be corrected from zero (0) days to five hundred twenty-three (523) days. Applicant requests this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

The \$200.00 petition fee set forth in 37 CFR 1.18(e) has been assessed. No additional fees are required. The fee set forth in 37 CFR 1.18(e) is required and will not be refunded.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under §

1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee1.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months

For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the \$1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

after issuance pursuant to 37 CFR 1.705(d) and  ${\bf must}$  include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3215.

Charlema Grant

Attorney Advisor



DELAND LAW OFFICE P.O. BOX 69 KLAMATH RIVER CA 96050-0069 MAILED
APR 2 0 2011
OFFICE OF PETITIONS

In re Application of SATOSHI SHAHANA

Application No. 11/389,658

Filed: March 22, 2006

Attorney Docket No. SIC-00-007-1

**DECISION ON PETITION** 

This is a decision on the petition, filed August 30, 2010, requesting "waiver of the requirement of 37 C.F.R. § 1.84(h)(3), that hatching must be used in patent drawings to indicate section portions of an object. Alternatively, the petitioner requests waiver of the requirement of 37 C.F.R. § 1.84(h)(3) insofar as it is mandatory that different types of hatching must have different conventional meanings as regards the nature of a material seen in cross section."

# The petition is **GRANTED** to the extent indicated below.

The instant application is a reissue application of US Patent No. 6,450,060. Amended drawings of Figures 1 – 5 were filed on August 3, 2010, wherein Figures 4 and 5 represent cross-sectional views of a device shown in Figure 2. In not accepting the drawings filed August 3, 2010, the Examiner noted in the Advisory action mailed August 19, 2010, that "[t]hese drawings are not accepted by the Examiner because the drawings are not in compliance with 37 CFR 1.84 as required under 37 CFR 1.173(b)(3)." In response thereto, the instant petition was filed on August 30, 2010.

The applicable regulation in 37 CFR 1.84(h)(3) requires:

<u>Sectional views</u>. The plane upon which a sectional view is taken should be indicated on the view from which the section is cut by a broken line. The ends of the broken line should be designated by Arabic or Roman numerals corresponding to the view number of the sectional view, and should have arrows to indicate the direction of sight. Hatching must be used to indicate

section portions of an object, and must be made by regularly spaced oblique parallel lines spaced sufficiently apart to enable the lines to be distinguished without difficulty. Hatching should not impede the clear reading of the reference characters and lead lines. If it is not possible to place reference characters outside the hatched area, the hatching may be broken off wherever reference characters are inserted. Hatching must be at a substantial angle to the surrounding axes or principal lines, preferably 45°. A cross section must be set out and drawn to show all of the materials as they are shown in the view from which the cross section was taken. The parts in cross section must show proper material(s) by hatching with regularly spaced parallel oblique strokes, the space between strokes being chosen on the basis of the total area to be hatched. The various parts of a cross section of the same item should be hatched in the same manner and should accurately and graphically indicate the nature of the material(s) that is illustrated in cross section. The hatching of juxtaposed different elements must be angled in a different way. In the case of large areas, hatching may be confined to an edging drawn around the entire inside of the outline of the area to be hatched. Different types of hatching should have different conventional meanings as regards the nature of a material seen in cross section.

As part of the guidance provided on the use of symbols in drawings filed in patent applications, MPEP § 608.02, paragraph (IX), states that, "[o]verly specific symbols should be avoided. Symbols with unclear meanings should be labeled for clarification." In noting that "use of conventional features is very helpful in making prior art searches", this section of MPEP also states that the specific symbols listed therein "should be used to indicate various materials where the material is an important feature of the invention" (emphasis added). The applicable regulation on the use of symbols in drawings is set forth in CFR 1.84(n):

<u>Symbols</u>. Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

It is noted that the disclosure of the instant application does not set forth a specific material as being associated with the device whose cross-sectional views are shown in Figs. 4 and 5. It should be possible for the applicant to use hatching with "regularly spaced parallel oblique strokes, the space between strokes being chosen on the basis of the total area to be hatched," as required by 37 CFR 1.84(h)(3). It is suggested that the applicant superimpose a symbol on the "parallel oblique strokes" to be used in the hatching, with the symbol so chosen as to avoid a conflict with the currently accepted conventional material designations. In order to

aid in adequate identification of the use of such a symbol, as required by 37 CFR 1.84(n), applicants should add a sentence to the specification stating that the hatching shown in Figures 4 and 5, resulting from the use of the specific symbol superimposed on the parallel oblique strokes, represents no specific material. The addition of such a statement to the specification will not be considered as new matter under 37 CFR 1.173(a), as no specific material has been disclosed in the disclosure as originally filed.

37 CFR 1.183 permits, in an extraordinary situation, when justice requires, any requirement of the regulations which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Accordingly, for the reasons set forth above, this decision may be taken as waiving, to the extent indicated above, the specific requirement under 37 CFR 1.84(h)(3) that requires "different types of hatching must have different conventional meanings as regards the nature of a material seen in cross section."

Any questions concerning this decision may be directed to the undersigned at (571) 272-4914. Any questions concerning the status of the application must be directed to the Technology Center.

This decision is being forwarded to the Technology Center Group Art Unit 3656 for processing the Request for Continued Examination filed November 3, 2010, and other papers filed therewith.

Ramesh Krishnamurthy

Petitions Examiner



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

Decision Date: November 7,2011

In re Application of : DECISION ON REQUEST TO WITHDRAW AS

Kayvan Niazi ATTORNEY/AGENTOF RECORD

Application No: 11389695

Filed: 27-Mar-2006

Attorney Docket No: 638772006700

This is an electronic decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed November 7,2011

The request is **APPROVED.** 

The request was signed by Catherine M. Polizzi (registration no. 40130 ) on behalf of all attorneys/agents associated with Customer Number 25226 . All attorneys/agents associated with Cusotmer Number 25226 have been withdrawn.

Since there are no remaining attorneys of record, all future communications from the Office will be directed to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71, with correspondence address:

Name The Buck Institute for Age Research

Name2

Address 1 8001 Redwood Blvd.

Address 2

City Novato
State CA

Postal Code 94945

Country US

As a reminder, requester is required to inform the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 of the electronically processed petition.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

Doc Code: PET.AUTO Document Description: Petition :	automatically granted by EFS-Web	PTO/SB/83 U.S. Patent and Trademark Office Department of Commerce			
Electronic Petition Request	REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS				
Application Number	11389695	11389695			
Filing Date	27-Mar-2006				
First Named Inventor	Kayvan Niazi				
Art Unit	1643				
Examiner Name	BRADLEY DUFFY				
Attorney Docket Number	638772006700				
Title	Reagents and methods for cancer treatment and prevention				
	orney or agent for the above identified patent associated with Customer Number:	application and 25226			
The reason(s) for this request are	those described in 37 CFR:				
10.40(b)(4)					
<b>Certifications</b>					
I/We have given reasonable intend to withdraw from em	notice to the client, prior to the expiration of the r ployment	response period, that the practitioner(s)			
I/We have delivered to the country to which the client is entitled	lient or a duly authorized representative of the cli	ent all papers and property (including funds)			
✓ I/We have notified the client	t of any responses that may be due and the time fi	rame within which the client must respond			
Change the correspondence addre properly made itself of record purs	ess and direct all future correspondence to the firs evant to 37 CFR 3.71:	t named inventor or assignee that has			
Name	The Buck Institute for Age Research				
Address	8001 Redwood Blvd.				
City	Novato				
State	CA				
Postal Code	94945	945			
Country	US				
	1				

Signature	/Catherine Polizzi/
Name	Catherine M. Polizzi
Registration Number	40130

Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

HOGAN LOVELLS US LLP IP GROUP, COLUMBIA SQUARE 555 THIRTEENTH STREET, N.W. WASHINGTON DC 20004

MAILED

SEP 2 2 2010 OFFICE OF PETITIONS

In re Patent No. 7,797,273 Issue Date: September 14, 2010 Application No. 11/389,754

NOTICE

Filed: March 27, 2006

Attorney Docket No. 82031-0024

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed July 15, 2010 and supplemented on July 20, 2010.

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3215.

Charlema Grant

**Petitions Attorney** 

MICHAEL B. MARTIN
PATENT AND LICENSING DEPARTMENT
NALCO COMPANY
1601 WEST DIEHL ROAD
NAPERVILLE IL 60563-1198

MAILED

AUG 18 2011

OFFICE OF PETITIONS

In re Application of

KEISER, et al

Application No. 11/389,756

Filed: March 27, 2006

Docket No. 7921

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 4, 2011, to revive the above-identified application.

:

# The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, February 1, 2011, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on May 2, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of \$1620; and (3) and the required statement of unintentional delay.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney document must be submitted.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6735.

This application is being referred to Technology Center AU 1617 for appropriate action by the Examiner in the normal course of business.

/Diane C. Goodwyn/
Diane C. Goodwyn
Petitions Examiner
Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

# PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR NY 10510

**MAILED** 

AUG 3 0 2010

OFFICE OF PETITIONS

In re Application of

John D. Dobak, III et al.

Application No. 11/389,879 : DECISION ON PETITION

Filed: March 27, 2006

Attorney Docket No. 014218US9

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 27, 2010, to revive the above-identified application.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, May 29, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 30, 2009.

## The petition is **GRANTED**.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of \$1,620, and (3) a proper statement of unintentional delay.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571) 272-4584.

This application is being referred to Technology Center AU 3739 for appropriate action by the Examiner in the normal course of business.

JoAnne Burke

Petitions Examiner
Office of Petitions



# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/06/2010

BROOKS KUSHMAN P.C. /Oracle America/ SUN / STK 1000 TOWN CENTER, TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075-1238

Applicant : Francis Campos : DECISION ON REQUEST FOR Patent Number : 7656610 : RECALCULATION of PATENT Issue Date : 02/02/2010 : TERM ADJUSTMENT IN VIEW

Application No: 11/389,901 : OF WYETH AND NOTICE OF INTENT TO Filed : 03/27/2006 : ISSUE CERTIFICATE OF CORRECTION

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 870 days. The USPTO will sua sponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

• . . . .

	SPE RESPONSE FOR CER	RTIFICATE OF CORRECTION
DATE	01-07-10	Paper No.:
TO SPE OF	: ART UNIT	
		11/200006 5 7707064
SUBJECT	: Request for Certificate of Correction for	Appl. No.: 11/389906 Patent No.: 7787864
		CofC mailroom date: 12-22-10
Please respon	nd to this request for a certificate of	correction within 7 days.
FOR IFW FIL	ES:	
application im claims be cha	age. No new matter should be intro nged.	as shown in the COCIN document(s) in the IFW duced, nor should the scope or meaning of the
document cod		rward the completed response to scanning using
FOR PAPER	FILES:	
	the requested changes/corrections ete this form (see below) and forwar	as shown in the attached certificate of correction. rd it with the file to:
Randolp	tes of Correction Branch (CofC) h Square – 9D10-A cation 7580	Certificates of Correction Branch
		Angela Green
Thank You	For Your Assistance	Aligela Oreali
The request	for issuing the above-identifie on the appropriate box.	d correction(s) is hereby:
a	Approved	All changes apply.
	Approved in Part	Specify below which changes do not apply.
	Denied	State the reasons for denial below.
Comments:	Correctus, add no	nes malle
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SPE / Art Unit
U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office
SUPERVISORY PATENT EXAMINER 2600
TECHNOLOGY CENTER 2600

PTOL-306 (REV. 7/03)



MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO IL 60661

MAILED

SEP 29 2010

OFFICE OF PETITIONS

In re Patent No. 7,747,847

Issued: June 29, 2010

Application No. 11/389,980

Filed: March 27, 2006

Attorney Docket No. 16564US02

: LETTER REGARDING

PATENT TERM ADJUSTMENT

This is a decision on the APPLICATION FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 35 U.S.C. § 154(b) INDICATED IN THE PATENT (37 CFR § 1.705(d)) filed on August 27, 2010, requesting that the patent term adjustment indicated on the above-identified patent be corrected from 953 days to 968 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and is being considered in light of the Court of Appeals for the Federal Circuit's decision in *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. 1-7-2010).

The request for review of the patent term adjustment is **DISMISSED**.

Patentees are given THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The patent term adjustment indicated in the patent is properly reflected.

Patentee has miscalculated the total patent term adjustment. In this instance the period consumed by appellate review began on November 11, 2009 and ended on February 17, 2010 with the mailing of the Notice of Allowance and is 98 days. Further, the Office has determined that the period of overlap is 4 days. Considering the exclusion and the overlap, the "B delay" is 361 days. Thus, the patent term adjustment is 953 days.

The Office acknowledges the submission of the required fee of \$200.00 set forth in 37 CFR 1.18(e) .

Telephone inquiries specific to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball Senior Petitions Attorney



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 01/12/2011

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036

Applicant: Keiji Nosaka: DECISION ON REQUEST FORPatent Number: 7602055: RECALCULATION of PATENTIssue Date: 10/13/2009: TERM ADJUSTMENT IN VIEW

Application No: 11/390,200 : OF WYETH AND NOTICE OF INTENT TO Filed : 03/28/2006 : ISSUE CERTIFICATE OF CORRECTION

155UE CERTIFICATE OF CORRECTI

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be  $\bf 224$  days. The USPTO will  $\it suasponte$  issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.



FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON DC 20007

MAILED

AUG 3 0 2010
OFFICE OF PETITIONS

In re Application of

Youngho CHO et al.

Application No. 11/390,203 Filed: March 28, 2006

Patent No. 7,400,192

Issued: July 15, 2008

Attorney Docket No. 078134-0122

NOTICE UNDER 37 CFR. 1.28(c)

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to Michelle R. Eason at (571) 272-4231.

Thurman K. Page Petitions Examiner Office of Petitions



INTEGRAL INTELLECTUAL PROPERTY INC./RIM SUITE 300 1370 DON MILLS ROAD TORONTO ON M3B 3N7 CANADA

**MAILED**APR 0 1 2011

**OFFICE OF PETITIONS** 

In re Application of

Matthew Bells et al. : DECISION ON APPLICATION

Application No. 11/390,214 : FOR PATENT TERM ADJUSTMENT

Filed: March 28, 2006

Attorney Docket No. RIM044-01US

This is in response to the "Application for Patent Term Adjustment under 37 C.F.R. § 1.705(b)" filed January 26, 2011. Applicants request the initial determination of patent term adjustment be corrected from nine hundred sixty-one (961) days to one thousand three hundred eighty-six (1,386) days.

The request for reconsideration of the initial determination of patent term adjustment is granted to the extent indicated herein.

The Office has updated the PALM screen to indicate the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is 937 days. A copy of the updated PALM screen showing the correct determination is enclosed.

The Office issued a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) on January 26, 2011, in the application advising Applicants of a patent term adjustment to date of 961 days. The instant petition was timely filed on January 26, 2011.

Applicants assert the patent term adjustment should be increased by 449 days for Office delay under 37 C.F.R. § 1.703(b) ("B delay"). Applicants also assert the patent term adjustment should be reduced 24 days for delay under 37 C.F.R. § 1.704 ("Applicant Delay").

#### B Delay

To the extent applicants request reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the request is premature.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See 37 C.F.R. § 1.702(b). (This is true even where a request for continued examination ("RCE") was filed). The computer will not undertake the 37 C.F.R. § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 C.F.R. § 1.702(a)(4) or applicant delay under 37 C.F.R. § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 C.F.R. § 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature.

Rather than file an application for patent term adjustment under 37 C.F.R. § 1.705(b) contesting the 37 C.F.R. § 1.702(b) calculation at the time of the mailing of the notice of allowance, an applicant may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 C.F.R. § 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 C.F.R. § 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 C.F.R. § 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee. <sup>1</sup>

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 C.F.R. § 1.705(d) and must include payment of the required fee under 37 C.F.R. § 1.18(e).

# **Applicant Delay**

Applicants indicate a 24-day reduction in patent term adjustment is appropriate under 37 C.F.R. § 1.704(c)(8) based on the submission of an information disclosure statement ("IDS") on January 29, 2009, following the submission of a response to a non-final Office action on January 5, 2009.

<sup>&</sup>lt;sup>1</sup> For example, if applicant disputes both the calculation of patent term adjustment under 37 C.F.R. § 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 C.F.R. § 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 C.F.R. § 1.705(b) and 35 U.S.C. § 154(b)(3)(B). A dispute as to the calculation of the 37 C.F.R. § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(d) will be dismissed as untimely filed.

The Office has reviewed the record and agrees entry of a 24-day reduction in patent term adjustment is warranted. Therefore, the Office has entered a 24-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8).

#### Conclusion

The Determination of Patent Term Adjustment under 35 U.S.C. 154(b) mailed with the Notice of Allowance on June 19, 2009, advised of a patent term adjustment to date of 961 days, which was the sum of 500 days of Office Delay under 37 C.F.R. § 1.703(a)(1) and 461 days of delay under 37 C.F.R. § 1.703(a)(2).

As previously discussed, the patent term adjustment should have included a 24-day reduction for Applicant Delay. Therefore, the proper patent term adjustment at the time the Notice of Allowance issued is 937 days, which is the sum of 500 days of Office Delay under 37 C.F.R. § 1.703(a)(1) and 461 days of delay under 37 C.F.R. § 1.703(a)(2) reduced by 24 days of Applicant Delay.

Applicants are reminded that any delays by the Office pursuant to 37 C.F.R. §§ 1.702(a)(4) and 1.702(b) and any Applicant Delay under 37 C.F.R. § 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to Applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley Senior Petitions Attorney

Office of Petitions

Enclosure: Copy of REVISED PALM screen



PTA/PTE Information

Patent <u>T</u>erm Adjustment

Patent Term <u>E</u>xtension

Application Number\*: 11390214

Search Explanation of PTA Calculation Explanation of PTE Calculation

PTA Calculations for Application: 11390214

Application Filing Date 03/28/2006	OverLapping Days Between (A and B) or (A and C)
Issue Date of Patent	Non-Overlapping USPTO Delays: 961
A Delays 961	PTO Manual Adjustment -24
B Delays 0	Applicant Delay (APPL) 0
C Delays 0	Total PTA (days) 937

#### \* - Sorted Column

## File Contents History

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Action Number	Action Recorded <u>Date</u>	Action Due Date	Action Code	<u>Action</u> <u>Description</u>	<u>Duration</u> <u>PTO</u>	Duration APPL	Parent Action Number
70 .	03/30/2011	State of the	P028	Adjustment of PTA Calculation by PTO		24	0
57	01/26/2011		MN/=.	Mail Notice of Allowance	• •		0
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55	01/21/2011		DVER	Document Verification		. * **** -	0
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49	01/13/2011	38121 P. 2	EXIN	Examiner Interview Summary Record (PTOL - 413			0
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47 **** ************	09/28/2010	**	IDSC	Information Disclosure Statement considered		e 11 125m 1	0
42	09/28/2010		A	Response after Non-Final Action			0
41	09/28/2010		M844	Information Disclosure Statement (IDS) Filed			0
40	09/28/2010		WIDS	Information Disclosure Statement (IDS) Filed			0
39	08/30/2010		INHY	case Inherited			0
38	08/30/2010		DOCK	Case Docketed to Examiner in GAU			0
16	08/09/2010		IDSC	Information Disclosure Statement considered			0
37	08/09/2010		EIDS.	Electronic Information Disclosure Statement			0
35	08/09/2010		WIDS	Information Disclosure Statement (IDS) Filed			0
34	08/09/2010			Electronic Review			0
33	08/09/2010		EML_NTF	Email Notification			0
32 S	08/09/2010	05/05/2009	MCTNF	Mail Non-Final Rejection	461		25
11	08/03/2010	03/03/2009	CTNF	Non-Final Rejection	<u>461</u>		0
26				· · · · · · · · · · · · · · · · · · ·			-
	02/13/2009		FWDX	Date Forwarded to Examiner			0
28	01/29/2009		IDSC	Information Disclosure Statement considered			0
24	01/29/2009	184	WIDS	Information Disclosure Statement (IDS) Filed	20 miles 2000	North Art S	0
25	01/05/2009		Α	Response after Non-Final Action			0
29	12/08/2008		IDSC	Information Disclosure Statement considered			0
27	12/08/2008		EIDS.	Electronic Information Disclosure Statement			0
23	12/08/2008	Baku w uvalturi.b	WIDS	Information Disclosure Statement (IDS) Filed		1 - 1 - 12 to 1	0
22	10/14/2008		ELC_RVW	Electronic Review			0
21	10/11/2008		EML_NTF	Email Notification	er er er er er er	* * * * *	0
20	10/09/2008	05/28/2007	MCTNF	Mail Non-Final Rejection	500		0.5
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5	06/19/2008		DOCK	Case Docketed to Examiner in GAU			Total Administration of O
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2	10/04/2007		PG-ISSUE	PG-Pub Issue Notification		· · · · · · · · · · · · · · · · · · ·	0
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9°. €	10/03/2007		EIDS.	Information Disclosure Statement considered	4.1	-	О О
				Electronic Information Disclosure Statement			•
7	10/03/2007		WIDS	Information Disclosure Statement (IDS) Filed			0
.7	07/28/2006		IDSC	Information Disclosure Statement considered			0
0.7	07/28/2006		EIDS.	Electronic Information Disclosure Statement			0
.0	07/28/2006		WIDS	Information Disclosure Statement (IDS) Filed			0
,	06/22/2006		DOCK	Case Docketed to Examiner In GAU	•		0
.8	05/26/2006		IDSC	Information Disclosure Statement considered			0
	05/26/2006		RCAP	Reference capture on IDS			0
.7	05/26/2006		M844	Information Disclosure Statement (IDS) Filed			0
	05/26/2006		WIDS	Information Disclosure Statement (IDS) Filed			0
i	04/26/2006		TSSCOMP	IFW TSS Processing by Tech Center Complete			o
,	04/20/2006		COMP	Application Is Now Complete			- 0
i	04/19/2006		OIPE	Application Dispatched from OIPE			•
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	04/05/2006		SCAN	IFW Scan & PACR Auto Security Review		1	
	03/28/2006		IEXX	Initial Exam Team on			0

> MAILED OCT 04 2011 OFFICE OF PETITIONS

HARNESS, DICKEY, & PIERCE, P.L.C 7700 BONHOMME, SUITE 400 ST. LOUIS, MO 63105

In re Patent No. 7,339,548

Issued: March 4, 2008

Application No. 11/390,599

Filed: March 28, 2006

Attorney Docket No.: 9062E-000346/US

**NOTICE** 

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28, filed September 22, 2011.

The Office no longer investigates or rejects original or reissue patent under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

/SDB/

Sherry D. Brinkley **Petitions Examiner** Office of Petitions



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402-1498

MAILED
DEC 0 9 2010
OFFICE OF PETITIONS

In re Application of

Chifei Wu et al

Application No. 11/390,621 Filed: March 28, 2006

Attorney Docket No. 187670/US

**DECISION GRANTING PETITION** 

: UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed December 7, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

The petition is not signed by an attorney of record. Nevertheless, in accordance with 37 CFR 1.34, the signature of Mr. Bryan A. Wong appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts. If Mr. Wong desires to receive future correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

Petitioner is advised that the issue fee paid on November 18, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). <u>Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.</u>

This application is being referred to Technology Center AU 1796 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

/Karen Creasy/ Karen Creasy Petitions Examiner Office of Petitions

Cc:

HAMRE, SCHUMANN, MUELLER & LARSON, P.C. P.O. BOX 2902 MINNEAPOLIS, MN 55402-0902

	SPE RESPONSE FOR CERTIFICATE OF CORRECTION		
DATE	: 10/24/11		
TO SPE OF	: ART UNIT		
SUBJECT	: Request for Certificate of Correction for Appl. No.: <u>11390689</u> Patent No.:	7818659	_
	CofC mailroom date:	10/14/11	

Please respond to this request for a certificate of correction within 7 days.

# **FOR IFW FILES:**

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

## FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square – 9D10-A
Palm Location 7580
You can fax the Directors/SPE response to 571-273-3421

Note: Should the changes to claim 23 be approved?



**Certificates of Correction Branch** 

571-272-3421

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

# SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Note	VOUL	decision	on the	appropriate	hov
INULE	vou	decision	on me	appropriate	DUX.

Approved	All changes apply.
☐ Approved in Part	Specify below which changes do not apply.
☐ Denied	State the reasons for denial below.
comments: The requested cor- spelling errors, grammatical er Thus, the requested correction	rections merely correct rors and typographic errors. s are approved.
	2176 SPE Art Unit

DOUG HUTTON SUPERVISORY PATENT EXAMINER



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

KOPPEL, PATRICK, HEYBL & PHILPOTT, PLC
2815 TOWNSGATE ROAD
SUITE 215
WESTLAKE VILLAGE CA 91361-5827
AUG 03 20!1

OFFICE OF PETITIONS

In re Application of

Yefim Samullovich Poberezhskiy

Application No. 11/390,762

Filed: March 28, 2006

Attorney Docket No. 2005-033US8

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 18, 2011, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before April 20, 2011, as required by the Notice of Allowance and Fee(s) Due mailed January 20, 2011. Accordingly, the date of abandonment of this application is April 21, 2011. A Notice of Abandonment was mailed May 5, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of \$1,510.00 and the publication fee of \$300.00, (2) the petition fee of \$1,620.00; and (3) a proper statement of unintentional delay.

Further, it is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

This application is being referred to the Office of Data Management for processing into a patent.

/Joan Olszewski/ Joan Olszewski Petitions Examiner Office of Petitions



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

Mail Date: 08/02/2010

INTEL/BSTZ
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

Applicant: Sam Sivakumar: DECISION ON REQUEST FORPatent Number: 7648803: RECALCULATION of PATENTIssue Date: 01/19/2010: TERM ADJUSTMENT IN VIEW

Application No: 11/390,779 : OF WYETH AND NOTICE OF INTENT TO Filed : 03/27/2006 : ISSUE CERTIFICATE OF CORRECTION

JOOL CHRITITICITIE O.

:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be 863 days. The USPTO will suasponte issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

<b>₩</b> 1*	SPE RESPONSE FO	R CERTIFICATE OF C	ORRECTION	·
DATE :	92711			Paper No.:
TO SPE OF : ART U	NIT 3641	•		
SUBJECT : Request	for Certificate of Correction	on for Appl. No.:	SUNSOF Patent	No. 7970644
			CofC mailroom da	
Please respond to the	is request for a certi	ficate of correction		te: 95 91 11
FOR IFW FILES:	Check (	COPC -S	hald the	, be approved
Please review the rethe IFW application in meaning of the claim	quested changes/comage. No new matt	rrections as shown	in the COCIN do	cument(s) in
Please complete the using document code	response (see belove COCX.	w) and forward the	completed respo	nse to scanning
FOR PAPER FILES:				
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•		•	Certificates of Co	rrection Branch
	·		703-756-1814 _	
Thank You For You	r Assistance			
The request for issu		itified correction(s	s) is hereby:	
□ Approv	ed .	All changes a	ipply.	
☐ Approv	ed in Part	Specify below	which changes <b>d</b>	o not apply.
□ Denïed		State the reas	sons for denial belo	ow.
Comments:				•
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	<u> </u>	SPE	(	Art Unit
TOL-306 (REV. 7/03)		U.S. DEPARTMENT (	OF COMMERCE Pater	nt and Trademark Office

PTOL-306 (REV. 7/03)



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.usplo.gov

AT & T LEGAL DEPARTMENT - NDQ ATTN: PATENT DOCKETING ONE AT & T WAY, ROOM 2A-207 BEDMINSTER, NJ 07921

MAILED

OCT 21 2010

In re Application of

Emmett Dudley Crawford, et. al.

Application No. 11/390,826 Filed: March 28, 2006

Attorney Docket No. 80449

**OFFICE OF PETITIONS** 

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 8, 2010, to revive the above-identified application.

The application became abandoned for failure to file a proper reply to the final Office action mailed on August 27, 2009. A Notice of Abandonment was mailed on August 17, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) with the \$810 fee<sup>1</sup> and a submission under 37 CFR 1.114; (2) the petition fee of \$1,620; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

It is noted that address given in the present petition differs from the correspondence address of record. Therefore, a courtesy copy of this decision is being mailed to petitioner. Thereafter, all future communications from the Office will be mailed solely to the address of record until otherwise instructed.

This application file is being referred to Technology Center Art Unit 1796 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

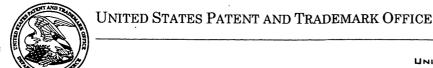
relephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

Petitions Examiner
Office of Petitions

cc: Betty J. Boshears

P.O. Box 511 Kingsport, TN 37662

<sup>&</sup>lt;sup>1</sup> Since the RCE filed on July 9, 2010 is considered as improper, the \$810 fee will be refunded to petitioner's deposit account.



COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BETTY JOY BOSHEARS EASTMAN CHEMICAL COMPANY P.O. BOX 511 KINGSPORT TN 37662

**MAILED** 

OCT 12 2010

In re Application of Crawford, et al.

OFFICE OF PETITIONS

Application No. 11/390,827

ON PETITION

Filed: March 28, 2006

Attorney Docket No. 80383

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 17, 2010, to revive the above-identified application.

The petition is GRANTED.

The application became abandoned July 15, 2010 for failure to timely submit a proper reply following the submission of a Notice of Appeal on December 14, 2009. An improper request for continued examination (RCE) and a five month petition for extension of time were filed July 8, 2010. Notice of Abandonment was mailed August 3, 2010.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

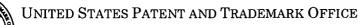
The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE), including fee and submission required by 37 CFR 1.114; (2) the required petition fee; and (3) a proper statement of unintentional delay.

This application is being referred to Technology Center AU 1796 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown Petitions Attorney Office of Petitions





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

CHARLES N.J. RUGGIERO, ESQ.
OHLANDT, GREELEY, RUGGIERO & PERLE, L.L.P.
10th FLOOR
ONE LANDMARK SQUARE
STAMFORD CT 06901-2682

MAILED
MAR 0 6 2012
OFFICE OF PETITIONS

In re Application of

Chomik et al.

Application No. 11/390,941 : DECISION ON PETITION Filed: March 27, 2006 : UNDER 37 CFR 1.78(a)(6)

Attorney Docket No. 460.2132USQ1

This is a decision on the petition under 37 CFR 1.78(a)(6), filed February 23, 2012, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional application set forth in the concurrently filed amendment and ADS.

# The petition is **GRANTED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Additionally, the instant nonprovisional application must be pending at the time of filing of the reference to the prior-filed provisional application as required by 37 CFR 1.78(a)(5)(ii). Further, a nonprovisional application in the priority chain claiming the benefit of the prior-filed provisional application must have been filed within twelve months of the filing date of the prior-filed provisional application.

37 CFR § 1.78(a)(6) requires a statement that the entire delay between the date the claim was due under 37 CFR § 1.78(a)(5)(ii) and the date the claim was filed was unintentional. Since the statement appearing in the petition varies from the required language, the statement is being

construed as the statement required by 37 CFR §1.78(a)(6). If this is not a correct reading of the statement appearing in the petition, practitioner should promptly notify the Office.

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 119(e) is accepted as being unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(6) should not be construed as meaning that this application is entitled to the benefit of the filing date of the prior-filed application. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed provisional application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3230. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

The application is being forwarded to Technology Center AU 3781 for consideration by the examiner of the claim under 35 U.S.C. §119(e) for the benefit of priority to the prior-filed provisional application.

I was seen

Shirene Willis Brantley
Senior Petitions Attorney

Office of Petitions

ATTACHMENT: Corrected Filing Receipt



### United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. BOX 1450 Alexandria, Virginia 22313-1450

						<u> </u>
APPLICATION	FILING or	GRP ART				
NUMBER	371(c) DATE	UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
11/390 941	03/27/2006	3781	1052	460.2132USO1	17	1

CONFIRMATION NO. 3635 CORRECTED FILING RECEIPT

CHARLES N.J. RUGGIERO, ESQ.
OHLANDT, GREELEY, RUGGIERO & PERLE, L.L.P.
10th FLOOR
ONE LANDMARK SQUARE
STAMFORD, CT 06901-2682

Date Mailed: 03/05/2012

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

#### Applicant(s)

Richard S. Chomik, Orlando, FL; Mark Yoho, Chagrin Falls, OH; Stuart Leslie, Larchmont, NY; Taek Kim, Washington Township, NJ; Aidan Petrie, Jamestown, RI; Joe Sejnowski, North Kingstown, RI;

### **Assignment For Published Patent Application**

Playtex Products, Inc.

Power of Attorney: The patent practitioners associated with Customer Number 00909

# Domestic Priority data as claimed by applicant

This application is a DIV of 10/714,381 11/06/2003 ABN which claims benefit of 60/499,443 09/02/2003

Foreign Applications (You may be eligible to benefit from the Patent Prosecution Highway program at the USPTO. Please see <a href="http://www.uspto.gov">http://www.uspto.gov</a> for more information.)

If Required, Foreign Filing License Granted: 04/27/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 11/390,941** 

Projected Publication Date: Not Applicable

Non-Publication Request: No Early Publication Request: No

page 1 of 3

Title

WASTE STORAGE DEVICE

**Preliminary Class** 

220

### PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

# LICENSE FOR FOREIGN FILING UNDER Title 35, United States Code, Section 184 Title 37, Code of Federal Regulations, 5.11 & 5.15

### **GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

page 2 of 3

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

### **NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

### SelectUSA

The United States represents the largest, most dynamic marketplace in the world and is an unparalleled location for business investment, innovation and commercialization of new technologies. The USA offers tremendous resources and advantages for those who invest and manufacture goods here. Through SelectUSA, our nation works to encourage, facilitate, and accelerate business investment. To learn more about why the USA is the best country in the world to develop technology, manufacture products, and grow your business, visit <u>SelectUSA.gov</u>.



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

THE PROCTER & GAMBLE COMPANY GLOBAL LEGAL DEPARTMENT – IP SYCAMORE BUILDING – 4<sup>TH</sup> FLOOR 299 EAST SIXTH STREET CINCINNATI OH 45202

MAILED

NOV 22 2010

OFFICE OF PETITIONS

In re Application of Lon Montgomery GRAY, et al Application No. 11/391,162 Filed: March 28, 2006 Attorney Docket No. 8822MDL5

**DECISION ON PETITION** 

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 26, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, March 18, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on June 19, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Terminal Disclaimer, (2) the petition fee of \$1620; and (3) a proper statement of unintentional delay.

The Terminal Disclaimer filed with the petition on October 26, 2010, has been reviewed and approved by the Technology Center.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6735.

All other inquiries should be directed to the Technology Center at (571) 272-3700.

This application is being referred to Technology Center AU 1624 for appropriate action by the Examiner in the normal course of business.

/dcg/ Diane C. Goodwyn Petitions Examiner Office of Petitions

DATE (0/2	polis		Paper No.:
TO SPE OF : ART UNIT 2	1.01		
SUBJECT : Request for Cert	tificate of Competion for	Appl. No.: 11/39/278	Patent No.: 778722
Please respond to this requ			
FOR IFW FILES:		'2	ays.
Please review the requeste the IFW application image. meaning of the claims be c	No new matter sh	ons as shown in the CC ould be introduced, nor	OCIN document(s) in should the scope or
Please complete the responsing document code <b>COC</b>	nse (see below) an X.	d forward the complete	d response to scannir
FOR PAPER FILES:			
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Certificates of Corre Randolph Square – Palm Location 7580	9D10-A )	Ovirg Certificate 571-272 Thank Y	es of Correction Branch -0460  You For Your Assista
Certificates of Corre Randolph Square — Palm Location 7580  The request for issuing the Note your decision on the appropriate box	9D10-A ) ne above-identified	Certificate 571-272  Thank Y	es of Correction Branch -0460 'ou For Your Assista
Certificates of Corre Randolph Square — Palm Location 7580  The request for issuing the Note your decision on the appropriate box	9D10-A ) ne above-identified	Certificate 571-272  Thank Y d correction(s) is here!  All changes apply.	es of Correction Branch -0460  You For Your Assistate by: anges do not apply
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/Wayne Young/

PTOL-306 (REV. 7/03)

SPE AU2627

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

6/10/2011



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR **ARLINGTON VA 22203** 

MAILED

NOV 1 8 2010

**OFFICE OF PETITIONS** 

In re Application of

Hideki Hashiba

Application No. 11/391346

Filing or 371(c) Date: 03/29/2006 

Pat. Num.: 7213561

Issue Date: 05/08/2007 Attorney Docket Number:

249-418 (AMK)

ON PETITION

This is a notice regarding request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods Attorney Office of Petitions





Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

APEX JURIS, PLLC 12733 LAKE CITY WAY NORTHEAST SEATTLE WA 98125

MAILED

OCT 19 2011

In re Application of Chen-Ning Hsi

**OFFICE OF PETITIONS** 

Application No. 11/391,423

**DECISION ON PETITION** 

Filed: March 28, 2006

Attorney Docket No. 08.32.02.USP

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 7, 2011, to revive the above-identified application.

## The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed January 5, 2011, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on April 6, 2011. A Notice of Abandonment was mailed on July 18, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of \$1,860, (3) a proper statement of unintentional delay. Accordingly, the amendment is accepted as being unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to Technology Center AU 2614 for appropriate action by the Examiner in the normal course of business on the reply received September 16, 2011.

/Kimberly Inabinet/

Kimberly Inabinet Petitions Examiner Office of Petitions

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MAILED JUL 19:2011

OFFICE OF PETITIONS

Browdy and Neimark, PLLC 1625 K Street, N.W. Suite 1100 Washington DC 20006

In re Patent No. 7,982,766

Issue Date: July 19, 2011 Application No. 11/391,472

Filed: March 29, 2006

Attorney Docket No. CORGHI25

**NOTICE** 

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28, filed June 15, 2011.

The request is **DISMISSED**.

It is noted that \$1,810 was authorized using the firm's credit card to charge the issue and publication fees when the request was filed. Petitioner states that a form PTO-2038 authorizing the additional charges of \$590.00, which satisfies the deficiency payment requirement as per the itemization of the filing fees. However, there was no form PTO-2038 submitted to charge the required deficiency payment of the filing fees.

Inquiries concerning this communication should be directed to the undersigned at (571) 272-3213.

Cheryl Gibson-Baylor

Petitions Examiner Office of Petitions



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Browdy and Neimark, PLLC 1625 K Street, N.W. Suite 1100 Washington DC 20006

MAILED

SEP 07 2011

OFFICE OF PETITIONS

In re Patent No. 7,982,766 Issue Date: July 19, 2011 Application No. 11/391,472

NOTICE

Filed: March 29, 2006

Attorney Docket No. CORCHI25

This is a notice regarding your renewed request for acceptance of a fee deficiency submission under 37 CFR 1.28, filed August 4, 2011.

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3213.

Cheryl Gibson-Baylor Petitions Examiner

Office of Petitions



Commissioner for Patents United States Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450 www.uspto.gov

In re Application of William Michael Frederick Taylor

Application No. 11391501

Filed: March 27,2006

Attorney Docket No. Q121770

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:DECISION ON PETITION TO MAKE SPECIAL :UNDER 37 CFR 1.102(c)(1)

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1), filed 10-MAR-2011 to make the above-identified application special based on applicant's age as set forth in MPEP § 708.02, Section IV.

### The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1), MPEP § 708.02, Section IV: Applicant's Age must include a statement by applicant or a registered practitioner having evidence that applicant is at least 65 years of age. No fee is required.

Accordingly, the above-identified application has been accorded "special" status and will be taken up for action by the examiner upon the completion of all pre-examination processing.

Telephone inquiries concerning this electronic decision should be directed to the Electronic Business Center at 866-217-9197.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

DATE	: <u>3/21/11</u>	Paper No.:
TO SPE OF	: ART UNIT <u>2889</u>	
SUBJECT	: Request for Certificate of Correc	tion for Appl. No.: 11391753 Patent No.: 7579763
		CofC mailroom date: 03/14/11
Please resp	ond to this request for a cert	tificate of correction within 7 days.
FOR IFW F	ILES:	
IFW applica	ew the requested changes/co tion image. No new matter s the claims be changed.	orrections as shown in the <b>COCIN</b> document(s) in the should be introduced, nor should the scope or
Please comusing docum	plete the response (see belonent code <b>COCX</b> .	w) and forward the completed response to scanning
FOR PAPE	R FILES:	
correction.	Please complete this form (s	orrections as shown in the attached certificate of see below) and forward it with the file to:
correction. Certif Rand Palm	w the requested changes/co Please complete this form (s ficates of Correction Branc olph Square – 9D10-A Location 7580	ee below) and forward it with the file to:  ch (CofC)
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PILLSBURY WINTHROP SHAW PITTMAN LLP P.O. BOX 10500 MCLEAN, VA 22102

**OFFICE OF PETITIONS** 

In re Application of

Earl A. Killian et al

Application No. 11/391,773

Filed: March 27, 2006

Attorney Docket No. 083818-0350186

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby ACCEPTED.

Inquiries related to this communication should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle

Petitions Examiner Office of Petitions